

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMBRIDGE MOBILE TELEMATICS, INC.,
Petitioner,

v.

SFARA, INC.,
Patent Owner.

IPR2024-00966
Patent 9,333,946 B2

Before JOHN F. HORVATH, ROBERT L. KINDER, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

PER CURIAM

Opinion Concurring filed by HORVATH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Cambridge Mobile Telematics, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6, 8–13, and 15–20 (“the challenged claims”) of U.S. Patent No. 9,333,946 B2 (Ex. 1001, “the ’946 patent”). Paper 2 (“Pet.”), 3. Sfara, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to the Preliminary Response, Paper 9 (Prelim. Reply), and Patent Owner filed a Sur-Reply, Paper 11 (Prelim. Sur-Reply). We have jurisdiction and authority under 35 U.S.C. §§ 6, 314 and 37 C.F.R. § 42.4.

For the reasons discussed below, we determine that it is appropriate to exercise our discretion under § 314(a) to deny the Petition.

B. Real Parties-in-Interest

Petitioner identifies itself as the real party-in-interest. Pet. 91. Patent Owner identifies itself as the real party-in-interest. Paper 4, 1; Paper 6, 1.

C. Related Matters

Petitioner and Patent Owner identify the following district court case as a proceeding that can affect or be affected by this proceeding: *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, 3:23-cv-01368 (DNJ) (the “district court proceeding”). Pet. 91; Paper 4, 1; Paper 6, 1.

D. The ’946 Patent

The ’946 patent is directed toward “an improved method and apparatus of determining the specific identity and type of vehicle a smartphone is in.” Ex. 1001, 2:46–48. The method is best illustrated in Figures 12 and 13, which are reproduced below.

FIG. 12

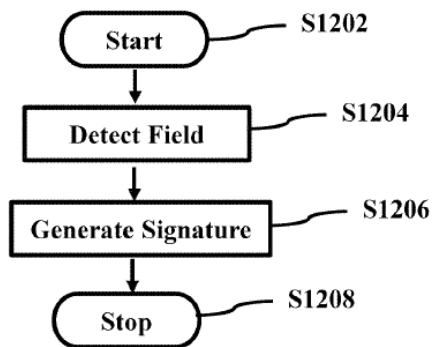
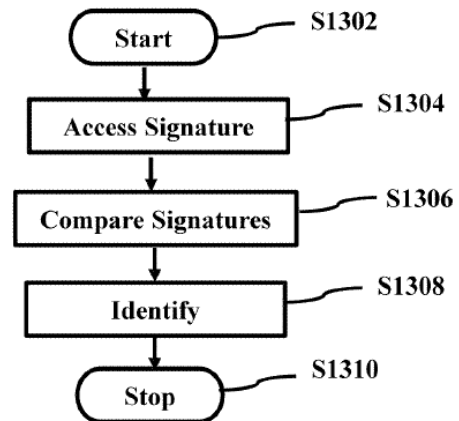


FIG. 13



The Figures above are Figures 12 and 13 of the '946 patent, illustrating a “method of detecting an item or a location” and a “method of verifying an item or a location,” respectively. *Id.* at 3:41–46. The detecting method begins (S1202) by detecting a field (S1204) via a field-detecting component 412, which also generates a signature (S1206) characteristic of the field. *Id.* at 15:31–35, 15:39–45, Fig. 4. The signature can be, e.g., the absolute value of a detected magnetic field, or a value of one of its orthogonal (x , y , z) components. *Id.* at 8:6–13. The verifying method begins (S1302) by accessing a signature (S1304) from a database via access component 416 and comparing (S1306), via comparator 418, the previously generated signature (S1206) to the accessed signature (S1304). *Id.* at 16:1–12, Fig. 4. Comparator 418 sends an output to identifying component 420 to identify (S1308) the item or location associated with the detected field. *Id.* at 16:13–17, Fig. 4. If the generated and accessed signatures match, “identifying component 420 may indicate that the newly detected item/location is the same item/location that was previously registered” in the database. *Id.* at 16:17–24. If they do not, “identifying component 420 may indicate that the newly detected item/location is [not] the same item/location that was

previously registered” in the database.” *Id.* at 16:24–31.

E. Illustrative Claim

Claims 1, 8, and 15 are independent, and claims 2–6, 9–13, and 16–20 depend directly or indirectly from them. Ex. 1001, 17:51–21:5. Claim 1, which is illustrative of the challenged claims, is reproduced below. Claim 8 recites a method performed by the device and device components recited in claim 1. *Compare id.* at 18:49–19:8, *with id.* at 17:51–18:8. Claim 15 recites a computer-readable medium having instructions that, when read by a computer, instruct the computer to perform the method of claim 8. *Compare id.* at 19:55–20:17, *with id.* at 18:49–19:8.

