

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION,
Petitioner,

v.

ASML NETHERLANDS B.V.,
CARL ZEISS AG,
Patent Owner.

Case IPR2018-00227
Patent 7,209,167 B2

Before BRIAN J. McNAMARA, DAVID M. McKONE, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION DENYING REQUEST FOR REHEARING
37C.F.R. § 42.71(d)

INTRODUCTION

On June 28, 2018, Nikon Corporation (“Petitioner”) filed a Request for Rehearing (Paper 10, “Req. Reh’g.”) of our Decision Denying *Inter Partes* Review of claims 1, 2, 4–16, and 18–27 (the “challenged claims”) of U.S. Patent No. 7,209,167 B2 entered on June 4, 2018 (Paper 9, “Dec.”). Petitioner’s request is directed only to challenged independent claim 15 and dependent claims 20 and 23 on only one of the grounds raised in the Petition, i.e., obviousness under 35 U.S.C. §103(a) over U.S. Patent 5,367,332, Nov. 22, 1994 (Ex. 1005, “Kerns”) in combination with U.S. Patent Appl. Publication No. US 2001/0043279 A1, Nov. 22, 2001 (Ex. 1006, “Niikawa”). Req. Reh’g. 1.

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

We address below the matters Petitioner asserts we overlooked or misapprehended.

Petitioner asserts that the Decision Denying Institution overlooked the distinction discussed in the Petition between the language of method claim 1 and apparatus claim 14, written in means plus function language, and that of claim 15. Req. Reh’g. 3–7. Petitioner argues that “[c]laims 1 and 14 recite ‘generating sensory data from a sensory signal responsive to detecting manipulation of the camera’” but “[i]n contrast Claim 15 recites ‘initiat[ing] capture of sensory data responsive to the trigger signal’” where “the trigger signal in claim 15 is generated ‘in response to detection of a focus adjustment.’” Req. Reh’g. 6 (citing Pet. 9–10).

Petitioner does not dispute our analysis of the language “responsive to detecting manipulation of the camera” of claims 1 and 14 where we concluded that this limitation required both focus adjustments and viewfinder activation. *Id.* at 3. Petitioner asserts that we did not perform a separate analysis of claim 15 and, because we did not recognize that claim 15 requires only that the trigger signal is generated in response to a focus adjustment, we did not apply the broadest reasonable construction. *Id.* at 4, 6, 8–9 (citing Pet. 13). Petitioner asserts that Patent Owner “encouraged this error by conflating sensory data for all three claims together in the very start of its Patent Owner’s Preliminary Response,” but “despite lumping claim 15 with claims 1 and 14 on page 4 of its response, Patent Owner presented *no* argument on this issue with respect to claim 15.” *Id.* at 7–8. According to Petitioner, Patent Owner offered “*no discussion at all* to provide any explanation or reasoning why claim 15 requires *both* focus adjustment and viewfinder activation to trigger image and sensory data capture *in response*

to the trigger signal.” Id. at 8–9. For the reasons discussed below, we are not persuaded by Petitioner’s arguments distinguishing the recitation of triggering of sensory data capture in claims 1 and 14 from the recitation of claim 15.

Claim 14 recites a “means for detecting” and claim 15 recites a “detection circuit [coupled to the processing unit].” The “means for detecting” in claim 14 includes “means for sensing focus adjustment by the camera while the camera is powered-up and in a wait state, for sensing activation of a viewfinder display of the digital camera and for generating the trigger signal in response to detection of a focus adjustment.”

Claim 15 includes a “wherein” clause with language very similar to the “means for detecting” language of claim 14. As we noted in the Decision Denying Institution, claim 15 recites “wherein the detection circuit is configured to sense focus adjustments by the camera while the camera is powered-up and in a wait state, sense activation of a viewfinder display of the digital camera, and generate the trigger signal in response to detection of a focus adjustment.”

Claim 14 recites “means for generating sensory data from a sensor signal responsive to detecting manipulation of the camera.” In claim 15, “the detection circuit [is] configured to generate a trigger signal when the camera is manipulated prior to image-capture” and “the processing unit is configured to initiate capture of sensory data responsive to the trigger signal.”

Petitioner argues that claim 15 “explicitly ties sensory data capture to the trigger signal that is generated in response to detection of a focus adjustment.” Req. Reh’g. 6 (citing Pet 13). Petitioner contends an analysis

that (a) the detection circuit generates a trigger signal when the camera is manipulated and (b) the detection circuit senses focus adjustments and viewfinder actions, so that (c) the trigger must be responsive to both focus adjustment and viewfinder activation, is indirect reasoning that results in a construction that is “not the *broadest* reasonable interpretation.” *Id.* at 5 (emphasis in original). Petitioner’s emphasis on “broadest,” however ignores the “reasonable” aspect of the construction.

Claim 15 explicitly recites that “the detection circuit [is] configured to generate a trigger signal when the camera is manipulated prior to image-capture” and that “the detection circuit is configured to sense focus adjustments by the camera while the camera is powered-up and in a wait state, sense activation of a viewfinder display of the digital camera, and generate the trigger signal in response to detection of a focus adjustment.” Claim 15 recites that the detection circuit configured to generate the trigger signal performs all of these functions, as opposed to one or more of them. Petitioner identifies no disclosure in the Specification supporting its proposed construction that claim 15 should be construed to mean a system in which generating a trigger signal when the camera is manipulated does not require both sensing activation of the viewfinder and detecting focus adjustment.

