

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYCOM, INC.,
Petitioner,

v.

DIRECTPACKET RESEARCH, INC.,
Patent Owner.

IPR2019-01233
Patent 7,773,588 B2

Before SHEILA F. McSHANE, CHRISTOPHER L. OGDEN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining No Challenged Claims Unpatentable
35 U.S.C. §§ 144, 318

I. INTRODUCTION

We address this case after a decision by the United States Court of Appeals for the Federal Circuit in *directPacket Research, Inc. v. Polycom, Inc.*, No. 2021-1661, 2022 WL 243918 (Fed. Cir. Jan. 26, 2022) (“Remand Dec.”).

A. Procedural Background

Polycom, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–23 (“the challenged claims”) of U.S. Patent No. 7,773,588 B2 (Ex. 1001, “the ’588 patent”). Paper 1 (“Pet.”). We issued a Decision to Institute *inter partes* review of all challenged claims under all grounds. *See* Paper 21 (“Inst. Dec.”).

After institution of trial, directPacket Research Inc. (“Patent Owner”) filed a Patent Owner Response, with Petitioner replying. Paper 30 (“PO Resp.”); Paper 46 (“Pet. Reply”). The parties also filed Petitioner’s Post-Hearing Supplemental Brief Regarding Claim Construction (Paper 62), Patent Owner’s Post-Hearing Supplemental Brief (Paper 61), and Responsive Briefs concerning claim construction (Papers 63, 64). Petitioner filed the supporting Declaration and Reply Declaration of Dr. Tal Lavian (Ex. 1002; Ex. 1017), and Patent Owner filed the supporting Declarations of Dr. Kevin Jeffay (Ex. 2001, Ex. 2009).

An oral hearing was held on October 20, 2020. A transcript of the hearing is included in the record. Paper 65 (“Tr.”).

We issued a Final Written Decision in accordance with 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Paper 66 (“Final Dec.” or “Final Written Decision”). In that decision, we determined that Petitioner demonstrated by

a preponderance of the evidence that claims 1–23 of the ’588 patent were unpatentable. *Id.* at 35.

Petitioner appealed the Final Written Decision to the United States Court of Appeals for the Federal Circuit. *See* Paper 67. The Federal Circuit reviewed the Board’s claim interpretation of the term “multimedia data stream,” which was that the term “does not have to consist of both signaling and media messages, and may be a signaling message only.” *See directPacket Research*, 2022 WL 243918, at *1. The Federal Circuit disagreed with the Board’s construction, and instead construed “the term multimedia data stream according to its plain and ordinary meaning, which must include media.” *Id.* at *2. The Federal Circuit vacated the Board’s decision and remanded the case back for further proceedings. *Id.*

Subsequent to the remand, a conference call was conducted with the parties to discuss requests for additions to the record. Paper 71. Petitioner requested leave to file additional briefing and an expert report. *Id.* at 2. Patent Owner asserted that no additional briefing or expert report was warranted. *Id.* The Board allowed additional briefing but did not grant leave to file additional evidence. *Id.* at 2–3.

Petitioner then filed Petitioner’s Opening Brief On Remand (Paper 72, “Pet. Rem. Br.”) and Reply Brief (Paper 75, “Pet. Rem. Reply”). Patent Owner filed Patent Owner’s Responsive Brief On Remand (Paper 74, “PO Rem. Resp.”).

Having analyzed the record in view of our reviewing court’s directive, we determine on remand, for the reasons that follow, that Petitioner has not shown by a preponderance of the evidence that claims 1–23 of the ’588 patent are unpatentable.

B. Prior Final Written Decision

In the Final Written Decision, the Board determined that the interpretation of the term “multimedia data stream” did “not have to consist of both signaling and media messages, and may be a signaling message only.” Final Dec. 19. Many of Patent Owner’s arguments in opposition to Petitioner’s obviousness challenges are based on the alleged failings of the primary prior art relied upon to teach “multimedia data stream” as recited in certain limitations of the independent claims. *See, e.g., id.* at 24–26, 33–34. As discussed in the Final Written Decision, the Board did not find these Patent Owner arguments to be persuasive because of the Board’s interpretation of the term “multimedia data stream.” *Id.*

C. Federal Circuit Decision and Scope of the Remand

The Federal Circuit considered the Board’s construction of the term “multimedia data stream,” wherein “[b]ased on that construction, the Board determined that all claims of the ’588 patent would have been obvious.” *directPacket Research*, 2022 WL 243918, at *1. Based on its assessment of the record, the Federal Circuit determined that the plain and ordinary meaning of the term should be accorded, and the term “multimedia data stream” “must include media.” *Id.* at 2.

