

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD., and  
SAMSUNG ELECTRONICS AMERICA, INC.,  
Petitioner,

v.

CELLECT, LLC,  
Patent Owner.

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IPR2020-00561  
Patent 6,982,742 B2

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Before JAMESON LEE, PATRICK M. BOUCHER, and  
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 42, 58, and 66 of U.S. Patent No. 6,982,742 B2 (Ex. 1001, “the ’742 patent”). Paper 2

(“Pet.”). Collect, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply and Patent Owner filed a Sur-Reply. Papers 9, 12.

For the reasons set forth below, we deny the Petition and do not institute an *inter partes* review.

## I. BACKGROUND

### A. The '742 Patent

The '742 patent relates to “solid state image sensors which are configured to be of a minimum size and used within miniature computer systems known as palm top computers, personal digital assistants (PDA), or handheld computers/organizers.” Ex. 1001, 1:21–26. Figure 1 of the '742 patent is reproduced below.

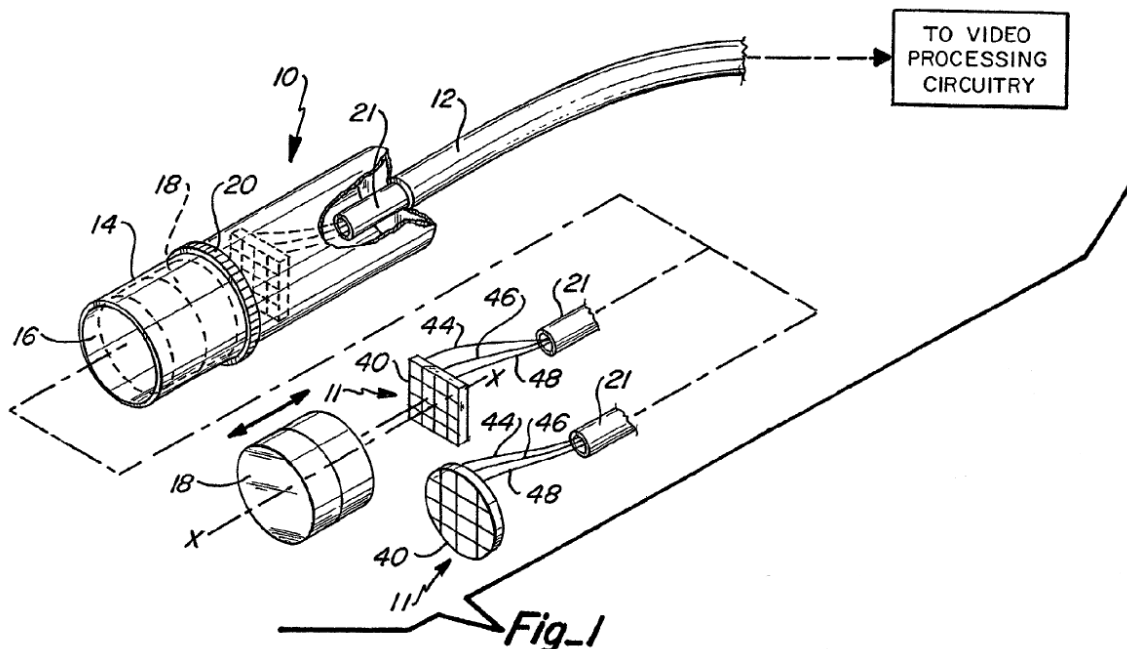


Figure 1 is an enlarged fragmentary partially exploded perspective view of the distal end of a camera module used in conjunction with a PDA. *Id.* at 7,

21–25. As illustrated, camera module 10 incorporates imaging device 11, which includes image sensor 40, housed within outer tube/sheath 14. *Id.* at 8:20–33, 9:36–37.

Figure 9a of the '742 patent is reproduced below.

