

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY COMPUTER ENTERTAINMENT AMERICA LLC
and MICROSOFT CORPORATION INC.,
Petitioner,

v.

ADC TECHNOLOGY INC.,
Patent Owner.

Case CBM2015-00026
Patent 6,193,520

**PATENT OWNER'S RESPONSE TO
PETITION FOR COVERED BUSINESS METHOD PATENT
REVIEW OF UNITED STATES PATENT NO. 6,193,520**

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I. Introduction

Pursuant to 37 C.F.R. §§ 42.220(b), Patent Owner, ADC Technology Inc. (“ADC”), submits this Response in the Covered Business Method Patent Review, which was instituted on July 3, 2015, from the Corrected Petition (Paper No. 6) (the “Petition”) filed on January 12, 2015, by Sony Computer Entertainment America LLC and Microsoft Corporation Inc (collectively, “Petitioner”) requesting covered business method review of claims 8-14 of U.S. Patent No. 6,193,520 (the “520 Patent,” Ex. 1001). Patent Owner respectfully requests that the Patent Trial and Appeal Board (the “Board”) affirm patentability of claims 8-14.

II. Nishio Reference Is Not Permissible Prior Art

During patent prosecution of the '520 Patent, the Examiner issued an Office Action dated May 9, 2000, and rejected the as-filed claims 1-3, 5, 8-10, 12, 15-17, and 19 under the judicially created doctrine of double patenting over claims 1-3 of U.S. Patent No. 5,775,995 since the claims, if allowed, would improperly extend the “right to exclude” already

granted in the patent. *'520 Patent File History*, Ex. 1015 at 86-90. The Examiner determined the following:

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The communication system for transmitting at least one of the program, the data, and a combination of the program and data (such as software of video games or karaoke music) from the host facility to a communication termination device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Id. at 89. Claims 8-10 and 12, which are undergoing review in the present proceeding, correspond to the as-filed claims 8-10 and 12 in the original application. In a Response dated August 1, 2000, a Terminal Disclaimer was submitted to overcome the raised double patenting rejection with respect to the claims. Claims 3, 10, and 17 were amended for dependency issues. *Id.* at 82-85. A Notice of Allowability was issued

allowing claims 1-21 on August 25, 2000. *Id.* at 80-81. The Patent issued on February 27, 2001.

U.S. Patent No. 5,775,995 is a divisional patent application of U.S. Patent No. 5,745,744 (Appl. No. 555,400). Ex. 1014 at 1. The '744 Patent was filed on November 9, 1995. Ex. 1013 at 1. Because the '995 Patent is a division of the '744 Patent, the specifications of the two are identical. Because the Examiner found support for claims 8-14 in the '995 Patent, there is also support in the '744 Patent. Thus, the effective filing date for claims 8-14 is at the *latest* November 9, 1995, which predates the February 2, 1996, publication date of the German application to Nashio. Ex. 1007 at 2. Therefore, the Nashio reference is an impermissible prior art reference.

III. Declaration Is Inconsistent with Prior Art of Record

In the Declaration of Garry E. Kitchen, Garry declares that he co-founded Skyworks Technologies, Inc. in 1995. He describes Skyworks Technologies, Inc. as an “early pioneering online game company.” Ex. 1011 at ¶11. The Declaration also states that Skyworks performed technical consulting for and provided content to the Sega Channel, one

of the first downloadable game content delivery systems deployed in the United States. Id. at ¶13. The Declaration states that from 1993-1998, Sega Channel delivered Sega Genesis-compatible games for rental over coaxial cable.

The latest effective filing date for claims 8-14 in the present proceeding is November 9, 1995. Mr. Kitchen's declaration states that Skyworks Technologies, Inc. was an “early pioneering online game company”, but it was not founded until 1995. Therefore, the '520 Patent and its family pre-date Mr. Kitchen's “early pioneering online game company” and must therefore be an even earlier pioneering online game company.

In addition, during the time of development for pioneering technologies, typically there are many incremental developments that may lead down many different paths. It is unknown during development which paths will lead to success so many incremental changes are pursued. Therefore, reflecting back after 20 years of development, many incremental developments may appear to be obvious. However, at the time of development, the incremental changes

most likely were not obvious. This is especially true when reflecting back over 20 years in a rapidly developing technology. This reflecting back over 20 years comes into play in the present proceeding. Even the Petitioner's own art contradicts the theory that the claims of the '520 Patent would have been obvious. In the description of the prior art section of Tsumura having a filing date of February 18, 1993, Tsumura summarizes the prior art for computer games as follows:

There are two main applications for computer games, namely home use and commercial use. Games for home use are normally played on TV game machines into which different ROM cassettes containing game program and data can be inserted and removed at will. Personal computers can be used in place of dedicated TV game machines with the relevant game programs being held on floppy disks. A single machine can thus be used to play a variety of different games simply by changing the ROM cassette or floppy disk containing the game program. By contrast, commercial game machines come in many different shapes and sizes, typically either inset into the horizontal surface of a small table or else with an upright visual display arrangement. Such machines are limited, however, in

that each one can generally be used to play only one type of game. The owner of this type of machine must change the ROM board if he wants to change the game. A player using this type of machine cannot therefore freely select the game of his choice and can play only the game for which the machine has been programmed.