The Federal Circuit directed that

[b]ecause the Board applied an erroneous construction that affects every independent claim and, under the correct construction, factual issues exist on the proper outcome, we vacate the Board’s final written decision and remand for further proceedings consistent with this opinion.

Id.

II. BACKGROUND

A. Related Proceedings

At the time of the Petition filing, Petitioner identified *directPacket Research, Inc. v. Polycom, Inc.*, 2:18-cv-00331-AWA-RJK (E.D. Va.) as a related matter. Pet. 2–3. At the time of the filing of Mandatory Notices, Patent Owner indicated that *directPacket Research, Inc. v. Polycom, Inc.*, C.A. No. 5:19-cv-03918-VKD (N.D. Cal.) involved the ’588 patent. Paper 4, 2 (Mandatory Notices). The parties both refer to a single litigation that was originally filed in the Eastern District of Virginia and was then transferred to the Northern District of California in July, 2019.

B. The ’588 Patent

The ’588 patent is entitled “System and Method for Cross Protocol Communication” and issued on August 10, 2010 from an application filed on April 13, 2006. Ex. 1001, codes (22), (45), (54).

The ’588 patent is directed to facilitating multimedia communication with multiple communication protocols. Ex. 1001, 2:3–5. The system can handle different types of traffic including forms of Internet communications, such as voice over Internet Protocol (VoIP), and differing types of protocols, such as H.323 and Session Initiation Protocol (SIP), which can accommodate multimedia communication including voice, video, and data communications in real time. *Id.* at 1:18–30. The differing protocols may have different structures and formats and may be incompatible. *Id.* at 1:41–48, 1:58–61. In order to address incompatibility issues, the invention includes a communication controller, which receives a multimedia data stream in a first protocol and converts it to an intermediate protocol. *Id.* at 2:5–10. The multimedia data stream in the intermediate protocol is

transmitted to a second communication controller, which converts the data stream to a second protocol that is compatible with the destination communication device. *Id.* at 2:15–18.

Figure 2, reproduced below, is a block diagram illustrating component blocks of communication controller 100. Ex. 1001, 4:20–21.

FIG. 2

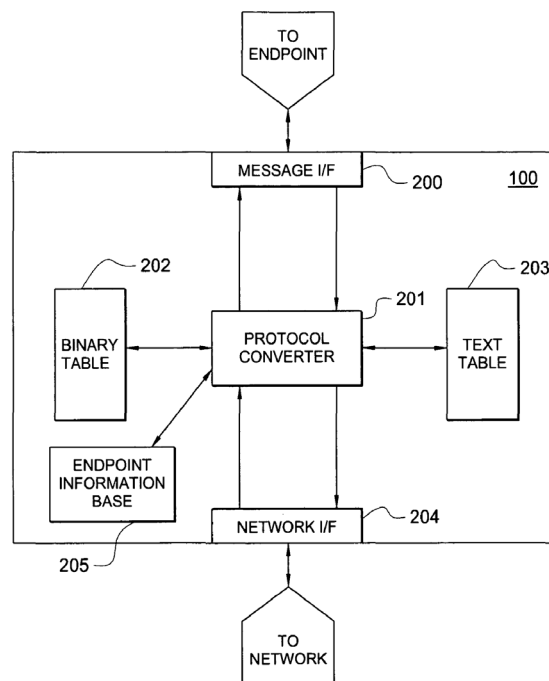
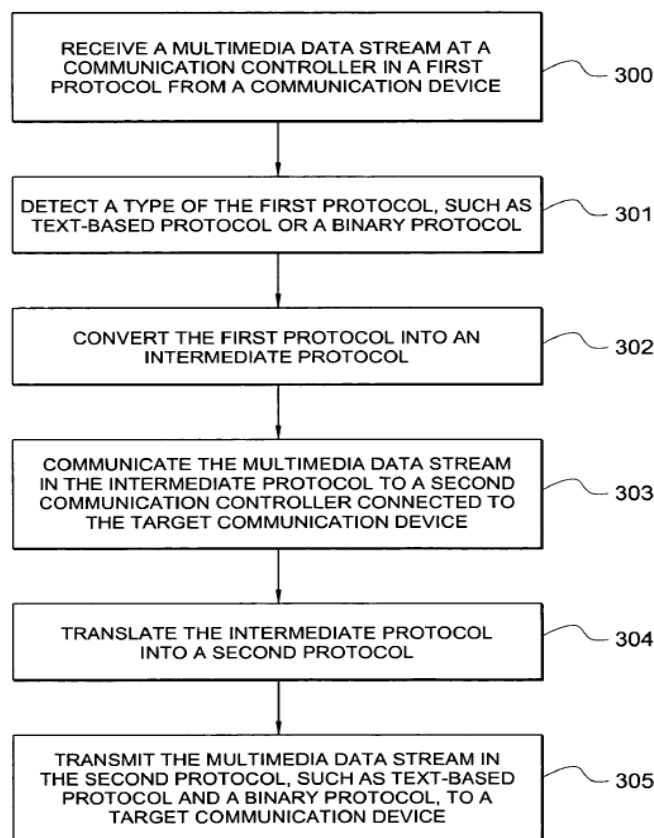