1. A device, for use with a database, said device comprising:

a field-detecting component operable to detect at least one of an electric field, a magnetic field and an electro-magnetic field and to generate a detected field signature based on the detected one of an electric field, a magnetic field and an electro-magnetic field;

an input component operable to input the detected field signature into the database;

an accessing component operable to access the detected field signature from the database;

a comparing component operable to generate a comparison signal; and

an identifying component, operable to identify one of an item and a location based on the comparison signal,

wherein said field-detecting component is further operable to detect a second one of an electric field, a magnetic field and an electro-magnetic field and to generate a second detected field signature based on the detected second one of an electric field, a magnetic field and an electro-magnetic field, and

wherein said comparing component is operable to generate the comparison signal based on a comparison of the detected field signature and the second detected field signature.

Ex. 1001, 17:51–18:8.

F. Evidence

Reference		Effective Date	Exhibit
Abramson	US 8,290,480 B2	Oct. 16, 2012	1004
Fong	US 8,509,812 B2	Dec. 27, 2011	1005

Petitioner also relies upon the Declaration of Lin Zhong, Ph.D. Ex.1002.

G. Asserted Grounds

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Ground	Claims	35 U.S.C. §	Reference(s)
1	1, 5, 6, 8, 12, 13, 15, 19, 20	103	Fong
2	1–6, 8–13, 15–20	103	Abramson
3	2–4, 6, 9–11, 13, 16–18	103	Fong, Abramson

II. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a)

Patent Owner argues we should deny the Petition because Petitioner failed to state how the claims should be construed. Prelim. Resp. 10–17 (citing 37 C.F.R. § 42.104(b)(3)). In doing so, Patent Owner argues Petitioner’s contention that the claims should be given their plain and ordinary meaning “is diametrically opposed to its means-plus-function construction in the district court” and Petitioner has not explained “why its position is different in the two proceedings and has provided no alternative means-plus-function construction . . . in this proceeding.” *Id.* at 10.

Our rules require that a petition set forth “[h]ow the challenged claim is to be construed.” 37 C.F.R. §42.104(b)(3) (“rule 104(b)(3)”). The rule further states:

Where the claim to be construed contains a means-plus-function . . . limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

Id. As the Board recently explained:

The Consolidated Trial Practice Guide^[1,2] (“CTPG”) . . . instructs that “[w]here claim language *may* be construed according to 35 U.S.C. § 112(f), a petitioner *must* provide a construction.” CTPG 45 (emphases added) (citing 37 C.F.R. § 42.104(b)(3)). The CTPG advises that a party “may choose to elaborate why § 112(f) should or should not apply to the limitation at issue.” *Id.* Notably, the CTPG warns that “[a] petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).” *Id.*

10x Genomics, Inc. v. Pres. and Fellows of Harvard Coll., IPR2023-01299, Paper 15 at 8 (PTAB Mar. 14, 2024) (denying institution).

In the district court proceeding, Petitioner argued that “the ‘component’ terms^[3] in the Challenged Claims should be means-plus-function terms under § 112(f) and that such terms are indefinite.” Pet. 6 n. 1 (citing Ex. 1008, 39–48). In this proceeding, Petitioner argues that because

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

² Though not part of our rules, the CTPG “is intended to advise the public on the general framework of the rules, including the structure and times for taking action in each of the AIA proceedings” and to “encourage[] consistency of procedures among panels of the Board.” CTPG, 1, 3.

³ For example, in claim 1, the terms “a mode-determining component,” “a first detecting component,” and “a second detecting component.”

Patent Owner’s district court position is “that Petitioner infringes the ’946 patent according to the plain and ordinary meaning of the ‘component’ terms,” it has here “applied Patent Owner’s proposed ‘plain and ordinary meaning’ constructions of the disputed [component] terms.” *Id.* at 5–6.

In response, Patent Owner argues that although it “proposed a ‘plain and ordinary meaning’ construction of [the component] terms in the litigation, [it] also provided its own means-plus-function construction as an alternative.” Prelim. Resp. 12 (citing Ex. 1008, 39–48). Patent Owner further argues that Petitioner should have addressed whether the “component” terms are means-plus-function limitations in this proceeding and that its failure to do so renders the Petition deficient under 37 C.F.R. § 42.104(b)(3). *Id.* at 10 (citing *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10 (PTAB Feb. 14, 2019); *10x Genomics*, IPR2023-01299, Paper 15). We agree.

