

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PERSONALIZED MEDIA COMMUNICATIONS, INC.

Appeal 2007-4044
Reexamination Controls 90/006,697 and 90/006,841 (merged)
Patent 4,704,725
Technology Center 3900

and

Appeal 2008-0334
Reexamination Control 90/006,800
Patent 4,694,490
Technology Center 3900

Decided: December 18, 2008

Before JOHN C. MARTIN, LEE E. BARRETT, and MARK NAGUMO,
Administrative Patent Judges.

MARTIN, *Administrative Patent Judge.*

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DECISION ON REQUEST FOR REHEARING¹

Appellant requests rehearing of our holding that the policy set forth in *Ex parte Papst-Motoren*, 1 USPQ2d 1655 (BPAI 1986), of construing expired patent claims undergoing reexamination in a manner that will preserve their validity is limited to resolving ambiguities in the claim language (Decision 29-30). Appellant also seeks rehearing of our conclusion that “user specific” is broad enough to read on the Mode 2 captioning described in Appendix B of the CBS Petition (*id.* at 45).

WHAT IS THE APPROPRIATE STANDARD FOR CONSTRUING CLAIMS OF AN EXPIRED PATENT UNDERGOING REEXAMINATION?

Briefly, because it is illogical to construe claims that are not accorded a presumption of validity more leniently than claims that are accorded a presumption of validity, we reject Appellant’s contention that we have improperly narrowed the construction of expired claims in the reexamination of an expired patent. A detailed analysis follows.

The ‘490 and ‘725 patents under reexamination expired in September 2004 and November 2004, respectively, after reexamination was ordered by the Examiner.

The question of how to construe claims of an expired patent undergoing reexamination has not been addressed by the Federal Circuit.

¹ “Request for Rehearing Under 37 C.F.R. § 41.52.”

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In decisions involving the reexamination of unexpired patents, the court has held that “[c]laims are given ‘broadest reasonable interpretation, consistent with the specification, in reexaminations proceedings.’” *In re Trans Texas Holdings, Corp.*, 498 F.3d 1290, 1298 (Fed. Cir. 2007) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). *Accord*, *In re Swanson*, 540 F.3d 1368, 1377-78 (Fed. Cir. 2008); *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hiniker Co.*, 150 F.3d 1362, 1368 (Fed. Cir. 1998). The *Yamamoto* court explained that the “broadest reasonable interpretation” claim construction standard for patent claims under reexamination is based on a patentee’s right to amend the patent claims during a reexamination proceeding:

The PTO broadly interprets claims during examination of a patent application since the applicant may “amend his claims to obtain protection commensurate with his actual contribution to the art.” *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550, 56 CCPA 1381, 1395 (1969). This approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified. Applicants’ interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language. *Id.* at 1405 n.31, 162 USPQ at 550 n. 31, 56 CCPA at 1396 n. 31.

An applicant's ability to amend his claims to avoid cited prior art distinguishes proceedings before the PTO from proceedings in federal district courts on issued patents. When an application is pending in the PTO, the applicant has the

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ability to correct errors in claim language and adjust the scope of claim protection as needed. This opportunity is not available in an infringement action in district court

The same policies warranting the PTO's approach to claim interpretation when an original application is involved have been held applicable to reissue proceedings because the reissue provision, 35 U.S.C. § 251, permits amendment of the claims to avoid prior art. [Citation omitted.] The reexamination law . . . gives patent owners the same right: [quoting 35 U.S.C. § 305 (1982)].

Appellant therefore had an opportunity during reexamination in the PTO to amend his claims to correspond with his contribution to the art. The reasons underlying the PTO's interpretation of the claims in reissue proceedings therefore justify using the same approach in reexamination proceedings.

Yamamoto, 740 F.2d at 1571-72.

