

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FASTVDO LLC,
Patent Owner.

Case IPR2016-01203
Patent No. 5,850,482

**PETITIONER APPLE INC.'S OPPOSITION TO
PATENT OWNER FASTVDO LLC'S REQUEST FOR
REHEARING ON INSTITUTION DECISION**

I. INTRODUCTION

As authorized by the Board in a February 22, 2017 email, Petitioner Apple Inc. hereby opposes the request of Patent Owner FastVDO, LLC (“FastVDO”) to rehear the Board’s Institution Decision. Petitioner complied with 37 C.F.R. § 42.104(b)(3) by explicitly identifying the portion of the specification of the ’482 patent (*i.e.*, Col. 16, lines 10-14) that arguably could be deemed structure for the “error protection means” limitation of claims 7-11 and 22-26 of the ’482 patent.

Under the trial practice rules, “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). The Board did not abuse its discretion here. In addition to identifying the specific portion of the specification that arguably described structure corresponding to the claimed function as required by § 42.104(b)(3), Petitioner also argued that such description was inadequate under 35 U.S.C. § 112, ¶ 6. Petitioner was not required to *concede* that the specification *adequately* disclosed corresponding structure.

That the Board appreciated the issue that FastVDO raised in its Preliminary Response—and is now rearguing in its Request for Rehearing—is evidenced by its considered analysis of this disputed means-plus-function limitation, which it ultimately construed in the manner proposed by FastVDO. That the Board disagreed that the reference in the specification to a textbook was inadequate does not make the Petition defective, and Petitioner expressly recognized the possibility

that the Board would so disagree. Petitioner met its obligation under the rule of § 42.104(b)(3), and rehearing of the Institution Decision should be denied.

II. STATUS OF THIS PROCEEDING

On June 16, 2016, Petitioner filed a Petition for *inter partes* review of the '482 patent (Paper 2). FastVDO filed its Preliminary Response on September 26, 2016 (Paper 10), and the Board instituted review of all challenged claims in a December 16, 2016 Decision (Paper 14). On December 30, 2016, FastVDO filed a Request for Rehearing with respect to claims 7-11 and 22-26 (Paper 16). FastVDO specifically contends that Petitioner did not identify corresponding structure for the “error protection means” of those claims, and that the “the Board overlooked Petitioner’s failure to comply with 37 C.F.R. § 42.104(b)(3).” (Paper 16 at 2.) FastVDO further contends that Petitioner’s “sole theory” was indefiniteness. (Paper 16 at 1, 3.) As explained herein, the Board did not “overlook” a failure to comply with § 42.104(b)(3), and indefiniteness was not Petitioner’s sole theory.

III. PETITIONER SATISFIED ITS DUTY UNDER § 42.104(B)(3)

As explained by the Federal Circuit, the construction of a “means-plus-function” limitation requires (1) an identification of the claimed function and then (2) a determination of the corresponding structure, *if any exists*:

Construing a means-plus-function claim term is a two-step process.

The court must first identify the claimed function. [Citation omitted.]

Then, *the court must determine what structure, if any, disclosed in the specification corresponds to the claimed function.*

Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1351 (Fed. Cir. 2015) (en banc) (emphasis added). This standard was quoted by Petitioner (Petition at 9) and the Board (Decision at 10), and was not challenged by FastVDO (with good reason).

Instead, FastVDO's Request focuses on 37 C.F.R. § 42.104(b)(3), but the language of that rule (set forth below) is entirely consistent with *Williamson*:

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must *identify the specific portions of the specification* that describe the structure, material, or acts corresponding to each claimed function[.]

37 C.F.R. § 42.104(b)(3) (emphasis added). This rule does not require that a petitioner must *concede* that there is an adequate corresponding structure; rather, it merely requires a petitioner to “*identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function,*” which was precisely what Petitioner here did in *identifying* what it saw as the only portion of the '482 specification that arguably *describes* the structure corresponding to the claimed function of the “error protection means”:

... The specification does not disclose any structure for performing this [recited] function. (Lippman ¶62.)

Instead, the specification simply states that methods and apparatus for performing “unequal error protection” were “known to those skilled in the art” “as described, for example, in R. G. Gallager, ‘Information Theory and Reliable Communication’, Wiley and Sons (1968).” (’482, 16:10-14).

(Petition at 9-10; emphasis added.) After satisfying the requirement of § 42.104(b)(3) to “identify the specific portions of the specification [*i.e.*, ’482, 16:10-14] that describe the structure ... corresponding to each claimed function,” Petitioner argued that such disclosure was inadequate. (Petition at 10.)

The rule cited by FastVDO requires no more, and the Federal Circuit’s qualifier (“if any”) in *Williamson* confirms that construction of a means-plus-function term may indeed result in a determination that *there is no adequate corresponding structure*. Here, Petitioner explicitly identified the specific portion of the specification that describes the unequal error protection means.

That the Board disagreed with Petitioner and determined that the specification “discloses enough of an algorithm to allow a person of ordinary skill in the art to discern the necessary structure for performing the claimed function” (*see* Decision at 10-12) does not translate to Petitioner having failed to *identify* “the specific portions of the specification that describe the structure[.]” Petitioner identified Col. 16, lines 10-14 and said it wasn’t enough—the Board identified the *same* portion of the specification, along with the subsequent three sentences, and

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