

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD CO.,
Petitioner,

v.

U.S. PHILIPS CORPORATION, ORANGE, S.A., TDF SAS, and
INSTITUT FÜR RUNDFUNKTECHNIK GMBH,
Patent Owner.

Case IPR2015-01505
Patent 5,777,992

Before BRIAN J. McNAMARA, SCOTT A. DANIELS, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

BACKGROUND

Hewlett-Packard Co. (“Petitioner”) filed a Petition, Paper 2 (“Pet.”), to institute an *inter partes* review of claims 1–21 (the “challenged claims”) of U.S. Patent No. 5,777,992 (“the ’992 Patent”). 35 U.S.C. § 311. U.S. Philips Corporation, Orange, S.A., TDF SAS, and Institut Für Rundfunktechnik GMBH (collectively, “Patent Owner”) timely filed a Preliminary Response, Paper 14 (“Prelim. Resp.”), contending that the Petition should be denied as to all challenged claims. We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Having considered the arguments and the associated evidence presented in the Petition and the Patent Owner Preliminary Response, for the reasons described below, we decline to institute an *inter partes* review of any of the challenged claims.

REAL PARTIES IN INTEREST

Petitioner identifies itself as the only real party-in-interest. Pet. 1

PENDING LITIGATION AND RELATED PROCEEDINGS

The Petition states that ’992 Patent has been asserted in *Audio MPEG, Inc. v. Hewlett-Packard Co.*, No. 2:15-cv-00073 (E.D. Va.). Pet. 1; Paper 6, 2. Petitioner also identifies IPR2015-01507 (concerning U.S. Patent No. 5,323,396) as filed concurrently with the Petition that is the subject of this Petition.

THE '992 PATENT (EXHIBIT 1001)

The '992 Patent concerns a decoder, and a receiver incorporating a decoder, for decoding an encoded digital signal that has been obtained by encoding a wideband digital signal of a specific sampling frequency F_s , for example, a digital audio signal. Ex. 1001, col. 1, ll. 20–23, 33–34. The encoded digital signal comprises consecutive frames, where each frame has a plurality of information packets, each packet having N bits. *Id.* at col. 1, ll. 24–27. The information packets are fictitious units used to define the length of a frame, so they need not be explicitly discernible in the information stream of the encoded digital signal. *Id.* at col. 4, ll. 16–19. The frames are divided into B information packets related to a calculated value P to obtain faithful replica of the original wideband signal. *Id.* at col. 2, ll. 22–25. The purpose of dividing the wideband signal into B information packets is that, for a wide-band digital signal of a sampling frequency F_s , the average frame rate of the encoded digital signal received is such that the duration of a frame in the digital signal corresponds to the duration occupied by n_s samples of the wide-band signal. *Id.* at col. 2, ll. 25–47. A frame also includes synchronization information. *Id.* at col. 1, ll. 28–29.

The decoder has an input for receiving the encoded digital signal and is adapted to convert it and output a replica of the wideband digital signal. *Id.* at col. 1, ll. 33–34.

Claim 1 reproduced below, is illustrative.

1. A decoder for decoding an encoded digital signal, wherein the encoded digital signal represents a wideband digital signal having a sampling frequency F_s , and the encoded digital signal comprises consecutive frames, each frame comprising a plurality of information packets, each information packet comprising N bits, N being larger than 1, a frame comprising at least a first frame portion including synchronization information; and wherein the decoder comprises:

an input for receiving the encoded digital signal,
means for converting the encoded digital signal into a replica of the wideband digital signal,
and

an output for supplying the replica of the wideband digital signal,

characterized in that said converter is arranged for converting a signal having a number of information packets in one frame determined according to the formula

$$P = \frac{Br}{N} \times \frac{n_s}{F_s}$$

where BR is the bitrate of the encoded digital signal and n_s is the number of samples of the wideband digital signal whose corresponding information in the encoded digital signal is included in one frame of the encoded digital signal, and

if P is an integer, the number of information packets in one frame is P , and

if P is not an integer, the number of information packets in a number v of the frames is P' , where P' is the highest integer whose value is less than P ; and the number of information packets in a number w of the other frames is equal to $P'+1$, the numbers v and w being selected such that the average frame rate of the encoded digital signal is substantially equal to F_s/n_s .