Figure 2, above, shows communication controller 100 receiving data streams from an endpoint at message interface 200, which sends the data stream to protocol converter 201. Ex. 1001, 4:21–27. Protocol converter 201 examines the data stream and determines what protocol the data stream has been configured for and examines the data stream packets to find protocol messages or commands contained within it. *Id.* at 4:27–29. Protocol converter 201 accesses a corresponding table to find the interim protocol

message to replace the original message. *Id.* at 4:32–34. More specifically, protocol converter 201 may access binary table 202, when the received multimedia data stream is in a binary format protocol, or it may access text table 203, when the received multimedia data stream is in a text-based protocol. *Id.* at 4:35–39. As protocol converter 201 assembles the new data stream in the interim protocol, the stream is forwarded to network interface 204 for transmission of the translated data stream onto the network. *Id.* at 4:52–55.

Figure 3, reproduced below, presents an embodiment of a method showing the steps of protocol conversion. Ex. 1001, 5:30–31.

FIG. 3



As shown in Figure 3, above, in step 300, a multimedia data stream is received from a communication device at a communication controller in a first protocol, and at step 301, the type of the first protocol is detected. Ex. 1001, 5:30–35. The first protocol is converted into an intermediate protocol in step 302, and the multimedia data stream in the intermediate protocol is communicated, in step 303, to a second communication controller connected to the target communication device. *Id.* at 5:35–39. The intermediate protocol is translated into a second protocol in step 304, and is transmitted to a target communication device at step 305. *Id.* at 5:39–43.

Challenged claims 1, 7, 11, and 18 of the '588 patent are independent. Claim 1 is reproduced below, with sub-paragraphing added to the limitations for reference purposes.

1. A method for multimedia communication comprising:
 - [a] receiving a multimedia data stream at a communication controller in a first protocol from a communication device, wherein the first protocol comprises a signaling protocol;
 - [b] detecting a type of said first protocol;
 - [c] converting said first protocol into an intermediate protocol;
 - [d] translating said intermediate protocol into a second protocol, wherein the second protocol comprises a signaling protocol; and
 - [e] transmitting said multimedia data stream in said second protocol to a target communication device;
 - [f] wherein said first protocol comprises one of a text-based protocol and a binary protocol and wherein said second protocol comprises one of a binary protocol and a text-based protocol.

Ex. 1001, 7:25–41.

C. Grounds Considered in Remand

Petitioner contends that claims 1–23 of the ’588 patent are unpatentable under the following grounds, which remain at issue on remand.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–23	103(a) ¹	Ress ²
1–23	103(a)	Ress, Doyle ³

Pet. 5.

III. ANALYSIS

A. Level of Ordinary Skill in the Art

As discussed in the Final Written Decision, we adopted Petitioner’s proposal that a person of ordinary skill in the art would have a Bachelor’s degree or equivalent in electrical engineering, computer engineering, or similar field, with at least two years of experience in a relevant field such as telecommunications or multimedia communications. Final Dec. 9–11; *see also* Inst. Dec. 19–21. Additionally, the adopted qualifications include that the skilled artisan should have some familiarity with the design and implementation of VoIP and multimedia networks. *Id.* Neither Patent Owner nor Petitioner have disputed the qualifications of a person of ordinary

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the challenged claims of the ’588 patent have an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of 35 U.S.C. § 103.

² US 6,885,658 B1, filed on February 18, 2000, issued April 26, 2005, claiming priority to Provisional Application No. 60/137,867, filed on June 7, 1999. Ex. 1004.

³ US Pub. No. 2002/0133588 A1, published September 19, 2002. Ex. 1005.

skill in the art employed. *See generally*, PO Resp.; Pet. Reply; PO Sur-Reply.

B. Claim Construction

As discussed above, the Federal Circuit has determined that the claim term “multimedia data stream” “must include media.” *directPacket Research*, 2022 WL 243918, at *2.