Ex parte Papst-Motoren involved reexamination of a patent that expired prior to the date of the Board's initial (unpublished) decision affirming the Examiner's rejection. In its decision on reconsideration, the Board held that because the claims of an expired patent under reexamination cannot be amended,² they should, if necessary, be given a construction that

² The Board cited § 1.530(d) (1986), which read in pertinent part: "No amended or new claims may be proposed for entry in an expired patent. Moreover, no amended or new claims will be incorporated into the patent by certificate issued after the expiration of the patent." Provisions to the same effect now appear in § 1.530(j) (2008), which provides: "No amended or new claims may be proposed for entry in an expired patent. Moreover, no (Continued on next page.)

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will render them valid rather than being given the broadest reasonable interpretation:

[I]n reexamination proceedings in which the PTO is considering the patentability of claims of an expired patent which are not subject to amendment, a policy of liberal claim construction may properly and should be applied. Such a policy favors a construction of a patent claim that will render it valid, i.e., a narrow construction, over a broad construction that would render it invalid. *See Roberts Dairy Co. v. United States*, 530 F.2d 1342, 1367 (Ct.Cl. 1976). *See, also, ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, *supra*, 732 F.2d [1572,] 1577 [(Fed. Cir. 1983)].

Papst-Motoren, 1 USPQ2d at 1656. *Accord Ex parte Bowles*, 23 USPQ2d 1015, 1017 (BPAI 1991).³ In so holding, the Board explained in *Papst-Motoren* that it was narrowly construing express claim language rather than improperly reading limitations from the specification into the claims:

We are mindful that it has been held improper for “inferential limitations” to be added to a claim. *In re Priest*, 582 F.2d 33 (CCPA 1978). In the present case, however, we are not adding inferential limitations to claim 4. Rather, because claim 4 is no longer subject to amendment we are interpreting it narrowly, as discussed above, and construing express claim language, in the manner urged by appellant, as

amendment, other than the cancellation of claims, will be incorporated into the patent by certificate issued after the expiration of the patent.”

³ This *Papst-Motoren* policy is also mentioned in *Bamberger v. Cheruvu*, 55 USPQ2d 1523, 1526 (BPAI 1998).

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requiring an enlargement of the second passageway which necessarily includes the corners of the polygonal housing.

1 USPQ2d at 1657.

Although *Papst-Motoren* and *Bowles* are not binding on the Board,⁴ we held (Decision 29-30) that for the reasons stated therein we would construe Appellant’s expired patent claims, if possible, to preserve their validity, bearing in mind the following admonition in *Phillips v. AWH Corp.*:

While we have acknowledged the maxim that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction. *See Nazomi Communications [Inc. v. ARM Holdings, PLC]*, 403 F.3d [1364,] 1368-69 [(Fed. Cir. 2005)]. Instead, we have limited the maxim to cases in which “the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous.” *Liebel-Flarsheim [Co. v. Medrad, Inc.]*, 358 F.3d [898,] 911 [(Fed. Cir. 2004)] [other citations omitted].

Phillips, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (*en banc*). We also pointed out that “it is improper to use the possible invalidity of the claims, if broadly

⁴ As explained at pages 5-6 of *Board of Patent Appeals and Interference Standard Operating Procedure (Revision 7), Publication of Opinions and Binding Precedent (SOP 2)* (available at <http://www.uspto.gov/web/offices/dcom/bpai/stdproced.html>), prior Board decisions are binding precedent only if designated “precedential” in accordance with the procedures contained in the current version of SOP 2 or in any earlier version of SOP 2. Neither of *Papst-Motoren* and *Bowles* has been so designated.

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construed, over the prior art as the reason for construing them narrowly,” citing *The Saunders Group, Inc. v. ComforTrac, Inc.*, 492 F.3d 1326, 1335 (Fed. Cir. 2007) (Decision 30), and held that “Appellant is therefore incorrect to argue that “where two reasonable definitions exist for a claim term, one of which renders the claim valid and other renders the claim invalid, the law is that the more narrow definition should be applied to an expired patent in reexamination.” Decision 30-31.