In the district court proceeding, Petitioner emphasized the importance of resolving whether the “component” terms are means-plus-function terms, stating the:

construction of the listed “component” terms—specifically, *whether those terms are means-plus-function limitations* governed by 35 U.S.C. § 112(f) and, if so, whether the specification properly discloses corresponding structure for the recited function in those limitations—*will be most significant* to the resolution of the case and/or *will be case or claim dispositive* or substantially conducive to promoting settlement.

Ex. 1008, 2 (emphasis added) (quoted in Prelim. Resp. 11–12). That is, Petitioner clearly stated that determining whether the “component” terms required means-plus-function construction was a potentially case-dispositive issue. Subsequently, Petitioner construed every limitation of claims 1, 8, and 15 as a means-plus-function limitation, thereby implicating rule

104(b)(3). *Id.* at 39–51. In this proceeding, by contrast, Petitioner neither construes the “component” term limitations as means-plus-function limitations nor explains why they should not be so construed. Pet. 5–7. Moreover, although Patent Owner did argue that the “component” terms should be construed to have their plain and ordinary meaning in the district court proceeding, it also set forth an alternative means-plus-function construction, thus further implicating rule 104(b)(3). Ex. 1008, 39–51.

Given these facts, we determine that rule 104(b)(3) mandates that the Petition either identify “the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” recited in the “component” term limitations or explain why the “component” term limitations are not subject to a means-plus-function construction. This, it fails to do.

To be clear, we note that our rules do not prohibit a petitioner from taking inconsistent claim construction positions before the Board and a district court. *See 10x Genomics, Inc. v. Bio-Rad Labs, Inc.*, IPR2020-00086, Paper 8 at 18 (PTAB Apr. 27, 2020). However, where, as here, a petitioner has proposed a claim term be construed solely as a means-plus-function limitation in a district court proceeding and emphasized that the issue is not only “most significant” but potentially “case . . . dispositive,” we determine the petition is obliged to either apply that construction in this proceeding or explain why that construction is not applicable. Accordingly, we find the Petition to be deficient under rule 104(b)(3).⁴

⁴ We further decline to provide a claim construction of the “component” terms which are not briefed by either party in this proceeding.

III. CONCLUSION

For the foregoing reasons, we determine that the Petition fails to satisfy the requirements of 37 C.F.R. § 42.104(b)(3). Accordingly, we decline to institute an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314, we decline to institute an *inter partes* review.

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HORVATH, *Administrative Patent Judge*, concurring.

I. CONCURRENCE

I concur with the panel’s decision to deny the Petition, and write separately to express my separate reasons for denying the Petition.

A. Discretionary Denial Under 35 U.S.C. § 314(a)

Unlike the majority, I would not discretionarily deny the Petition for Petitioner’s alleged failure to construe the claims or to explain why the claims are not means-plus-function claims. Although rule 104(b)(3) requires a petitioner to state “[h]ow the challenged claim is to be construed,” a failure to do so does not require denying a petition. For example, the CTPG states that “[a] petitioner who chooses not to address construction under § 112(f) *risks* failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).” CTPG at 45 (emphasis added). But risking failure is not failing, and neither rule

104(b)(3) nor the CTPG mandate that a petition *must fail* when a petitioner fails to satisfy rule 104(b)(3). Indeed, our rules allow us to “waive or suspend a requirement of parts 1, 41, and 42,” including rule 104(b)(3), further establishing that a petition need not be denied for failing to comply with the rule. 37 C.F.R. § 42.5(b).

Moreover, Petitioner arguably *has* satisfied rule 104(b)(3) because Petitioner *has* stated “[h]ow the challenged claim is to be construed,” namely, by giving all terms their plain and ordinary meaning. Pet. 5. Although Petitioner argued differently in district court, rule 104(b)(3) does not require Petitioner to construe the claims consistently here and in district court. *See Samsung Elecs. Co., Ltd v. Collect, LLC*, IPR2020-00476, Paper 14 at 12 (PTAB July 31, 2020) (“It is not a requirement of [rule] 104(b)(3) that for every term for which Petitioner has proposed an express construction in related district court litigation, Petitioner must propose the same construction in the Petition.”).