As Petitioner points out, the ’167 patent acknowledges that it was known to use the shutter release button to initiate both audio capture and focusing. *Id.* at 10 (citing Pet. 33, Ex. 1001, 1:14–16 (disclosing that “[s]ome still cameras utilize a first position on a shutter-release button to initiate audio capture and/or focusing”)). The ’167 patent recognizes that in such systems “the user is limited to capturing an image during the audio

recording period in order to obtain the best coordination between picture and sound.” Ex. 1001, 1:44–47. The ’167 patent addresses this limitation of the prior art with a system in which “[m]anipulation of the camera is detected prior to image capture, and sensory data are generated in response to detecting the manipulation.” Ex. 1001, 1:54–56. Construing apparatus claim 15 as a whole, the functional limitation, “the detection circuit configured to generate a trigger signal when the camera is manipulated prior to image-capture,” must be view the claimed manipulation in the context of the additional functional limitation that the detection circuit is configured to sense activation of the viewfinder. Recognizing that the Specification articulates one purpose of the invention is to avoid the technical constraints of using the shutter button alone to initiate both audio capture and focusing, we do not construe the claim to mean only focusing adjustment is required to begin audio recording merely because the claim also recites that the sensory data used to generate the trigger signal is a focus adjustment.

Petitioner next argues that “Given the Board’s construction of claim 15 was erroneously narrow, its statement that the combination of Kerns and Niikawa does not disclose that *both* focus adjustment and viewfinder activation are required to trigger capture is irrelevant, because claim 15 does not require both.” Req. Reh’g. 9. The basis of Petitioner’s argument is its assertion that “under BRI the manipulation required to cause generation of sensory data need not include the two manipulations recited in claim 1, but can be any detected manipulation.” Pet. 33. As we are not persuaded by Petitioner’s claim construction arguments, we are not persuaded by Petitioner’s argument that the features of claim 15 are disclosed by the combination of Kerns and Niikawa.

Petitioner also argues that Patent Owner presented no argument or evidence for claim 15 concerning the combination of Kerns and Niikawa (Req. Reh’g. 11–12, citing Prelim. Resp. 26–32). Petitioner bears the burden of demonstrating a reasonable likelihood it will succeed on its challenge to patentability and Patent Owner is not obligated even to respond to the Petition. 37 C.F.R. § 42.107.

Even if we adopted Petitioner’s proposed broader construction, we are not persuaded that the Request for Rehearing demonstrates any error or misapprehension in our analysis of the Petition, the ’167 patent, or the references. Kerns uses a two-position shutter button (ready and picture taking positions) that in the first position begins to take a series of photographs and record a series of sound images in ring buffers that are filled and then overwritten as recording progresses. *See e.g.*, Ex. 1005, 3:17–23. When the user presses the button into the second position, additional pictures are snapped and recording stops, with the ring buffers remaining intact. *Id.* at 3:24–33. Kerns does not explicitly discuss auto focusing. Niikawa uses a separate button for sound recording. *See, e.g.*, Ex. 1006 ¶ 155. The Petition describes Kerns at pages 27–30 without mentioning focusing. The relevant claim chart in the Petition cites Kerns’ disclosure of a two-position shutter, but does not cite a portion of Kerns that discloses responding to a detection in focus adjustment. *Id.* at 43. Petitioner’s chart of claim 15 cites Niikawa as disclosing “generating a trigger signal in response to detection of focus adjustment when the camera is manipulated prior to image capture.” Petitioner acknowledges “Niikawa discloses recording sound in association with an image by using sound recording button 53 during ‘after view’ display following image

capture.” Pet. 32 (citing Ex. 1006 ¶ 106). Although Niikawa discloses audio capture, Niikawa does not disclose audio capture based on focusing adjustment. Accordingly, neither Kerns nor Niikawa individually discloses initiating audio capture based on focusing adjustment.

The Petition argues that “it would have been obvious to one of skill in the art to employ the two-step shutter control of Kerns in the camera of Niikawa to provide simplified sound recording control in connection with image capture” (*id.* at 32). As noted above, Kerns does not discuss explicitly responding to focus adjustment to trigger audio recording. The Petition also acknowledges that “Niikawa discloses numerous sensors relating to image taking operations that will cause the camera to be switched to capture mode.” *Id.* at 34. Petitioner’s assertion that one of ordinary skill would have modified Niikawa to replace sound recording button 53 with Kerns’ two-step shutter and further modified the combination to select autofocus as the sensor parameter that initiates sound recording, as recited in claim 15, is not supported by the references and represents an impermissible level of hindsight. Thus, we further determine the Petition did not demonstrate sufficiently that the combination of Kerns and Niikawa would have taught or suggested initiating audio capture based on focusing adjustment to the ordinarily skilled artisan during the relevant timeframe.

As we are not persuaded Petitioner carried its burden, the request for rehearing is denied.

ORDER

In consideration of the above, it is

ORDERED that Petitioner’s Request for Rehearing is DENIED.

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