We determine that it is not necessary to provide an express interpretation of any other terms of the claims. *Cf. Vivid Techs., Inc.*, 200 F.3d at 803 (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

C. Alleged Obviousness of Claims 1–23 over Ress

In the Petition, Petitioner contends that claims 1–23 are rendered obvious by Ress. Pet. 21–56; Pet. Rem. Br. 1–6; Pet. Rem. Reply Br. 4. Patent Owner argues that the prior art asserted fails to teach or suggest at least the claim limitations that recite “multimedia data stream.” *See* PO Resp. 18–40; PO Rem. Resp. 1, 4–6.

We begin our discussion with a brief summary of Ress and then address the evidence and arguments presented.

1. Ress (Ex. 1004)

Ress is directed to a method and apparatus for interworking between internet protocol (IP) telephony protocols. Ex. 1004, 1:13–17. The system includes a call server that has a first protocol agent for communicating with a first protocol device according to a first protocol and a second protocol agent that communicates with a second protocol device according to a second protocol. *Id.* at 3:11–16. An interworking agent provides functions usable by the first and second protocol agents to communicate using a third

protocol. *Id.* at 3:16–18. Figure 3, reproduced below, depicts a block diagram illustrating media gateway controller (MGC) and gatekeeper (GK) functions implemented within a call server according to an embodiment of the invention. *Id.* at 3:37–40.

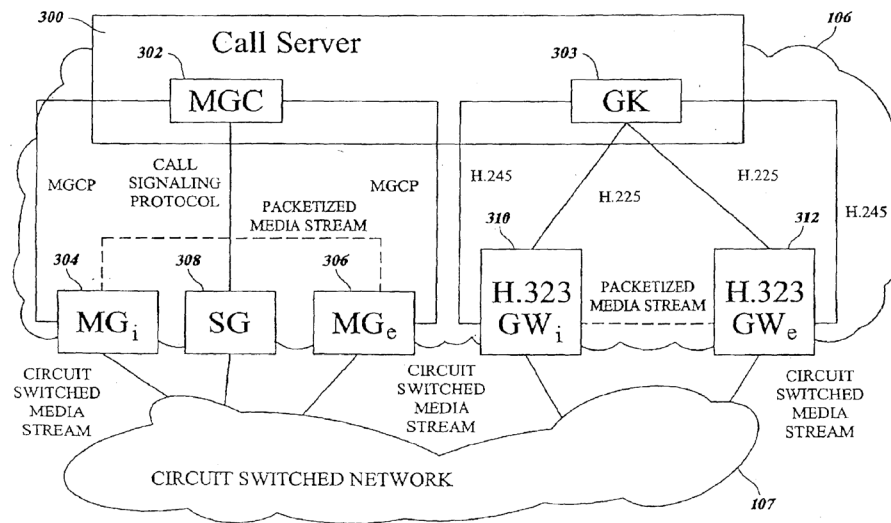


FIG. 3

Figure 3, above, depicts an embodiment of the invention with call server 300, which includes MGC function 302 and GK function 303. Ex. 1004, 4:43–46. Also depicted in Figure 3, above, are ingress media gateway (MG) 304 and egress MG 306, and a signaling gateway (SG) 308 in direct communication with a circuit switched network. *Id.* at 4:43–54.

Interworking agents provide functions usable by the first and second protocol's agents to communicate using a third protocol, where the third protocol provides a superset of the functions provided by the first and second protocols. Ex. 1004, 3:16–20. Figure 5, reproduced below, illustrates a call server that includes a plurality of interworking agents. *Id.* at 3:41–43.

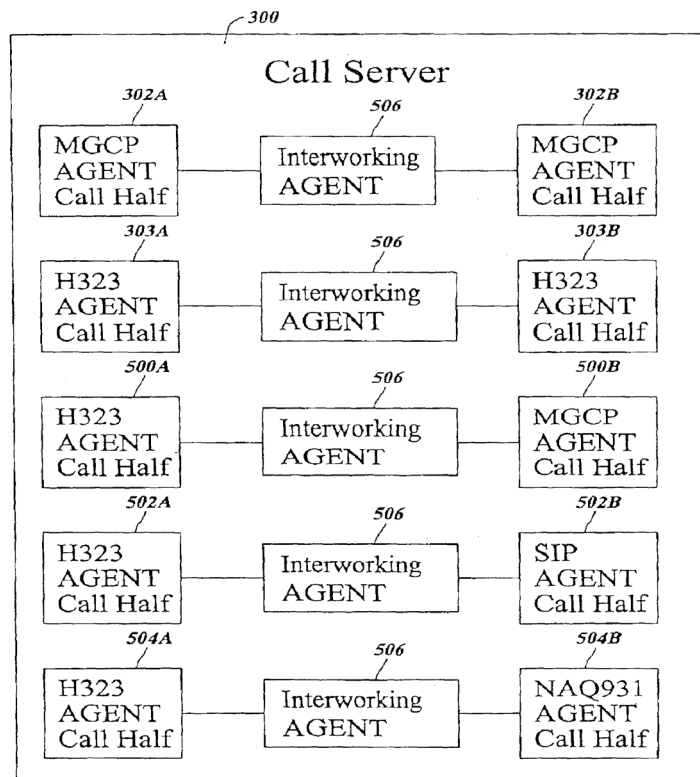


FIG. 5

As illustrated in Figure 5, above, interworking agent 506 provides functions usable by different protocol agents to provide interworking between the protocol agents. Ex. 1004, 5:35–38.