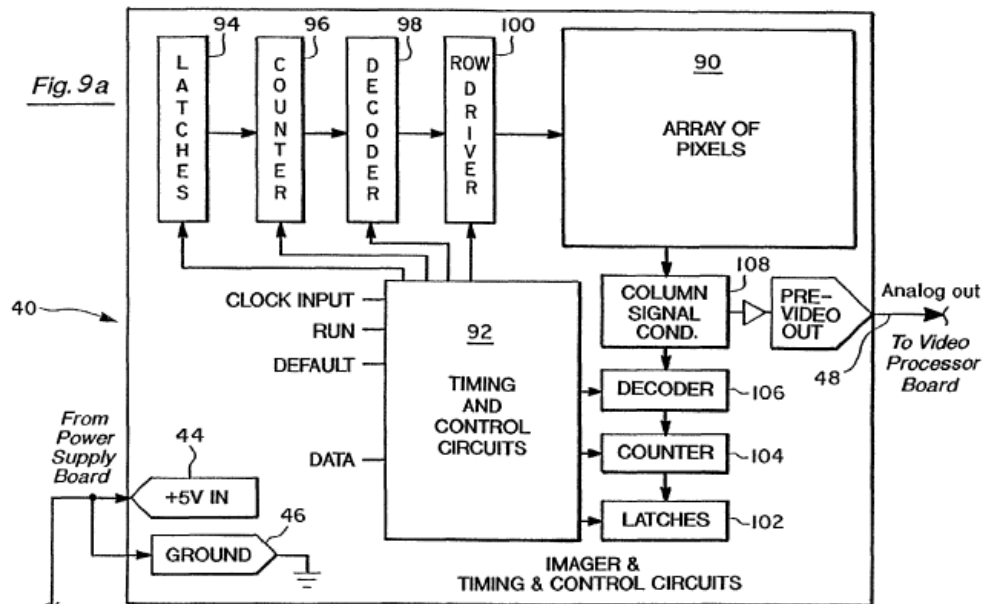


Figure 9a is a schematic diagram of image sensor 40, which contains pixel array 90 and “timing and control circuits 92,” as well as certain other circuitry. *Id.* at 15: 4–6. In describing Figure 9a, the '742 patent explains that timing and control circuits 92 “are used to control the release of the image information or image signal stored in the pixel array.” *Id.* at 16:9–11. When the pixels are arranged in a plurality of rows and columns, “[t]he image information from each of the pixels is first consolidated in a row by row fashion, and is then downloaded from one or more columns that contain the consolidated information from the rows.” *Id.* at 16:12–16. Control of information consolidated from the rows is achieved by latches 94, counter 96, and decoder 98. *Id.* at 16:16–18. The '742 patent summarizes such functionality as follows:

In short, latches 94 will initially allow the information stored in each pixel to be accessed. The counter 96 then controls the amount of information flow based upon a desired time sequence. Once the counter has reached its set point, the decoder 98 then knows to take the information and place it in the serial format. The whole process is repeated, based upon the timing sequence that is programmed. When the row driver 100 has accounted for each of the rows, the row driver reads out each of the rows at the desired video rate.

*Id.* at 16:34–43. Similar functionality is provided for column information by latches 102, counter 104, and decoder 106. *Id.* at 16:45–51.

### *B. Illustrative Claim*

Each of challenged claims 42, 58, and 66 is an independent claim. Claim 42 is illustrative of such challenged claims and is reproduced below, emphasizing a limitation having particular relevance to this Decision.

42. In a PDA having capability to transmit and receive data in a communications network, the improvement comprising:

a video system integral with said PDA for receiving and transmitting video images, and for viewing said images, said video system comprising:

a camera module housing an image sensor therein, said image sensor lying in a first plane and including an array of pixels for receiving images thereon, said image sensor producing a pre-video signal, a first circuit board lying in a second plane and electrically coupled to said image sensor, said first circuit board including ***circuitry means for timing and control of said array of pixels*** and circuitry means for processing and converting said pre-video signal to a desired video format, a transceiver radio element communicating with said first circuit board for transmitting said converted pre-video signal;

a transceiver radio module mounted in said PDA for wirelessly receiving said converted pre-video signal; and  
a video view screen attached to said PDA for viewing said video images, said video view screen communicating with said transceiver radio module, and displaying video images processed by said first circuit board.

Ex. 1001, 24:51–25:7 (emphasis added).

### *C. Evidence*

Petitioner relies on the following references:

Swift	WO 95/34988	Dec. 21 1995	Ex. 1005
Tanaka	US 4,700,219	Oct. 13, 1987	Ex. 1009
Tran	US 6,202,062 B1	Mar. 13, 2001	Ex. 1051
Harris	US 6,009,336	Dec. 28, 1999	Ex. 1052

N. L. Ricquier, I. L. Debusschere, B. L. Dierickx, A. L. Alaerts, J. L. Vlummens, and C. L. Claeys, *The CIVIS sensor: a flexible smart imager with programmable resolution*, CHARGE-COUPLED DEVICES AND SOLID STATE OPTICAL SENSORS IV, M. Morley, ed. (SPIE 1994) (Exs. 1033, 1038) (“Ricquier”).