Ex. 1003, col 2, lines 20-38. The characterization of the state of the art by Tsumura is in stark contrast to Mr. Kitchen's declaration. This is most likely due to having the benefit of 20 years of development to reflect upon and having the benefit of reviewing the issued patent sought to be invalidated. Thus, unless the cited art actually discloses each of the claim limitations, Applicant does not believe that Mr. Kitchen's declaration should be used to reconstruct the invention based on an “obvious to combine” mindset using 20 years of hindsight.

IV. Claim Construction

Patent Owner disputes certain of Petitioner's proposed claim constructions as being erroneous and even illogical. Although Patent Owner only argues at length two of Petitioner's proposed claim constructions, Patent Owner submits that all of Petitioner's proposed

claim constructions are, at least, misleading and erroneous. However, the two most egregious examples are set out here.

A. Interference Means

Petitioners take the erroneous position that the claim term “interference means” has at least five different constructions, each with additional functional limitations piled on top of the disclosed structure. Petition, pages 22-24. However, the proper construction must only disclose the appropriate structure to implement the claimed function, not necessarily other functions in other portions of the claims. See, e.g., *Williamson V. Citrix Online LLC*, No. 2013–1130 (Fed. Cir. June 16, 2015) In other words, Petitioners properly identify the “general purpose computer” programmed to prevent further use of the program or data as described at 11:56-64 and 10:20-44. Accordingly, that is the proper construction. Petitioners’ attempt to introduce significant additional functional limitations through litigation-fueled argument is improper. Accordingly, the “interference means” in each claimed instance should properly be construed as the general purpose computer disclosed by the

'520 Patent programmed to interfere with execution of said executing means when said clock means counts said predetermined time period.

B. “Program, Data, and Combination” terms

Petitioners meander through a lengthy circular argument in support of the erroneous conclusion that the term “program, data, and combination of program and data” is somehow indefinite. Petitioners’ failure is founded on their suggestion that a combination of program and data must necessarily be something “identifiably distinct” from either the program or the data. Petitioners cite no authority for that interesting position, which is not surprising.

The fact is that there is nothing indefinite about a claim that requires operations to be performed either on a program, or on data, or on a combination of the program and data. Petitioners advance the vague argument that one cannot tell if a “video game” is a program, or data, or a combination. However, Petitioners appear to attach an undisclosed definition to “video game” specifically to make it vague whether it is either a program, or data, or a combination. There is nothing indefinite about the term “program, data, and combination.”

Petitioners' complaint is that they are unclear about whether an accused product satisfies that claim term. However, whether an accused product falls within a clear claim term is an issue to be resolved through litigation. Litigation uncertainty does not render a claim term indefinite.

V. Detailed Grounds for Patentability

A. Claims 8, 11, 13, and 14 are patentable under 35 USC 103(a) over Chernow in view of Tsumura

Petitioner concedes that Chernow does not teach the clock means of Claims 8, 11, 13, and 14 (Decision, Paper No. 10, pg 19) and the sound generating means of Claim 14 (Decision, Paper No. 10, pg 19). Petitioner relies on Tsumura to teach these undisclosed limitations. However, Tsumura does not remedy the failure of Chernow.

For Claim 8, there is no teaching in Tsumura for a clock means to associate a time period with a *start* of execution and to keep a predetermined time period after it starts. The Petitioner relies on Mr. Kitchen's conclusory declaration stating that a skilled artisan as of the Filing Date would have recognized modifying Chernow with the

measurement from Tsumura. Ex. 1011, ¶77-78. However, even this conclusory statement mischaracterizes the claimed limitation and the Filing Date. The date upon which a skilled artisan should base this determination is not July 2, 1998, but rather, the latest date of November 9, 1995, almost three year before Mr. Kitchen's time frame. In addition, Mr. Kitchen's declaration correlates Chernow's lease period with the predetermined time period, which totally dismisses that Claim 8 recites “a clock means for keeping *a predetermined time period after said executing means starts execution* of the program or data processing” and “the interference means for interfering with execution of said executing means *when said clock means counts said predetermined time period.*” Mr. Kitchen's declaration states that the “start time for the measurement of the 'term of use' is a minor modification that would involve minor software adjustments and the results would be certain.” Again, this mischaracterizes the limitations recited in Claim 8 and appears to be merely hindsight reconstruction.