The invention provides for a mechanism provided by agent interworking protocols for implementing media management and exchange by using connection information parameters (CIP) depicted in Figure 8, reproduced below. Ex. 1004, 8:8–12.

Connection Information Parameter	
Field	Example Values
800 Media Type	802 Audio, Video, Data
804 Channel ID	806 12345
808 Channel Operation	810 No action, open, close, modify, mode change, redirect, direct, send capabilities
812 Current Media Description	814 G.711@2 frames/packet
816 Media Capabilities	818 G.711, G.729, RTP address, payload size, media specific information

FIG. 8

Figure 8, above, is a table showing example fields and field values for the connection information parameter according to an embodiment of the invention. Ex. 1004, 8:16–18. Current media description field 812 stores current media description value 814 that indicates the description of the current media stream. *Id.* at 8:52–54. Media capabilities field 816 includes media capabilities value or values 818 that allow an entity to exchange its media capabilities with another entity. *Id.* at 8:56–58. In the example depicted in Figure 8, the media capabilities field includes a list of supported formats, such as G.711 or G.729. *Id.* at 8:58–60.

2. Analysis

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR*, 550 U.S. at 406. The question of obviousness

is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.

Graham v. John Deere Co., 383 U.S. 1, 17–18 (1966).

a. Independent claim 1

We focus on the claim 1 issues related to the claimed “multimedia data stream” because these issues are dispositive. We will first address the arguments and evidence presented by the parties during trial (Petition, Patent Owner Response, Petitioner Reply, Patent Owner Sur-Reply), and then address the issues raised in post-appeal briefing (Petitioner Opening on Remand, Patent Owner Responsive Brief, Petitioner Reply on Remand).

i. Trial Arguments and Evidence

During trial, Patent Owner argued that the claim term “multimedia data stream” requires that the stream include media. PO Resp. 18–20; PO Sur-Reply, 6–7; Paper 61, 1–5; Paper 64, 1–3. Petitioner asserted that Patent Owner’s position on claim construction was flawed, and “multimedia data stream” can consist of only signaling messages. Pet. Reply 1–4; Paper 62, 1–5; Paper 63, 1–3.

In the Petition, Petitioner contended that Ress teaches limitation 1[a] by its disclosure of the use of protocols for establishing “media stream communications, such as voice, data, video, or combinations thereof, over an IP network,” with the multimedia data streams received at various communication controllers such as gateways, terminals and multipoint control units. Pet. 23 (citing Ex. 1004, 1:20–24, 1:58–62, Figs. 3, 4). For limitation 1[a], which recites “receiving a multimedia data stream at a

communication controller in a first protocol from a communication device,” Petitioner referred to Ress’s Figure 3 and asserted that Ress discloses a call server that “includes a first protocol agent for communicating with a first protocol device according to a first protocol,” and that the first protocol can comprise a signaling protocol, such as H.323. *Id.* at 23 (citing Ex. 1004, code (57), 5:15–61 (explanations of block diagrams illustrating call servers), Figs. 3, 5, 6). In support, Dr. Lavian testified that Ress discloses a call server that “includes a first protocol agent for communicating with a first protocol device according to a first protocol.” Ex. 1002 ¶¶ 93–95 (citing Ex. 1004, 1:20–22, 1:58–62, 2:13–15; 2:30–42, 2:43–46, 2:59–62, 3:5–10, 4:43–5:14, 5:15–61, 7:13–32, claim 13, Figs. 3–6). Petitioner contended that data streams in Ress are typically received from communication devices, such as gateways associated with end user devices. *Id.* at 24 (citing Ex. 1004, 1:46–48, 2:6–9, 18:7–14). Accordingly, Petitioner contended that Ress’s call server acts as the claimed “communication controller” and Ress’s gateway acts as the claimed “communication device.”