In addition, Petitioner relies on a Declaration by Dean P. Neikirk, Ph.D. Ex. 1004.

### *D. Asserted Grounds of Unpatentability*

Petitioner challenges claims 42, 58, and 66 on the following grounds.  
Pet. 11.

Claim(s) Challenged	35 U.S.C. § <sup>1</sup>	References
42, 58, 66	103(a)	Harris, Swift, Ricquier
42, 58, 66	103(a)	Harris, Swift, Ricquier, Tanaka
66	103(a)	Harris, Swift, Ricquier, Tran
66	103(a)	Harris, Swift, Riquier, Tran, Tanaka

#### *E. Real Parties in Interest*

The parties identify only themselves as real parties in interest. Pet. 7; Paper 4, 1.

#### *F. Related Matters*

Both parties identify *Cellect, LLC v. Samsung Electronics Co., Ltd.*, No. 1:19-cv-00438 (D. Colo.) as involving the challenged claims. Pet. 7; Paper 4, 1. In addition, both parties note that IPR2020-00559 and IPR2020-00560 also involve the '742 patent. Pet. 8; Paper 4, 1. Petitioner has filed a number of other petitions for *inter partes* review involving patents owned by Patent Owner. See Pet. 7–8.

## II. ANALYSIS

### *A. Legal Principles*

A claim is unpatentable for obviousness 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

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended various provisions of 35 U.S.C. Because the '742 patent was filed before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA versions of those provisions apply.

the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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 skill in the art; and (4) when in evidence, objective indicia of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

### *B. Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir.

1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner asserts that “on or before 8/23/2001, a person of ordinary skill in the art (‘POSITA’) would have had a minimum of a Bachelor’s degree in Electrical Engineering, Physics, or a related field, and approximately two years of professional experience in the field of imaging devices.” Pet. 15. In addition, Petitioner asserts that “[a]dditional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.” *Id.* (citing Ex. 1004 ¶¶ 45–50). Patent Owner does not propose a description of the level of ordinary skill in the art or dispute Petitioner’s articulation.

We adopt Petitioner’s articulation of the level of ordinary skill in the art, but delete the qualifier “a minimum of” for the level of education, to keep that level from being vague and extending to a range that corresponds to the skill level of an expert. Thus, we regard the level of ordinary skill as being at the level of a person with “a Bachelor’s degree in Electrical Engineering, Physics, or a related field, and approximately two years of professional experience in the field of imaging devices.”

### *C. Claim Construction*

For petitions filed after November 13, 2018, as here, the Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the



claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–1317. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

The specification may reveal a special definition given to a claim term by the patentee, or the specification or prosecution history may reveal an intentional disclaimer or disavowal of claim scope by the inventor. *Id.* at 1316. If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). A disavowal, if any, can be effectuated by language in the specification or the prosecution history. *Poly-America, L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016).

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed.

Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

As indicated above, independent claim 42 recites “circuitry means for timing and control of said array of pixels.” Ex. 1001, 24:62–63. The same recitation appears in independent claim 66. *Id.* at 27:35–36. Claim 58 includes a similar recitation, but additionally specifies that the “circuitry means” is “coupled to said array of said pixels.” *Id.* at 26:48–50 (“circuitry means electrically coupled to said array of said pixels for timing and control of said array of pixels”). We hereinafter focus on the recitation of claim 42, “circuitry means for timing and control of said array of pixels,” which is thus an element of all challenged claims.

The Patent Act expressly provides for claim elements to be recited in means-plus-function format:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim *shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.*

35 U.S.C. § 112 ¶ 6 (emphasis added).<sup>2</sup> This rule of construction applies regardless of the tribunal interpreting a claim, e.g., the United States Patent and Trademark Office or a United States District Court. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). Further, the following explanation from the Federal Circuit is instructive:

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<sup>2</sup> Section 4(c) of the America Invents Act (“AIA”) re-designated 35 U.S.C. § 112 ¶ 6 as 35 U.S.C. § 112(f). Because the ’742 patent has a filing date prior to September 16, 2012, the effective date of AIA, we refer to the pre-AIA version of 35 U.S.C. § 112.

