UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and
INSTAGRAM, LLC,
Petitioners

v.

TLI COMMUNICATIONS, LLC,
Patent Owner

Case IPR2015-00778
Patent 6,038,295

PETITIONERS' SUBMISSION
RE JULY 23, 2015 ORDER (PAPER NO. 14)

In an order dated July 23, 2015, the Board requested additional briefing from the parties regarding the following question:

> Should the term "telephone unit" in claim 17 of U.S. Patent No. 6,038,295 be read as a means-plus-function element under 35 U.S.C. § 112, sixth paragraph, in light of *Williamson v. Citrix Online, LLC*, No. 2013-1130, 2015 WL 3687459 (Fed. Cir. June 16, 2015)?

(*See* Paper No. 14, at 2.) As the Petitioner will demonstrate below, the answer to the Board's question is "no." The term "telephone unit" in claim 17 under its broadest reasonable interpretation is not subject to 35 U.S.C. § 112(f) (formerly § 112, ¶ 6) because the claim does not recite a function for the claimed "telephone unit," a prerequisite to "means-plus-function" treatment under § 112(f).

Section 112(f) of the Patent Act makes clear that means-plus-function treatment is invoked only when a claim limitation is expressed "as a means or step for performing a specified function." 35 U.S.C. § 112(f) (underlining added). The statute itself therefore applies only to claim limitations that recite "a specified function." Consistent with this statutory language the Federal Circuit has held that "a claim element that uses the word 'means' but recites no function corresponding to the means does not invoke § 112, ¶ 6." *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1347 (Fed. Cir. 2002) (quoting *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999)) (emphasis added). As the Petitioner will show below, claim 17 recites no function for the claimed "telephone unit."

Williamson did not change this aspect of the law governing means-plus-function claim limitations. *Williamson* instead addressed the situation in which a claim limitation that does not use the word "means," but that is otherwise expressed as a means for performing a specified function, may be subject to § 112(f). *Williamson*, 2015 WL 3687459 at *7. In fact, the Federal Circuit emphasized that the term at issue in *Williamson*, "distributed learning control module for receiving communications," was recited "in a format consistent with traditional means-plus-function claim limitations." 2015 WL 3687459 at *8. *Williamson* did not change existing law that claim limitations that do not recite a function are not subject to § 112(f), even if they recite "means" or an equivalent term.

Claim 17 recites "telephone unit" twice, as shown in underlining below. Neither of those instances recites any function for the "telephone unit."

> 17. A method for recording and administering digital images, comprising the steps of:
>
> recording images using a digital pick up unit in a **telephone unit**,
>
> storing the images recorded by the digital pick up unit in a digital form as digital images,
>
> transmitting data including at least the digital images and classification information to a server, wherein said classification information is prescribable by a user of the **telephone unit** for allocation to the digital images,

receiving the data by the server,

extracting classification information which characterizes the digital images from the received data, and

storing the digital images in the server, said step of storing taking into consideration the classification information.

('295, Ex. 1001, 10:1-17 (claim 17) (emphasis added).)

The first instance of "telephone unit" above recites the step of recording images "using a digital pick up unit in a telephone unit." The recitation of "telephone unit" here merely specifies the location of the "digital pick up unit," and does not recite any specified function for the telephone unit itself.

The term "telephone unit" is next recited in the following clause of the "transmitting" step: "wherein said classification information is prescribable by a user of the telephone unit for allocation to the digital images." This instance of "telephone unit" merely identifies the user who can prescribe the classification information ("a user of the telephone unit"), and similarly fails to recite any specified function for the telephone unit. Because claim 17 does not recite any specified function for the claimed "telephone unit," it is not subject to § 112(f).

The fact that "telephone unit" in claim 17 is not a "means-plus-function" term is further confirmed by comparing it to other claim limitations in the '295 patent that recite "unit." Claim 1, for example, recites "a receiving unit for receiving data sent from said at least one telephone unit," and "an analysis unit for

analyzing the data received by the receiving unit from the telephone unit." ('295 patent, claim 1, 8:66-9:2 (emphasis added).) The "receiving unit" and "analysis unit" limitations in claim 1, unlike the telephone unit in claim 17, specify a particular function for each respective unit and are written in a format consistent with means-plus-function claiming. *See Williamson*, 2015 WL 3687459 at *8.

Because *Williamson* did not change the law that § 112(f) is invoked only when a claim is expressed "as a means or step for performing a specified function"—which the "telephone unit" term in claim 17 of the '295 patent is not—that term should not be construed as a means-plus-function claim limitation under its broadest reasonable interpretation.

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Respectfully submitted,

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