ART CITED IN PETITIONER’S CHALLENGES

Petitioner cites the following references in its challenges to patentability:

Reference	Designation	Exhibit No.
J.P. Chambers, <i>Signalling in Parity: A Brief History</i> , British Broadcasting Corp. (BBC) Research Department Report 1985/15 (Dec. 1985) (“Chambers”)	Chambers	Ex. 1014
International Organization for Standardization, Fifth MPEG Meeting Report, ISO-IED/JTC1/SC2/WG8N (Feb. 1989) (“MPEG 89-051”)	MPEG 89-051	Ex. 1010
G. Stoll, et al., <i>Masking-Pattern Adapted Subband Coding: Use of the Dynamic Bit-Rate Margin</i> (“MASCAM 1988”)	MASCAM 1988	Ex. 1032

CHALLENGES ASSERTED IN PETITION

Claims	Statutory Basis	Challenge
Claims 1–11 and 19–21	35 U.S.C. § 103	Obvious over the combination of Chambers and MPEG 89-051
Claims 12–18	35 U.S.C. § 103	Obvious over the combination of Chambers, MPEG 89-051, and MASCAM 1988

CLAIM CONSTRUCTION

For the reasons discussed below, we do not reach the obviousness issues, and no claim construction is necessary

ANALYSIS

Patentability challenges in an *inter partes* review must be “on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Petitioner’s asserted grounds of unpatentability are based on three non-patent references: Chambers, MPEG 89-051, and MASCAM 1988. Pet. 2–3. Patent Owner asserts that Petitioner has not provided sufficient evidence to show that any of these references is a printed publication. Prelim. Resp. 8–18. *Legal Standard Regarding Prior Art Printed Publications*

Petitioner has the initial burden of production of evidence establishing that asserted references are applicable as prior art. *Dynamic Drinkware LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015).

We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). The determination of whether a document is a “printed publication” under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004); *see also In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986) (holding that “public accessibility” is the touchstone in determining whether a reference is a “printed publication” under § 102).

To qualify as a printed publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*,

583 F.3d 1307, 1311 (Fed. Cir. 2009) (citation omitted). The party seeking to introduce the reference “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981) (citation omitted); *see also Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1333 (Fed. Cir. 2009) (holding that “a document is publicly accessible if it ‘has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it’” (citing *In re Wyer*, 655 F.2d at 226)).

Whether Chambers is Available as Prior Art

Petitioner asserts that Chambers “qualif[ies] as prior art under at least 35 U.S.C. § 102(b). Specifically, Chambers . . . was published in December 1985, . . . more than a year before the earliest priority date of the ‘396 Patent.”¹ Pet. 3. The Petition, however, points to no specific evidence supporting its assertion that Chambers was published in 1985.²

Chambers was cited in an ex parte reexamination request for the ’992 Patent filed by a third party, Timothy J. Maier. Ex. 1036, 145–168. The

¹ We understand Petitioner to be referring to the ’992 Patent that is the subject of this proceeding.

² In an email to the Board on December 14, 2015 seeking authorization to file a Reply to Patent Owner’s Preliminary Response, Petitioner asserted that it “was surprised to see [Patent Owner’s] arguments” regarding the prior art status of Chambers and MASCAM 1988 “[b]ecause Patent Owner[] had not ever disputed that Chambers was prior art in previous ex parte reexams, and because Patent Owner[] had submitted MASCAM 1988 as prior art in previous Information Disclosure Statements.” We did not authorize additional briefing on this issue. *See* Paper 15.

reexamination request states only that “Chambers was published in 1985, five years prior to the ’992 patent’s filing date.” *Id.* at 149. There is no other evidence in the reexamination file concerning Chambers’ status as prior art. In the reexamination, Patent Owner elected to argue on the merits that the claims of the ’992 Patent were patentable over Chambers. Ex. 1036, 346–352. At the end of the reexamination, the claims were confirmed. *Id.* at 2012. Patent Owner’s choice to address Chambers on the merits rather than challenge its prior art status does not relieve Petitioner of its initial burden to put forth evidence in this *inter partes* proceeding that Chambers is available as prior art to the ’992 Patent.