Section 112, paragraph 6 allows for a limited exception [to the particularly pointing out and distinctly claiming requirement of Section 112, second paragraph], permitting “a claim [to just] state the function of the element or step, and the ‘means’ covers the ‘structure, material, or acts’ set forth in the specification and equivalents thereof.” [*Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1383 (Fed. Cir. 2011)]. The trade-off for allowing such claiming is that “the specification must contain sufficient descriptive text by which a person of skill in the field of the invention would ‘know and understand what structure corresponds to the means limitation.’” *Id.* at 1383-84 (quoting *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008)).

*Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1317 (Fed. Cir. 2013). Likewise, “[t]he point of the requirement that the patentee disclose particular structure in the specification and that the scope of the patent claims be limited to that structure and its equivalents is to avoid pure functional claiming.” *Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). Indeed, “[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 the price but is attempting to claim in functional terms unbounded by any reference to structure in the specification.” *Medical Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1211 (Fed. Cir. 2003).

In determining whether the language at issue constitutes a means-plus-function recitation under 35 U.S.C. § 112 ¶ 6, we note that the Federal Circuit has explained as follows: “To determine whether § 112, para. 6 applies to a claim limitation, our precedent has long recognized the importance of the presence or absence of the word ‘means.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc). Use of

the word “means” in a claim element creates a rebuttable presumption that 35 U.S.C. § 112 ¶ 6 applied. *Id.* Here, not only is the word “means” used, but also the particular format and phraseology specifically referred to be statute, i.e., means “for performing a specified function.” Thus, there is a presumption that the recitation sets forth a means-plus-function element under 35 U.S.C. § 112 ¶ 6.

That presumption may be rebutted if the claim additionally recites structure sufficient to perform the described functions in their entirety. *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259 (Fed. Cir. 2008). “Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.” *Id.* at 1259–60.

On whether the recitation at issue is a means-plus-function element under 35 U.S.C. § 112 ¶ 6, Petitioner takes both positions, applying both the plain and ordinary meaning and, if § 112 ¶ 6 applies, designating the function and structure. Pet. 15–17, 40–47, 58, 61–62. To support the position that it is not a means-plus-function element, Petitioner makes the following assertion:

With respect to the “circuitry means” terms recited in the Claims, the Federal Circuit has held “when the structure-connoting term ‘circuit’ is coupled with a description of the circuit’s operation, sufficient structural meaning generally will be conveyed to [POSITAs], and §112(6) presumptively will not apply.” *Linear Tech. v. Impala Linear*, 379 F.3d 1311, 1320 (Fed. Cir. 2004).

*Id.* at 15. Patent Owner contends that the recitation at issue here is a means-plus-function element under 35 U.S.C. § 112 ¶ 6. Prelim. Resp. 7–9. We agree with Patent Owner.

*Linear Tech* does not stand for the proposition that the word “circuit” or “circuitry,” if found in a claim, always conveys structure, sufficiently definite and exact, to keep a claim recitation from being a means-plus-function element under 35 U.S.C. § 112 ¶ 6. First, *Linear Tech* involves *absence* of the word “means,” thereby implicating the opposite presumption, namely that the recitation is not a means-plus-function element. *Linear Tech*, 379 F.3d at 1319. On that basis alone, *Linear Tech* is distinguishable.

Second, the specification of the ’742 patent refutes the idea that “circuit” or “circuitry” conveys a specific or exact structural arrangement. The ’742 patent states that “[t]he terms ‘timing and control circuits’ or ‘timing and control circuitry’ as used herein refer to the *electronic components* which control the release of the image signal from the pixel array.” Ex. 1001, 5:2–5 (emphasis added). The words “circuit” and “circuitry” can be no more specific than “timing and control circuits” or “timing and control circuitry.” On the basis of the specification, “circuit” or “circuitry” broadly denotes electronic components and not the identity or specific arrangement of such components.

Third, *Linear Tech* is further distinguishable because there was expert testimony there that one with ordinary skill in the art who has read the claims “would have an understanding of, and would be able to draw, structural arrangements of the circuit elements defined by the claims.”