Appellant argues that “[t]he Decision relies on precedent which is inapplicable and is inconsistent with reexamination procedures” (Req. Reh’g 3). Specifically, after correctly noting (*id.* at 3-4) that the claims at issue in *Phillips* were subject to the presumption of validity under 35 U.S.C. § 282, which was held to be inapplicable to *ex parte* reexamination proceedings in *In re Etter*, 756 F.2d 852 (Fed. Cir. 1985) (*en banc*), Appellant argues:

The Decision fails to explain why the reasoning in *Phillips* is applicable to an *ex parte* reexamination proceeding in which 35 U.S.C. § 282 does not apply. Indeed, *Phillips* itself explains the relationship of its analysis to the presumption of validity:

The applicability of the doctrine [that claims should be construed to preserve their validity] in a particular case therefore depends on the strength of the inference that the PTO would have recognized that one claim interpretation would render the claim invalid, and the PTO would not have issued the patent assuming that to be the proper construction of the term.

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Phillips at 1327, 75 U.S.P.Q.2d at 1337. The policy of narrow claim construction during the reexamination of expired patents is not based on any inference of what the Examiner, during the original prosecution, may or may not have recognized. Rather, the policy of narrow claim construction is based on an acknowledgement that the patent owner's claims encompass patentable subject matter that the patent owner would ordinarily have a right to protect. Where the patent owner is precluded from amending the claims under examination, a policy of broad claim construction eliminates the patent owner's ability to protect his invention. A policy of narrow claim construction is necessary to protect the patent owner's acknowledged patentable subject matter.

Req. Reh'g 4.

To the extent Appellant is attempting to distinguish *Phillips* from *Papst-Motoren* on the ground that *Phillips* concerns patent claims that are subject to the § 282 presumption of validity, which does not apply to claims under reexamination, we are unpersuaded. In the first place, *Etter* involved the reexamination of unexpired patent claims and did not address whether the § 282 presumption applies to the reexamination of expired claims. Second, assuming for the sake of argument that the § 282 presumption does not apply to the reexamination of expired patent claims, inasmuch as under *Phillips* a patent claim that *is* subject to the § 282 presumption can be narrowly construed only to the extent necessary to resolve an ambiguity, it would seem to follow that a claim that is *not* subject to the § 282 presumption cannot be given an even narrower construction, as argued by Appellant.

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In the above-quoted passage, Appellant also appears to be arguing that *Phillips*'s admonition concerning the doctrine of preserving validity is inapplicable to the reexamination of expired patent claims because *Phillips* fails to address the problem addressed by *Papst-Motoren*, which is that expired claims cannot be amended. However, the same situation exists during invalidity and infringement litigation involving expired patent claims, which cannot be amended by reissue⁵ or through reexamination.⁶ Appellant has not identified, and we are unaware of, any authority for construing expired patent claims involved in such litigation more narrowly than unexpired patent claims.

Appellant's arguments fail to recognize that the point of *Papst-Motoren* is that expired patent claims under reexamination should be given a construction similar to the construction they would receive during litigation in a district court. In asking us to disregard *Phillips*, Appellant is seeking a narrower claim construction than would be adopted by a district court acting in accordance with contemporary claim construction principles.

For the foregoing reasons, we remain of the view that the claim language of an expired patent undergoing reexamination can be construed

⁵ A reissue patent can be issued only for the unexpired part of the term of the original patent. 35 U.S.C. § 251 (2002).

⁶ 37 C.F.R. § 1.530(j) (2008).

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more narrowly than its ordinary and customary meaning only to the extent required to resolve an ambiguity.

Appellant argues that even assuming we are correct on this point, the claim language is ambiguous and thus appropriate for a narrow construction because

[t]he breadth of a term, however, can and often does vary across its ordinary and accustomed meaning, which is exactly the type of “ambiguity” present here and which should be resolved using the Board's long-standing policy favoring a narrow construction of claim limitations in an expired patent. Thus, even under the Decision's incorrect limitation of the policy favoring a narrow construction to resolving ambiguities, the policy still should have been applied here.