I would also not deny the Petition because it failed to explain why the challenged claims are not “means-plus-function” claims or, if they are, to identify structure corresponding to the recited functions. Rule 104(b)(3) only requires a petition to identify corresponding structure “[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation.” But deciding whether a claim contains a mean-plus-function limitation is an issue for the Board to decide, not the petitioner. *See Markman v. Westview Instr., Inc.*, 517 U.S. 370, 391 (1996) (claim “interpretation . . . is an issue for the judge”); *Kemco Sales, Inc. v. Control Papers Co., Inc.*, 208 F.3d 1352, 1360 (Fed. Cir. 2000) (“Whether the

language of a claim is to be interpreted according to 35 U.S.C. § 112, ¶ 6,¹ i.e., whether a claim limitation is in means-plus-function format, is a matter of claim construction and is thus a question of law.”); *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346 (Fed. Cir. 2015) (“Regarding questions of claim construction, including whether claim language invokes 35 U.S.C. § 112, para. 6, the district court’s determinations . . . are legal questions that we review de novo.”).

B. Claim Construction

In *inter partes* reviews, we construe the claims “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2023). A patentee may recite a limitation in a claim for a combination as “a means or step for performing a specified function without the recital of structure, material, or acts in support thereof.” 35 U.S.C. § 112, ¶ 6. “[U]se of the word ‘means’ in a claim element creates a rebuttable presumption that § 112 ¶ 6 applies.” *Williamson*, 792 F.3d at 1348. “Nonetheless, mere incantation of the word ‘means’ in a clause reciting predominantly structure cannot evoke § 112 ¶ 6.” *York Prods., Inc. v. Cent. Tractor Farm & Fam. Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996). Conversely, “the failure to use the word ‘means’ [in a claim element] also creates a rebuttable presumption—this time that § 112 ¶ 6 does not apply.” *Williamson*, 792 F.3d at 1348. However, this presumption can also be overcome if the claim element fails to recite sufficiently definite structure for performing a recited function. *Id.* at 1349. Significantly, a claim element that is otherwise written in purely functional

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 112. 35 U.S.C. § 112(f) is identical in content to 112, ¶ 6.

terms does not recite sufficiently definite structure if it only recites generic or coined terms that lack a clear meaning. *Id.* at 1350 (“Generic terms such as ‘mechanism,’ ‘element,’ ‘device,’ and other nonce words . . . may be used in a claim in a manner that is tantamount to using the word ‘means’ because they ‘typically do not connote sufficiently definite structure.’”).

“Construing a means-plus-function claim term is a two-step process. The court must first identify the claimed function. Then, the court must determine what structure, if any, disclosed in the specification corresponds to the claimed function.” *Id.* at 1351 (internal citation omitted). “[S]tructure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997) (citation omitted). If the corresponding structure is a processor executing computer software, the specification must disclose and clearly link the recited function to “[an] algorithm that transforms [a] general purpose microprocessor into a ‘special purpose computer programmed to perform the disclosed algorithm.’” *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1338 (Fed. Cir. 2008).

Claims 1, 8, and 15 recite various “components” for performing various functions. Ex. 1001, 17:51–18:8, 18:49–19:8, 19:55–20:17. For example, claim 1 recites “a comparing component operable to generate a comparison signal.” *Id.* at 17:62–63. Claim 8 recites “generating, via a comparing component, a comparison signal.” *Id.* at 18:61–62. Claim 15 recites instructions that, when read by a computer, cause the computer to perform a method that includes the claim 8 step of “generating, via a comparing component, a comparison signal.” *Id.* at 19:55–59, 20:3–4.

The term “comparing component” is a nonce-word that does not connote a definite structure. *See Williamson*, 792 F.3d at 1350 (identifying words such as “mechanism,” “element,” “device,” and others as verbal constructs that do not connote sufficiently definite structures). Indeed, the Specification discloses all of the “components” recited in claims 1, 8, and 15, including the “comparing component,” can be “implemented as a computer having tangible computer-readable media for carrying or having computer-executable instructions or data structures stored thereon.” Ex. 1001, 5:35–43. Thus, like the word “module,” a recognized nonce word, each of the recited “components” is nothing more than “a generic description for software or hardware that performs a specified function” and their recitation “operate[s] as a substitute for ‘means’ in the context of § 112, para. 6.” *Williamson*, 792 F.3d at 1350. Accordingly, we construe the “comparing component” limitation recited in claims 1, 8, and 15 as a means-plus-function limitation whose function is “generating a comparison signal.”²

The only disclosures in the Specification that are linked to the function of “generating a comparison signal” are (1) “a computer having tangible computer-readable media for carrying or having computer executable instructions or data structures stored thereon” (Ex. 1001, 5:35–

² I note that method steps can include means-plus-function limitations. *See Rain Computing, Inc. v. Samsung Elecs. Am. Inc.*, 989 F.3d 1002, 1006–07 (Fed. Cir. 2021) (finding “Applicants are free to invoke § 112 ¶ 6 for a claim term nested in a method claim” and construing a “user identification module” recited in a method claim as a means-plus-function term); *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1374 (Fed. Cir. 2015) (construing a “compliance mechanism” recited in a method claim as a means-plus-function term).