*Linear Tech.*, 379 F.3d at 1320. Here, Petitioner has provided no such testimony from a technical witness.<sup>3</sup>

For these reasons, Petitioner does not rebut the presumption that the recited “circuitry means” defines a means-plus-function element under 35 U.S.C. § 112 ¶ 6. Accordingly, we conclude that “circuitry means for timing and control of said array of pixels” is, in the context of the ’742 patent, a means-plus-function element under 35 U.S.C. § 112 ¶ 6.

In addressing construction of the recitation as a means-plus-function element, Petitioner identifies the recited function as “timing and control of the array of pixels.” Pet. 16. Patent Owner identifies the recited function as “controlling release of the image signal from the pixel array.” Prelim. Resp. 8. Both Petitioner and Patent Owner are correct. Petitioner is correct because, literally, “timing and control of [the] array of pixels” is expressly stated in the phrase at issue as to what the circuitry means is “for.” Patent Owner is also correct, because the specification of the ’742 patent particularly defines “timing and control circuits” and “timing and control circuitry” as “electronic components which control the release of the image signal from the pixel array.” Ex. 1001, 5:2–5. The function identified by Petitioner is defined in the specification as meaning the function identified by Patent Owner. The parties are effectively referring to the same function in the context of the specification of the ’742 patent.

As for the corresponding structure described in the specification, Petitioner identifies box 92 in Figure 9a, reproduced above, which is labeled

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<sup>3</sup> Petitioner’s technical witness, Dr. Neikirk, does not take a position as to whether the limitation is a means-plus-function limitation. Ex. 1004 ¶¶ 72–74.

“TIMING AND CONTROL CIRCUITS.” Pet. 16. Patent Owner, on the other hand, identifies the corresponding structure as including the counters, decoders, and latches shown in Figure 9a, in addition to box 92. Prelim. Resp. 8 (citing Ex. 1001, 16:9–67). Patent Owner asserts that Petitioner’s identification is deficient as it “lacks the necessary latches, decoders and counters specifically identified in the ’742 Patent and which are needed to control the release of the signals from the image sensor.” *Id.* at 8–9.

For purposes of this Decision, we need not decide whether the counters, decoders, and latches shown in Figure 9a are necessarily a part of the described structure for the recited “circuitry means for timing and control of said array of pixels.” We agree with Petitioner and Patent Owner that Timing and Control Circuits 92 as shown in Figure 9a is at least a part of the described structure for the recitation. Indeed, the specification of the ’742 patent expressly states that “[t]he timing and control circuits are used to control the release of the image information or image signal stored in the pixel array.” Ex. 1001, 16:10–12.

But we need to ask what specific structure would have been recognized by one of ordinary skill in the art as described by box 92. If nothing more specific would have been recognized as described, then box 92 is merely a “black box” and does not convey sufficient structure to correspond, even if in part, to the recitation at issue. *See Augme Technologies, Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1338 (Fed. Cir. 2014) (“Simply disclosing a black box that performs the recited function is not a sufficient explanation of the algorithm required to render the means-plus-function term definite.”); *cf. Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1338 (Fed. Cir. 2008) (“the absence of internal circuitry [for

a black box] in the written description does not automatically render the claim indefinite”). “[T]he specification must contain sufficient descriptive text by which a person of skill in the field of the invention would ‘know and understand what structure corresponds to the means limitation.’” *Typhoon Touch Technologies, Inc. v. Dell, Inc.*, 659 F.3d 1376, 1383–84 (Fed. Cir. 2011) (quoting *Finisar Corp. v. DirecTV Grp., Inc.* 523 F.3d 1323, 1340 (Fed. Cir. 2008)). That is not the case here, as discussed below.

The specification of the ’742 patent does not describe what is contained within box 92. Nor has Petitioner submitted any testimony from a technical witness what specific circuitry arrangement one of ordinary skill in the art would have understood is described by the disclosure, such as from the label “TIMING AND CONTROL CIRCUITS” and box 92’s interaction with other components in Figure 9a. Further, as noted above, the specification of the ’742 patent describes “timing and control circuits” broadly as “electronic components” rather than as any specific circuit arrangement or class of circuit arrangements. *See* Ex. 1001, 5:2–5.

For the foregoing reasons, nothing sufficiently specific is described by box 92. Merely stating that it contains “electronic components” in general does not convey sufficiently specific corresponding structure for purposes of supporting a means-plus-function recitation in the challenged claims. We thus determine that, for the means-plus-function element “circuitry means for timing and control of said array of pixels,” the specification of the ’742 patent does not sufficiently describe a corresponding structure.

