

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

SYNCHVIEW TECHNOLOGIES, LLC,
Patent Owner.

IPR2019-00470
Patent 6,788,882 B1

Before JENNIFER S. BISK, MONICA S. ULLAGADDI, and
JULIA HEANEY, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Unified Patents, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) for *inter partes* review of claims 1–3, 5–10, 12, 13, 16–25, 27, 28, and 31–33 (“the challenged claims”) of U.S. Patent No. 6,788,882 B1 (“the ’882 patent,” Ex. 1001). Synchview Technologies, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We concluded that Petitioner failed to establish a reasonable likelihood of prevailing in demonstrating that any of the challenged claims are unpatentable. Paper 11 (“Decision” or “Dec.”). Specifically, we concluded that Petitioner did not demonstrate persuasively that any of the cited combinations teach or suggest a digital video recorder (DVR) as recited in independent claims 1 and 19. *Id.* at 18. Accordingly, we declined to institute trial on the challenged claims of the ’882 patent. *Id.*

Petitioner filed a request for rehearing (Paper 12, “Rehearing Request” or “Reh’g Req.”) of our Decision. Petitioner requests that we reconsider our decision that the cited combinations do not teach or suggest the DVR of independent claims 1 and 19. We ordered additional briefing on arguments presented in Petitioner’s Rehearing Request and Patent Owner’s Preliminary Response. Paper 14. Patent Owner responded with a Reply (Paper 15) and Petitioner responded with a Sur-Reply (Paper 16).

For the reasons set forth below, the request is denied and we decline to change our decision not to institute trial.

II. STANDARD OF REVIEW

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.

III. ANALYSIS

A. Whether we misapprehended the construction of the preamble term “digital video recorder”

First, Petitioner contends that “the Decision relied exclusively on extrinsic evidence in the form of two dictionary definitions proffered by Patent Owner,” and that the Board erred because “[t]here is no evidence in the record that these definitions evidenced the meaning of the term [DVR] as it would have been understood at the time of the invention, i.e., as of April 1998.” Reh’g Req. 4. Second, Petitioner contends we did not sufficiently analyze the intrinsic evidence in adopting one of the two dictionary definitions. *Id.*

We are persuaded by Petitioner’s first contention. We adopted a construction for DVR based on a dictionary that had a copyright date of 2002, which is four years after the 1998 filing date of the ’882 patent.¹ See Dec. 11 (citing Ex. 2005, 87). Although the dictionary definitions proposed by Patent Owner may be contemporaneous with the prosecution of the ’882 patent, we are persuaded that there is an insufficient basis upon which to find that, “these definitions evidenced the meaning of the term [DVR] as it would have been understood at the time of the invention, i.e., as of April 1998.” Reh’g Req. 6.

¹ In the Institution Decision, we determined that the preamble was limiting and thus we construed the term “DVR.”

We further determine, however, that the record does not support the conclusion that the term “DVR” had *any* well-understood meaning at the time of the invention. Patent Owner argues that, as of 1998, “DVRs were still on the horizon” and “TiVo, which claims to have made ‘the first DVR to ever exist,’ did not ship its first DVR until March 31, 1999.” Prelim. Resp. 5 (citing Ex. 2013 (TiVo Website)). Thus, the record indicates uncertainty as to whether the “modern” definition of DVR, or more particularly, a definition of DVR from 2004, would have been known and understood by a person of ordinary skill in the art at the time of the invention in 1998.

With regard to Petitioner’s second contention, Petitioner did not contend that “DVR” was expressly defined in the ’882 patent. *See generally* Pet. Petitioner does not point to anything in the record, including within the Specification, that indicates what a person of ordinary skill in the art would have understood the term to mean at the relevant time period. Irrespective of this, we considered the intrinsic evidence when we determined “[t]he ’882 patent does not define or redefine the claim term DVR.” Dec. 11. We further considered the intrinsic evidence with respect to Petitioner’s implicit argument—that DVR should be construed as a system having physically distributed components—when we determined “[t]he portion of the ’882 patent cited by Petitioner in support of its arguments does not indicate that the disk volume storage of the mass data storage unit is located separately from the claimed channel viewer.” *Id.* at 12 (citing Ex. 1001, 4:1–9). Accordingly, we did not overlook or misapprehend Petitioner’s implicit claim construction argument.

Petitioner did not otherwise address the construction of “DVR” except to “propose that claim terms not specifically discussed below should be given their plain meaning in light of the specification at this time.” Pet. 8. But Petitioner did not identify for us what the plain meaning of “DVR” was. So the record does not

indicate how a person of ordinary skill in the art in 1998 would have understood the term “DVR.” For example, would it have been understood to be mutually exclusive with respect to a video on-demand system (*compare* Paper 15, 6–7 (Patent Owner distinguishing an on-demand system from a DVR), *with* Paper 16, 5–6 (Petitioner arguing that such distinction is “based on a false dichotomy that a [DVR] and an on-demand system that records digitally are mutually exclusive concepts”))? Would it have been understood to require user control over the recording process (*compare* Paper 15, 7 (Patent Owner arguing that, in an on-demand system, “the user has no control over what is recorded or deleted”), *with* Paper 16, 7 (Petitioner arguing that there is “no such requirement of user selection”))? There is insufficient evidence of record that would guide us in deciding these issues.

In summary, the record does not include sufficient information for a determination of the claim scope of “DVR.” It is Petitioner’s burden to show, in the Petition, “[h]ow the challenged claim is to be construed” and “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(3)–(4). Without such an explanation of Petitioner’s position and supporting evidence, we cannot conduct the necessary factual inquiry for determining whether Petitioner has shown a reasonable likelihood in demonstrating that the prior art meets this limitation. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (reversing the Board’s decision of obviousness because it relied on “what at best are speculative assumptions as to the meaning of the claims”).

We are unable to conclude, therefore, that there is a reasonable likelihood that Petitioner would prevail in demonstrating the unpatentability of any of the challenged claims.

B. Petitioner's Remaining Rehearing Arguments

The remainder of arguments in Petitioner's Request for Rehearing concern the prior art disclosing a DVR under the construction adopted in the Decision. Reh'g. Req. 10–15. For the reasons discussed above, we determine that we erred in adopting that construction, but we have not been provided with enough evidence to determine a more accurate construction. As such, we cannot analyze whether the prior art renders the challenged claims unpatentable.

IV. CONCLUSION

For the foregoing reasons, we are persuaded that we misapprehended evidence as described above, and we modify our Decision to include this analysis. But we are not persuaded to change our ultimate conclusion to deny institution.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for rehearing is *denied*; and

FURTHER ORDERED that the petition for *inter partes* review is *denied* and no trial is instituted.

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