UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,

Petitioner

v.

TLI COMMUNICATIONS LLC,

Patent Owner

Case IPR2015-00283

Patent 6,038,295

PATENT OWNER'S SUBMISSION RE:

SEPTEMBER 4, 2015 ORDER (PAPER NO. 25)

I. CLAIM 18 IS SUFFICIENTLY DEFINITE UNDER 35 U.S.C. 112 ¶ 2.

The Board sought additional briefing from the Patent Owner regarding "the ambiguity in claim 18 of the '295 patent identified in the [IR2015-00778] Institution Decision." Paper 25 at 2. As described below, viewed against the language of the claim, the specification, and the prosecution history, claim 18 readily informs one of skill in the art regarding the scope of the invention such that even if an antecedent basis error existed, such an error would not render claim 18 unclear or indefinite under the standard set forth in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014).

Claim 18 of the '295 patent recites:

> A method as claimed in claim 17, further comprising:
> recognizing speech spoken into the telephone unit and
> storing the compressed recognized speech.

A person of ordinary skill in the art would readily realize from the language of claim 18 itself that the term at issue refers to the "recognized speech" in compressed form. The speech recognized in the first part of claim 18 is the same recognized speech being stored in the second part of the claim, with the storage occurring as a compressed version of the recognized speech. The specification describes recognizing speech spoken into the telephone unit and storing the recognized speech in a compressed form. *Ex. 1001* at 8:6-13 ("The classification

information OM may be prescribed by a user of the telephone unit TE, for example, by simply speaking the information into the microphone LS of the telephone unit TE . . . . [T]he spoken language by the user may be recognized and stored in a compressed form, for example, as text."). Thus the specification teaches that the "recognized speech" that is stored is compressed, resulting in compressed recognized speech.

Additionally, the prosecution history is consistent with the language found in claim 18 as issued—that is, compression of the recognized speech is introduced in claim 18. Indeed, claim 18 was filed reciting identical language (although with a different dependency due to claim amendments and renumbering):

> 18. A method as claimed in claim 16, further comprising:
> recognizing speech spoken into the telephone unit and
> storing the compressed recognized speech.

Ex. 2010 at 25.

The Supreme Court clarified the standard for definiteness in *Nautilus*: For a claim to be valid under 35 U.S.C. § 112 ¶ 2, all that is required is that the "patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty. The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable." 134 S. Ct. at 2129. Accordingly, even if claim 18 was found to lack sufficient antecedent basis for "the compressed recognized

speech," claim 18 would not be indefinite because (together with the specification and prosecution history) it sufficiently informs those skilled in the art about the scope of the invention with reasonable certainty. *Energizer Holdings, Inc. v. Int'l Trade Com'n*, 435 F.3d 1366, 1370-71 (Fed. Cir. 2006) (reversing Commission's ruling that claims were invalid for indefinite based on a lack of antecedent basis and stating, "When the meaning of the claim would reasonably be understood by persons of ordinary skill when read in light of the specification, the claim is not subject to invalidity upon departure from the protocol of 'antecedent basis.'"). In particular, given the clear directive in the specification that, "The classification information OM may be prescribed by a user of the telephone unit TE, . . . [and] the spoken language by the user may be recognized and stored in a compressed form," *Ex. 1001* at 8:6-13, one of ordinary skill in the art would have little difficulty recognizing what the "compressed recognized speech" in claim 18 refers to.

Thus claim 18 is not indefinite.

Respectfully submitted,

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EXHIBIT LIST

Ex. 2001 *In re TLI Communications LLC Patent Litigation*, Case No. 1:14-md-02534 (EDVA), Memorandum Opinion, Feb. 6, 2015.

Ex. 2002 Sharp J-SH04, Wikipedia (July 7, 2014, 11:15 AM), (retrieved from: http://en.wikipedia.org/wiki/J-SH04).

Ex. 2003 Deposition of Kenneth Alan Parlulski, July 28, 2015.

Ex. 2004 Excerpts from Tom Lichty, The Official America Online for Macintosh Membership Kit & Tour Guide (2d ed. 1994), pp. 1-48, 75-163, 479-492, 501-524.

Ex. 2005 *Facebook, Inc. et al. v. TLI Communications, LLC*, IPR2015-00778, Decision – Institution of *Inter Partes* Review, Paper 17 (P.T.A.B. Aug. 28, 2015).

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