Petitioner also asserted that limitations 1[b], 1[c], 1[d], and 1[f] are taught by the operation of interworking agents of Ress, which are in the call server. Pet. 24–30. Petitioner alleged that “[o]nce the data stream in Ress is translated to the second protocol at the second protocol device [in the call server], it is transmitted to a target communication device,” thereby teaching limitation 1[e]. *Id.* at 29–30 (citing Ex. 1004, 1:46–48, 2:6–9, 18:7–14). Thus, Petitioner asserted that it is Ress’s call server which performs all the steps, that is, the “detecting,” “converting,” “translating,” and “transmitting” steps of claim 1.

We agree with Petitioner that Ress discloses the use of signaling protocols for media stream communications (Pet. 24; Ex. 1004, 1:20–24), but the operative issue as to limitation 1[a] is whether Ress teaches that a multimedia data stream, including media, is received at the communication controller (call server). We have reviewed the evidence and argument provided by Petitioner during trial, and we agree with Patent Owner that Petitioner fails to demonstrate that Ress teaches or suggests this limitation. PO Resp. 18–19. The evidence supports Patent Owner’s contention, referencing annotated Figure 3 reproduced below, that “Ress illustrates a ‘packetized media stream’ (in blue) communicated between gateways is not associated with the signaling messages (in red) communicated to the call server” and “[t]he ‘packetized media stream’ notably never reaches the call server 300 of Ress.” *Id.* at 14, 19.

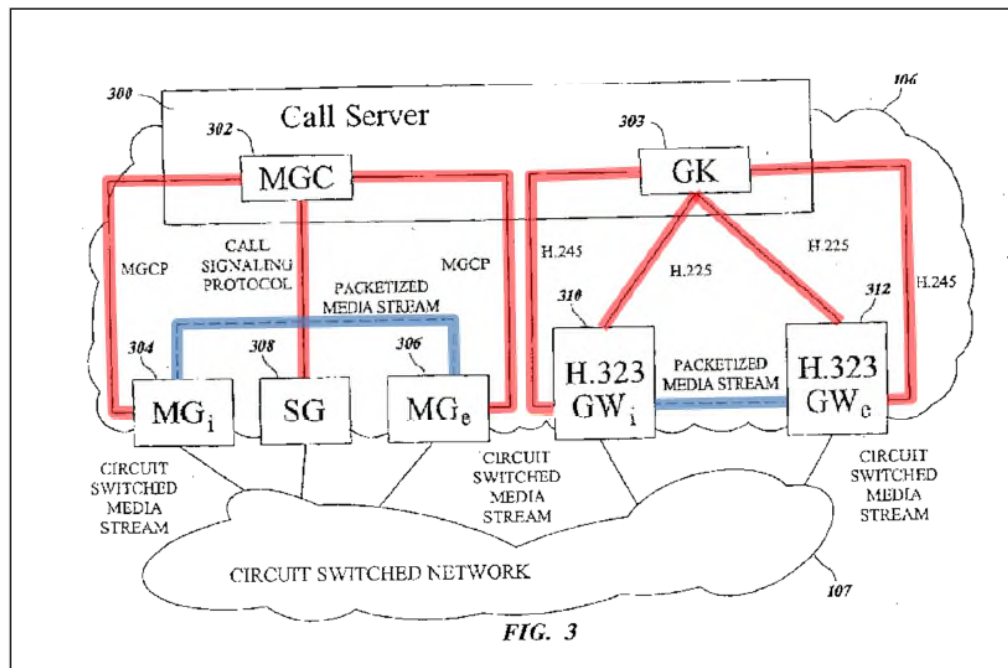


Figure 3, above, is a block diagram illustrating media gateway controller and gatekeeper functions implemented within a call server in Ress. Ex. 1004, 3:37–40.

We have carefully reviewed Petition, Reply, and supporting Declarations and we agree with Patent Owner that neither Petitioner nor Dr. Lavian identify the receipt of *media* at Ress’s call server. Pet. 13–16, 22–24; Pet. Reply 4–7; Ex. 1002 ¶¶ 76–80; 91–95; Ex. 1017 ¶¶ 7–17; PO Resp. 18–20; Ex. 2009 ¶¶ 91–95. More specifically, and consistent with Dr. Jeffay’s testimony, we agree that Dr. Lavian’s testimony regarding receiving a multimedia data stream is “only concerned with call control and call signaling and are silent on the issue of transmission or receipt of multimedia data streams.” Ex. 2009 ¶ 94. We further agree with Dr. Jeffay’s testimony that the “Packetized Media Stream,” as shown in Figure 3 of Ress, “is exclusively shown as being communicated directly between gateway devices and not involving the Call Server of Ress and not showing multimedia data streams being received from a communications device.” *Id.* ¶ 95. In other words, Ress teaches only that its call server receives call signaling, but no media is received by the call server. As such, we agree with Patent Owner that “[b]ecause the Call Server of Ress never receives any media, it cannot ‘receiv[e] a multimedia data stream’ as claimed.” PO Sur-Reply 6.