Req. Reh’g 5. While it is true that “[t]he breadth of a term . . . can . . . vary across its ordinary and accustomed meaning” (*id.*), such a circumstance does establish an ambiguity. In that situation, the claims terms are to be given the broadest reasonable definition consistent with the applicant’s disclosure. Nor does the fact that “user specific” is a broad term render the claim ambiguous. *See In re Miller*, 441 F.2d 689, 693 (CCPA 1971) (“breadth is not to be equated with indefiniteness”).

Appellant therefore has failed to show that “user specific” is ambiguous and thus appropriate for a narrow construction under *Phillips*.

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HOW SHOULD “USER SPECIFIC” BE CONSTRUED?

Appellant correctly points out that

[w]ith regard to the term “user specific,” . . . information generally can be classified along a continuum - from information that is unique to an individual to information that is generic to everyone. The question to be addressed is where along this continuum is the dividing line between information that is “user specific” and information that is not “user specific” and in particular whether the CBS Petition teaches the creation and display of information that falls on the “user specific” side of the dividing line.

Req. Reh’g 10. We also agree with Appellant that “[w]hen the intrinsic evidence -- the claim language, the specification, and the prosecution history -- is considered, it is clear that the term ‘user specific information’ must mean information relating to, or personal to, a particular user.” Decision 35. However, we continue to disagree with Appellant regarding what it means for an item of information to be personal to a particular user.

Based on our review of the other claim language (*id.* at 32-33), the dictionary definitions of “user” and “specific” (*id.* at 34-35), the Specification (including the “Wall Street Week” example) (*id.* at 35-37), and the prosecution history (*id.* at 37-40), we held that “user specific” is “broad enough to read any information (or signal) that reflects something personal about a particular user, such as property ownership, interests, preferences, or capabilities, and implies no restriction on the number of users to whom the

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information (or signal) can be considered to be personal.” *Id.* at 41.⁷ Appellant questions our inclusion of “interests” in this interpretation, arguing that a user’s viewing of the “Wall Street Week” program necessarily reflects the interests of that user and that for this reason “user specific” as defined to include “interests” fails to distinguish between the studio-generated graphics representing the Dow Jones Industrials and NASDAQ indices, which are communicated to all “Wall Street Week” viewers, and the graphic that represents the user’s own stock portfolio (Req. Reh’g 14-15). We are persuaded by this reasoning that “interests” is too broad a term to serve as an example of information that is personal to a particular user in the sense required by “user specific.” For the same reason, we conclude that “preferences,” which we included as another example of personal information, is likewise too broad. Consequently, we are withdrawing our reliance on “interests” and “preferences” in the above-quoted interpretation of “user specific” as “broad enough to read on any information (or signal) that reflects something personal about a particular user, such as property ownership, interests, preferences, or capabilities, and implies no restriction on the number of users to whom the information (or signal) can be considered to be personal.” Decision 41. However, as explained below, we do not need to rely on “interests” or “preferences” to explain why

⁷ The claims of the ‘729 patent recite “user specific signals.” The claims of the ‘490 patent recite “user specific information.”

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Appellant's arguments that the term "user specific" would not have been construed broadly enough to read on Mode 2 captioning are not persuasive.

Before addressing those reasons, we note that, as explained at pages 42-43 of the Decision, Appendix B explains that Mode 2 captioning involves sending to all of the television receivers (e.g., during the vertical blanking interval) data representing captions having various levels and in various languages. A decoder at the receiver stores the data that corresponds to any caption the viewer wishes to see. *See* App. B at 72 ("When many captions are sent, at various levels and in various languages, forming classes, all varieties for a given class of captions are sent far enough ahead to allow the decoder to store the one selected."). We agreed with the Examiner that "user specific" as used in the claims is broad enough to read on this Mode 2 captioning feature because it permits a particular television viewer to select and display captions in a language that reflects "that particular user's *personal* language and level capabilities." Decision 44 (quoting Answer 16) (emphasis added in Decision).