43), (2) a “comparing component,” “comparing component 418,” or “comparator 418” (*id.* at code (57), 2:60–61, 2:67–3:3, 16:1–17, Fig. 4), and (3) “any known device or system that is operable to compare two inputs” (*id.* at 6:50–52). None of these disclosures reveal a sufficiently cognizable structure that performs the recited function of “generating a comparison signal.”

The “comparing component,” “comparing component 418,” or “comparator 418” are not cognizable structures because they reveal no more than the same black-box “comparing component” recited in the claims. The computer implementing the functionality of the “comparing component” is not a cognizable structure because the Specification fails to describe an algorithm executed by the computer that would transform the computer into a “special purpose computer programmed to perform” the function of the “comparing component.” *Aristocrat*, 521 F.3d at 1338. “[A]ny known device or system that is operable to compare two inputs” is not a cognizable structure because the terms “device” and “system,” like the term “component” are simply nonce words that fail to connote a sufficiently definite structure.

To avail oneself of the privilege of reciting a means-plus-function limitation, one must disclose a cognizable structure in the Specification that is clearly linked to and performs the recited function. *See Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999) (finding § 112 ¶ 6 “sets forth a simple requirement, a *quid pro quo*, in order to utilize a generic means expression,” and further reasoning that “[a]ll one needs to do . . . is to recite some structure corresponding to the means in the specification . . . so that one can readily ascertain what the claim means”); *see also Med. Instr. and Diag. Corp. v. Electa AB*, 344 F.3d 1205, 1211

(Fed. Cir. 2003) (finding “[i]f the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid th[e] price” for using means-plus-function claiming).

Accordingly, for the reasons discussed above, I would find all claim limitations reciting the “comparing component” are written in means-plus-function form and the Specification fails to disclose a cognizable structure corresponding to and performing the “comparing component” functions.

C. Analysis of Petitioner’s Contentions

Petitioner contends claims 1, 5, 6, 8, 12, 13, 15, 19, and 20 are unpatentable over Fong, claims 1–6, 8–13, and 15–20 are unpatentable over Abramson, and claims 2–4, 6, 9–11, 13, and 16–18 are unpatentable over the combination of Fong and Abramson. Pet. 7–88. Patent Owner does not dispute these contentions. Prelim. Resp. 10–33. Instead, Patent Owner argues we should discretionarily deny the Petition under *Fintiv* or because Petitioner has failed to construe the claims. *Id.* I would not decline the Petition for failure to construe the claims for the reasons discussed above. I need not decide whether to deny the Petition under *Fintiv* for the following reason.

To consider the merits of Petitioner’s unpatentability challenges, one must undertake a two-step process that requires “construing the claim[s], a question of law for the court, followed by . . . a comparison of the construed claim[s] to the prior art.” *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998). For means-plus-function limitations, the asserted “prior art must disclose not simply a means for achieving the desired function, but rather the *particular structure* recited in the written description corresponding to that function, or an equivalent thereof.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1361 (Fed. Cir. 2001). Thus, “a

challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure—or an equivalent—was present in the prior art.” *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 582 F.3d 1288, 1299 (Fed. Cir. 2009).

As discussed above, all of the challenged claims recite a “comparing component” limitation that is written in means-plus-function format, but the Specification fails to disclose a sufficiently definite corresponding structure that performs its function of “generating a comparison signal.” Thus, I am unable to determine what specific prior art structure is needed to meet the limitation. *Fresenius*, 582 F.3d at 1299. Accordingly, I am unable to determine the merits of the Petition, and would deny the Petition for this reason. *See Samsung Elecs. Am., Inc. v. Prisia Engin. Corp.*, 948 F.3d 1342, 1353 (Fed. Cir. 2020) (“[T]he proper course for the Board to follow, if it cannot ascertain the scope of a claim with reasonable certainty for purposes of assessing patentability, is to decline to institute the IPR.”).

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