For Claim 11, Tsumura and Chernow fails to disclose all the limitations as discussed above for Claim 8, in addition Claim 11 recites

“said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means.” Mr. Kitchen's declaration does not appear to address the limitation recited in Claim 11 with respect to Tsumura and Chernow.

For Claim 13, Tsumura and Chernow fails to disclose all the limitations as discussed above for Claim 8, in addition Claim 13 recites “said interference means comprises means for invalidating an operation on said input device.” Mr. Kitchen's declaration does not appear to address the limitation recited in Claim 13 with respect to Tsumura and Chernow. The Board has already determined that Chernow does not teach this limitation when Chernow discloses that “the software renders itself unusable or erases itself from the user's disk.” PTAB Decision 01-11-2013, Appeal 2012-012256 at 32.

For Claim 14, Tsumura and Chernow fails to disclose all the limitations as discussed above for Claim 8, in addition Claim 14 recites “sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data

processing, wherein said interference means comprises means for preventing said sound generating means from generating sound.” Mr. Kitchen's declaration does not appear to address the limitation recited in Claim 14 with respect to Tsumura and Chernow. In the Petition, Petitioner's argue that Chernow's disclosure of “software renders itself unusable or erases itself from the user's disk” discloses “means for preventing said sound generating means from generating the sound.” In addition, the Petitioner's argue that Tsumura's disclosure of “an output terminal which outputs both display and audio signals to externally connected visual display and audio units to enable the game to proceed,” discloses these limitations. However, the Petitioner fails to provide any teachings regarding the limitation of “sound generating means for generating a predetermined sound in accordance with the progress of execution of the program.” The cited passages merely teach that there are audio units to enable the game to proceed, which does not teach or suggest “a predetermined sound in accordance with the progress of execution of the program” and “*interference means comprises means for preventing said sound generating means from generating the sound.*”

- B. Claims 9 and 10 are patentable under 35 USC 103(a) over Chernow in view of Tsumura in further view of Kato

Petitioner concedes that Chernow does not teach the clock means (Decision, Paper No. 10 at 19). For at least the reasons discussed above, claims 9 and 10 are patentable. In addition, Kato fails to remedy Chernow and Tsumura's failure to disclose “a second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by clock means” and “alarms means”.

- C. Claims 12 and 14 are patentable under 35 USC 103(a) over Chernow in view of Tsumura in further view of Nishio

As discussed above, Nishio is impermissible prior art and can not be used in a 103(a) rejection. For at least that reason, claims 12 and 14 are patentable over Chernow in view of Tsumura and Nishio. Further, as described above, the combination of Chernow and Tsumura does not teach claim 8 from which claims 12 and 14 depend and Nishio fails to remedy this failure because it does not teach “blocking the view of what is displayed on said screen” as recited in claim 12 and “preventing said sound generating means from generating sound” as recited in claim 14.

- D.** Claims 8-11 and 12-14 are patentable under 35 USC 103(a) over Okamoto in view of Tsumura

As discussed above, Tsumura fails to teach the limitations in Claims 8-11 and 12-14.

- E.** Claims 8-9, 11-12, and 14 are patentable under 35 USC 103(a) over Okamoto in view of Nishio

As discussed above, Nishio is impermissible prior art and can not be used in a 103(a) rejection.

VI. Conclusion

The first time this Board affirmed the patentability of the claims at issue in this matter, those claims were reviewed under the “broadest reasonable interpretation” standard set by rule and used during the initial prosecution of the ‘520 Patent. However, the ‘520 Patent is now expired, meaning that its claims are no longer subject to the “broadest reasonable interpretation” standard when assessing their patentability. Rather, as Petitioner concedes, the **narrower** claim construction standard used in litigation must be applied. See, *Amkor Technology, Inc. V. Tessera, Inc.*, Case IPR2013-00242 (Order April 14, 2014).

Accordingly, Claims 8-14 are not given their “broadest reasonable interpretation” in this proceeding, thus making it **less likely** that the Petitioner will meet its burden of proof since it is only relying on the same references in its attempt attack the validity of the challenged claims. In other words, if Petitioner was unable to establish that the claims of the ‘520 Patent were invalid when those claims were given a broader interpretation, then it is a futile exercise to raise those same arguments again, using the same prior art references, against a narrower claim construction.

Patent Owner respectfully requests that the Patent Trial and Appeal Board (the “Board”) affirm patentability of claims 8-14.

Dated: October 5, 2015.

Respectfully submitted,

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