Appellant argues that

[t]he Decision relies on the argument that a displayed Mode 2 caption reflects the user's personal language capabilities. However, there is no teaching or suggestion in the CBS Petition that this is correct. Rather, it appears that each user may select any one of the available classes of captioning without regard to the user's personal language capabilities. Each user may select captioning that the user is capable of reading or may select captioning that the user is not capable of reading. There is no

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correlation set forth in the CBS Petition between the class of Mode 2 captioning selected and the capabilities of the user selecting it. Of course, a user is likely to select a captioning language that reflects his language reading capability. However, a user is also likely to select television programs that reflect the user's interests.

Req. Reh'g 11. This argument is unconvincing because Appellant has not identified any claim language that precludes the claimed "user specific" information from being read on only those television receivers that are being used to display Mode 2 captions in one or more foreign languages that are understood by (and thus reflect the personal language capabilities of) their respective viewers.

Appellant also argues that

[a]lthough there is no set number of users that may have identical 'user specific' information, it should be clear that all the user's [*sic*] of a system cannot have the same 'user specific' information. Similarly, it must be possible for 'user specific' information to be unique to the user. . . .

. . . There is a clear difference between a locally specified and generated graph based upon the user's stock performance as described in the specification and a class of captioning generally broadcast to all users as described in the CBS Petition. As each user is unique, it should be recognized that information generated to reflect something personal about *a particular* user can be unique but is not necessarily unique to the user. A user's stock portfolio can be unique to a particular user while a class of captioning selected from a set of options cannot.

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Req. Reh'g 12. It is true that in contrast to Mode 2 captioning, which involves transmitting the same captioning data to all of the receiver stations, each of which can be used to store the captioning data that represents the class of captions of interest to the user, the receiver in Appellant's "Wall Street Week" example locally generates the data that represent the group of stocks in the viewer's stock portfolio. Specifically, in the "Wall Street Week" example the data that is used to generate the graphical overlay representing the user's stock portfolio is generated locally by a microcomputer (205 in Fig. 6C) that receives the daily closing prices for individual stocks ('725 Specification, col. 19, ll. 40-46). However, construing the term "user specific" as requiring local generation of "user specific" information and signals clearly amounts to improperly reading limitations from the Specification into the claims.⁸ This is not permitted even though the overlay that depicts the user's stock portfolio is the sole disclosed example of user specific information in Appellant's Specification. *See Phillips*, 415 F.3d at 1323 ("[W]e have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment."). "User specific"

⁸ As noted at page 33, footnote 38 of the Decision, Appellant has not based its claim interpretation on the "generate and transmit" language employed in the '725 and '490 patent claims.

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as applied to information and signals in the claims concerns the *content* of the information and signals, not the *origin* of the information and signals.

Although we agree with Appellant that the artisan would have recognized from the “Wall Street Week” example that it is possible for a particular user’s stock portfolio to be unique to that user, construing “user specific” as requiring a capability for uniqueness amounts to improperly reading a feature from that example into the claims.

Appellant also argues:

The Decision infers that the selection of captioning in a particular language reflects the language capabilities of the user. One can always infer a user's interests or capabilities from the programming the user selects. The term “user specific” should be interpreted [to] reflect something personal about the user that cannot be inferred from (i.e., is in addition to) the mere selection of the programming by the user.

Req. Reh’g 15. Again, Appellant is asking us to read a limitation from the “Wall Street Week” example into the claim term “user specific.” Also, Appellant has not explained, and it is not otherwise apparent, why the “user specific” language thus construed would not read on a user’s selection of a program that offers Mode 2 captioning. It would appear that the user’s selection of the language for the captions (the “user specific” information) is separate from the user’s selection of the program.

In summary, although we have modified our interpretation of “user specific” at page 44 of the Decision by withdrawing our reliance on “interests” and “preferences,” we are denying the Request for Rehearing to

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the extent it seeks a change in our holding as to the proper standard for
construing claims of expired patents undergoing Reexamination or a change
in our decision affirming the Examiner's rejections of claims 1-5 of the '725
patent and claims 1-9 and 11 of the '490 patent.

DENIED

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