Moreover, during trial, Petitioner never argued that Ress taught that a multimedia data stream, as claimed in claim 1, includes media. *See* Pet. 21–30; Pet. Reply 4–6. In the Petition and Reply, Petitioner’s assertions are instead based on its proposed claim construction that “[a] multimedia data stream can consist of only signaling messages”—which is the construction

that the Federal Circuit has rejected. Pet. Reply 3; *directPacket Research*, 2022 WL 243918, at *2. For instance, Petitioner contended that “[t]he ‘multimedia data stream’ being converted in the ’588 patent’s communication controller is the signaling portion.” Pet. Reply 4–5. Petitioner goes on to state, “*This is exactly what Ress teaches.*” *Id.* at 5 (emphasis added). This is also consistent with Petitioner’s representations made during oral argument prior to the appeal and remand:

JUDGE McSHANE: -- if we were to say that the multimedia data stream . . . included both signal and the media data, right?

MR. McBRIDE: Right.

JUDGE McSHANE: So, if that were the case, then Ress . . . would not teach it [limitation 1[a]] because it says receiving a media stream at a communication controller, correct?

MR. McBRIDE: If you were to require the multimedia data stream to include both signaling messages and content, then Ress would not necessarily teach that.

Tr. 43:24–44:7.

Petitioner relied upon Doyle only to the extent that Ress did not teach limitation 1[b], “detecting a type of said first protocol,” and there is no reliance on Doyle for the teaching of limitation 1[a]. Pet. 57–60.

Considering the arguments and evidence raised during trial, we determine that Petitioner fails to provide any arguments and evidence that Ress, or the combination of Ress and Doyle, teaches or suggests limitation 1[a], that is, that a “multimedia data stream” is received at a communication controller.

ii. Post-Appeal Arguments and Evidence

In briefing presented post-appeal, Petitioner asserts that Ress has the capability to receive and transmit a multimedia data stream that includes

media. Pet. Rem. Br. 1–6; Pet. Rem. Reply 2–4. Patent Owner argues that Petitioner chose not to make any invalidity arguments at trial directed to Patent Owner’s claim construction that a “multimedia data stream” includes media. PO Rem. Resp. 1. Patent Owner contends that, because Petitioner never presented invalidity arguments under the claim construction that requires media to be included in the multimedia data stream, Petitioner’s new argument and evidence presented post-appeal are impermissible under 37 C.F.R. § 42.23(b).

We determine that Petitioner presents new evidence and arguments post-appeal, which is impermissible. In its Opening Brief On Remand, Petitioner refers to multiple portions of Resso which had not been cited in either the Petition or Petitioner’s Reply. *See* Pet. Rem. Br. 1–6 (citing Ex. 1004, 5:62–65, 4:35–42, 7:49–53, 11:62–65, 12:3–9, 4:36–38, 12:6–12, 13:54–59, 12:25–29, 12:31–33, 18:21–24, 18:51–52, 19:6–12). Petitioner also refers to evidence that was cited in Petition and Reply but was not previously relied upon for any assertions related to any transmission of media to the call server in Resso. *Id.* (citing Ex. 1004, 6:16–19, 10:45–49, 18:11–14, 12:13–17, 12:18–21, Figs. 7, 12–19).

As discussed above, we have determined that Petitioner never argued during trial that Resso taught a multimedia data stream that includes media. In post-appeal, Petitioner contends that it is not presenting new arguments, and refers to an argument it made in Reply during trial in support (Pet. Rem. Reply 1–2):

Resso is not limited to *establishing* media stream communications. Resso teaches that the call server converts a multimedia data stream over the life of the connection, not just call establishment. For

example, Figs. 12–19 are call flow diagrams illustrating call signalings (among different protocols and entities) throughout the life of the connection, including scenarios like call hold and common channel signaling. Ex. 1017, ¶¶15.

Pet. Reply 5-6. Petitioner’s previous argument is directed to addressing Patent Owner’s assertion that Ress is limited to establishing media stream communications. But this previous argument does not contend that media is received by the call server; the contentions are instead directed to Ress’s disclosures that the call server handles call signaling, with no mention or suggestion of media being transmitted or received as the claim requires. *Id.* Petitioner also argues that in its post appeal briefing it is providing further explanation and elaboration on its previous contentions. Pet. Rem. Reply 1–3. But instead, as we discuss above, the record shows that Petitioner did not argue that that Ress taught that a multimedia data stream that includes media during trial—Petitioner’s arguments post-appeal instead present a completely new line of argument.