We are cognizant that the specification of the ’742 patent includes the following paragraph:



A further discussion of the timing and control circuitry which may be used in conjunction with an active pixel array is disclosed in U.S. Pat. No. 5,471,515 and is also described in an article entitled “Active Pixel Image Sensor Integrated With Readout Circuits” appearing in *NASA Tech Briefs*, October 1996, pp. 38 and 39. This particular article is also incorporated by reference.

*Id.* at 17:1–7. The patent referred to, U.S. Patent No. 5,471,515, is also incorporated by reference into the ’742 patent. *Id.* at 15:6–9. This paragraph does not provide specific structural description for what goes into box 92 of Figure 9a. Further, “material incorporated by reference cannot provide the corresponding structure necessary to satisfy the definiteness requirement for a means-plus-function clause.” *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1301 (Fed Cir. 2005).

Accordingly, the scope of challenged claims 42, 58, and 66 is uncertain, and we do not know what specific structure corresponds to “circuitry means for timing and control of said array of pixels.”

*D. Obviousness of Claims 42, 58, and 66 over Harris, Swift, and Ricquier*

Petitioner challenges claims 42, 58, and 66 as unpatentable under 35 U.S.C. § 103(a) over Harris, Swift, and Ricquier. Pet. 18–78. Because, as we determine above, the specification of the ’742 patent describes no corresponding structure sufficiently specific for the means-plus-function element “circuitry means for timing and control of said array of pixels,” it is uncertain what the applied prior art must teach or suggest to render obvious any challenged claim. If the scope of the claims cannot be determined without undue speculation, as is the case here, the differences between the claimed invention and the prior art cannot be ascertained. *See BlackBerry*

*Corp. v. MobileMedia Ideas, LLC*, IPR2013-00036, Paper 65, 19–20 (PTAB Mar. 7, 2014) (citing *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) and reasoning that “the prior art grounds of unpatentability must fall, *pro forma*, because they are based on speculative assumption as to the meaning of the claims”). Thus, Petitioner has shown no reasonable likelihood that it would prevail in establishing obviousness of any challenged claim over Harris and Adair.

*E. Obviousness of Claim 66 over Harris, Swift, Ricquier, and Tran*

Petitioner challenges claim 66 as unpatentable under 35 U.S.C. § 103(a) over Harris, Swift, Ricquier, and Tran. Pet. 78–80. For the same reasons discussed above in the context of the Harris, Swift, and Ricquier challenge, Petitioner has shown no reasonable likelihood that it would prevail in establishing obviousness of claim 66 over Harris, Swift, Ricquier, and Tran.

*F. Tanaka Grounds*

Petitioner challenges claims 42, 58, and 66 as unpatentable under 35 U.S.C. § 103(a) over Harris, Swift, Ricquier, and Tanaka, and claim 66 as unpatentable under 35 U.S.C. § 103(a) over Harris, Swift, Ricquier, Tran, and Tanaka. Pet. 80–86. For the same reasons discussed above in the context of the Harris, Swift, and Ricquier challenge, Petitioner has shown no reasonable likelihood that it would prevail in establishing obviousness of claim 66 over Harris, Swift, Ricquier, and Tanaka, or over Harris, Swift, Ricquier, Tran, and Tanaka.

*G. Patent Owner's Arguments Based on 35 U.S.C. § 325(d)*

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 325(d) to deny the Petition. Prelim. Resp. 15–57. We do not reach that issue because we have determined that Petitioner does not show a reasonable likelihood of prevailing in establishing unpatentability of any claim, and we deny institution on that basis.<sup>4</sup>

III. CONCLUSION

Petitioner has not shown a reasonable likelihood of prevailing in establishing patentability of at least one challenged claim of the '742 patent.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that the Petition is denied, and no *inter partes* review is instituted.

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<sup>4</sup> Patent Owner's Preliminary Response also argues that we should exercise discretion under 35 U.S.C. § 314(a) to deny the Petition based on the advanced stage of related litigation, but Patent Owner subsequently withdrew that argument after the district court stayed that litigation. Prelim. Resp. 57–66; Paper 11.

IPR2020-00561  
Patent 6,982,742 B2

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