On its face, Chambers includes a “December 1985” date, as well as a “BBC RD 1985/15” indication. Ex. 1014,³ 1. The fact that a date is printed on the face of a reference, without more, is not enough to establish that the reference was publicly accessible on that date. *See LG Elecs., Inc. v. Advanced Micro Devices, Inc.*, Case IPR2015-00329, slip op. at 13 (PTAB July 10, 2015) (Paper 13); *see also Google Inc. v. ART+COM Innovationpool GmbH*, Case IPR2015-00788, slip op. at 8 (PTAB Sept. 2, 2015) (Paper 7) (“[T]his bare date, without more, does not provide any information about the date [the reference] was publicly accessible.”). Further, the unsupported testimony of Dr. Jayant that “[Chambers] was published in December 1985” (Ex. 1004 ¶ 94) also is insufficient to demonstrate that Chambers was published in December 1985.

Patent Owner argues that the Petition includes no arguments or evidence regarding “whether or how Chambers was distributed, or, if it was

³ Citations to Ex. 1014 are to page numbers added by Petitioner at the bottom of each page.

distributed, whether that distribution was limited or subject to any confidentiality restrictions.” Prelim. Resp. 12. Although Chambers is dated December 1985 on its face, Petitioner provides no evidence concerning when it was first published or distributed. In particular, Petitioner provides no evidence that the British Broadcasting Corporation (“BBC”) made Chambers publicly available in 1985, or how an interested person would have located it. Petitioner likewise provides no evidence concerning the general publication or distribution policies of the BBC.

Further, as noted by Patent Owner, Chambers includes other information within the document itself that is inconsistent with a December 1985 publication date. *See* Prelim. Resp. 13. For example, Chambers includes a copyright notice that is nearly 20 years after the alleged December 1985 publication date—namely, “© BBC 2004”. Ex. 1014, 6. Further, the “References” section of Chambers includes at least one citation to a paper apparently published in February 1986, which also is after the alleged December 1985 publication date. Ex. 1014, 18. These dates are inconsistent with the December 1985 date printed on the face of the document, and cast further doubt as to the public availability thereof as of December 1985. Petitioner, however, makes no attempt to address or explain these inconsistencies.

Accordingly, based on the evidence provided in the Petition, we conclude Petitioner has not made a sufficient threshold showing that Chambers is available as prior art in this proceeding.

Whether MPEG 89-051 is Available as Prior Art

We reach a similar conclusion with respect to MPEG 89-051. The Petition states that MPEG 89-051 was made publicly available in February

1989, but the Petition does not discuss how this document was published or distributed.⁴ Pet. 3. Petitioner also does not explain how a document allegedly published in February 1989 includes an attachment, i.e., Annex V, dated March 1989. Ex. 1010, 12. Based on the evidence in the Petition, we conclude that Petitioner has not made a sufficient threshold showing that MPEG 89-051 is available as prior art in this proceeding.

Whether MASCAM 1988 is Available as Prior Art

Petitioner also asserts that MASCAM 1988 was published in 1988, but the Petition does not discuss how this document was published or distributed.⁵ Pet. 3. MASCAM 1988 was submitted by Patent Owner in an Information Disclosure Statement during the reexamination of the '992 Patent discussed above. Ex. 1036, 986. Patent Owner's Information Disclosure Statement specifically states, however, that its submission is not an admission that each or all of the listed documents constitute prior art and that Patent Owner reserves the right to present relevant facts and law concerning the status of such documents, if applied by the Examiner. *Id.* at 970–971. Patent Owner's choice to submit MASCAM 1988 in an Information Disclosure Statement in an earlier reexamination does not relieve Petitioner of its initial burden to put forth evidence in this *inter*

⁴ The Declaration of Nikil Jayant, Ex. 1004 (“Jayant Decl.”), ¶¶ 65–78, 103, provides some background concerning the workings of the MPEG Working Group, but the Petition does not demonstrate that distribution to members of the working group constitutes sufficient distribution to make MPEG 89-051 a printed publication.

⁵ The Jayant Declaration provides some background concerning the workings of the MPEG Working Group, but the Petition does not demonstrate that distribution to members of the working group constitutes sufficient distribution to make MASCAM 1998 a printed publication. Jayant Decl. ¶ 115–118.

partes proceeding that MASCAM 1988 is available as prior art. Based on the evidence in the Petition, we conclude that Petitioner has not made a sufficient threshold showing that MASCAM 1988 is available as prior art in this proceeding.

SUMMARY

Petitioner has not shown a reasonable likelihood that it will succeed in any of its challenges because Petitioner has not made a threshold showing that any of the references cited in those challenges is available as prior art. Therefore, we decline to institute *inter partes* review.

ORDER

Inter partes review of the claims of the '992 Patent challenged by Petitioner is not instituted.

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