Although it is not precedential, *Wireless Protocol Innovations, Inc. v. TCT Mobile, Inc.* is instructive because the case evaluated several issues that are similar to those here. *Wireless Protocol Innovations, Inc. v. TCT Mobile, Inc.*, No. 2021-2112, 2022 WL 2813743 (Fed. Cir. July 19, 2022). In *Wireless Protocol*, and similar to this case, an *inter partes* review final written decision was appealed to the Federal Circuit, which vacated the decision and remanded a ground to the Board because the Federal Circuit found that it was premised on an incorrect construction of a claim term. *Id.* at *1. Here, Petitioner was on notice of Patent Owner’s position on claim construction during trial at the time of the Patent Owner’s Response, and

Patent Owner’s position remained consistent, which is similar to the situation in *Wireless Protocol*. *Id.* at *1, 4; PO Resp. 18–20; PO Sur-Reply, 6–7; Paper 61, 1–5; Paper 64, 1–3. Additionally, and similar to *Wireless Protocol*, here the Federal Circuit “did not set forth a new claim construction never contemplated by the parties,” because the Federal Circuit agreed with Patent Owner’s known proposed construction. *See Wireless Protocol*, 2022 WL 2813743, at *4. *Wireless Protocol* found that under the circumstances of that case, because a petitioner was on notice of the claim construction and failed to raise an argument under it at trial, there was forfeiture of its argument. *Id.*

We agree with Patent Owner that Petitioner has impermissibly raised new issues and evidence on remand under 37 C.F.R. § 42.23(b).⁴ *See* PO Rem. Resp. 2–4. As discussed, Petitioner was on notice of Patent Owner’s proposed claim construction in the trial, and did not assert that the prior art taught or suggested the claim limitations under Patent Owner’s construction. Further, this is not a situation where Petitioner sought to clarify its prior position post-appeal, but instead Petitioner is impermissibly attempting to introduce new arguments and evidence. *Accord Kingston Tech. Co., Inc. V. SPEX Technologies, Inc.*, 798 F. App’x 629, 635 (Fed. Cir. 2020); *In re Google Tech. Holdings LLC*, 980 F.3d 858, 863 (Fed. Cir. 2020) (declining to consider arguments forfeited by failing to present them to the Board).

Accordingly, we decline to consider Petitioner’s arguments and evidence newly-raised post-appeal.

⁴ Because the issue did not arise in this case, we do not address the specific issue of the permissibility of Petitioner adapting its arguments in the Petition in its Reply to respond to Patent Owner’s claim construction. *See Wireless Protocol*, 2022 WL 2813743, at *5.

iii. Conclusion

Accordingly, we determine that Petitioner has not shown by a preponderance of the evidence that claim 1 of the '588 patent would have been obvious over Ress or the combination of Ress and Doyle.

b. Claims 2–23

Claims 7, 11, and 18 of the '588 patent are independent. These claims require that the communication controller comprises “a message interface to transceive multimedia data” (claim 7), “receiving a multimedia stream” (claim 11), or be a computer program with “code for receiving a multimedia data stream at a communication controller” (claim 18). Petitioner relies on the same arguments and evidence to that provided for limitation 1[a] to demonstrate Ress’s teaching of the similar limitations of claims 7, 11, and 18. Pet. 42–44, 47–48, 52. The parties provide no additional arguments related to these claims post-appeal.

As discussed above, we do not find that Petitioner has provided sufficient evidence that the asserted prior art teaches limitation 1[a], and we also find the same for the similar claim limitations of claims 7, 11, and 18. By virtue of their dependency from the independent claims, Petitioner’s obviousness challenges to dependent claims 2–6, 8–10, 12–17, and 19–23 also fail.

Accordingly, we determine that Petitioner has not shown by a preponderance of the evidence that claims 2–23 of the '588 patent would have been obvious over Ress or the combination of Ress and Doyle.

IV. CONCLUSION

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–23	103(a)	Ress		1–23
1–23	103(a)	Ress, Doyle		1–23
Overall Outcome				1–23

V. ORDER

For the reasons given, it is:

ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 1–23 of U.S. Patent No. 7,773,588 are unpatentable; and

FURTHER ORDERED because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2019-01233
Patent 7,773,588 B2

For PETITIONER:

David Dalke
Noorossadat Torabi
WINSTON & STRAWN LLP
DDalke@winston.com
ntorabi@winston.com

For PATENT OWNER:

Jitendra Malik
Christopher Ferenc
KATTEN MUCHIN ROSENMAN LLP
jitty.malik@kattenlaw.com
christopher.ferenc@kattenlaw.com