

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CUSTOMPLAY, LLC,
Petitioner,

v.

CLEARPLAY, INC.,
Patent Owner.

Case IPR2014-00383
Patent 7,543,318 B2

Before KARL D. EASTHOM, JUSTIN T. ARBES, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

ClearPlay, Inc. (“Patent Owner”) filed a Request For Rehearing (Paper 13, cited as “Req. Reh’g.”) requesting rehearing of our decision (Paper 10, cited as “Decision”) instituting *inter partes* review of claims 1–29 of U.S. Patent No. 7,543,318 B2 (“the ’318 patent”).¹

For the reasons stated below, we deny Patent Owner’s request.

II. DISCUSSION

When rehearing a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Patent Owner asserts an abuse of our discretion because, according to Patent Owner, our adopted claim construction “reads a limitation out of the claims, overlooks explicit associations between elements of the claims, is inconsistent with the specification of the ’318 Patent, and would render the claims incapable of filtering content.” Req. Reh’g. 4. Patent Owner also asserts that our Decision “incorrectly analyzes obvious[ness].” *Id.*

¹ A request for rehearing under 37 C.F.R. § 42.71(d) must be filed in the form of a motion, which is limited to 15 pages (*see* 37 C.F.R. § 42.24(a)(1)(v)). Patent Owner’s request exceeds the page limit. In the future, any motion or other filing in this proceeding that exceeds the page limits established in the applicable rules will not be accepted, without prejudice to refiling within the applicable time period. If timely refiling is not possible, the Board may reject the noncompliant filing or not consider any content beyond the applicable page limit.

Claim Construction

Patent Owner contends “the Board relies on a claim construction that reads the ‘start indicator’ or ‘end indicator’ limitation out of the claims.” Req. Reh’g. 5. Patent Owner bases its position on a misunderstanding, and, thus, a mischaracterization, of two sentences in our 22 page Decision. The two sentences on which Patent Owner relies appear on page 14 of our Decision: “Patent Owner asserts that the ‘processor limitation’ in claims 1 and 15 ‘requires the start and end indicators to be separate’ [citing Prelim. Resp. 23]. Patent Owner cites no evidence to support this argument.”

Patent Owner cites to these two sentences and characterizes their substance as determining that “there was no evidence that the start and end indicators of independent claims 1 and 15 have to be separate.” Req. Reh’g. 5. This mischaracterizes our determination. We also did not state in our Decision that “the position identified by the end indicator can be the same as the position identified by the start indicator,” as asserted by Patent Owner. *Id.* at 13. Our statements were limited to Petitioner’s argument concerning the “processor limitation.” We separately discussed and determined, for purposes of our Decision, that the start and stop positions in Malkin were separate, as explained below.

We did not specifically construe the claim terms “start indicator” or “end indicator.” As we stated in our Decision, [i]n an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” Decision 6 (citations omitted). “[W]hen interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Any special definition for a claim term must be set forth in the

specification with reasonable clarity, deliberateness, and precision. *Id.* (citation omitted). In its Preliminary Response, Patent Owner did not propose any special definition of the terms “start indicator,” “first position,” “end indicator,” or “second position.”

The challenged claims state that the start indicator is associated with a first position in a multimedia content presentation, and the end indicator is associated with a second position in the multimedia content presentation. Thus, the claims require two positions.²

In our Decision, we stated that Figure 3A of Malkin discloses a start position (Frame n) and a stop, or end, position (Frame n+4). Decision 13. This clearly establishes separate start and end positions. In our Decision (*id.*), we also explained that, in Malkin, a control specification is used to modify the content between the start and end positions to satisfy the viewer’s specification. *See* Ex. 1005, col. 5, ll. 14-15.³ The control specification indicates how the stream content should be modified. *Id.* at col. 12, ll. 59-65. Thus, in comparing Malkin to the challenged claims, we determined that Malkin discloses a system in which multimedia content is filtered by a control specification between a start or first position (Frame “n” in Figure 3A) and an end or second position (Frame “n+4” in Figure 3A). We did not “read[] the ‘start indicator’ or ‘end indicator’ limitation out of the claims,” as asserted by Patent Owner (Req. Reh’g. 5), nor did we misapprehend or overlook Patent Owner’s arguments regarding these claim

² Whether the two positions required in the claims are, or can be, the same position was not an issue presented or required for resolution in our Decision to Institute an *Inter Partes* Review or in this Decision on the Request for Rehearing.

³ Our Decision cited Malkin as “Ex. 1013.” Decision 13. The correct citation is Ex. 1005. The Decision in other places correctly identified and cited Malkin as Ex. 1005. *See, e.g.*, Decision 5, 13. It is clear that the Malkin reference to which we refer in the Decision is Exhibit 1005.

limitations.

Patent Owner focuses its Request for Rehearing on the fuzz-balls in Malkin. *E.g.*, Req. Reh’g. 8 (“Malkin’s fuzz-balls individually identify frames which is not the same as identifying two separate positions within the content.”); *see also id.* at 9 (“Malkin’s control specification merely defines fuzz-balls”). However, a fuzz-ball is merely one type of control specification. Ex. 1005, col. 5, ll. 14-15. We also stated in our Decision that “[a]nother type of control specification [disclosed in Malkin] ‘is an edit-decision list, which indicates which frames to modify or replace.’” Decision 13, *citing* Ex. 1005, col. 12, ll. 63-65. Thus, the control specification in Malkin is not limited to fuzz-balls applied to an individual frame. Malkin also discloses a control specification that edits one or more frames. Ex. 1005, col. 6, ll. 5–10 (“The mask provider has various control specifications (237) . . . for dynamically modifying or masking out portions of *one or more frames* of a video according to the content specification (248)”) (emphasis added). Malkin also discloses that control specification 237 “provides instructions on showing the frames *or groups of frames* of the multimedia streams, and specifies *blocking, omissions, and overlays.*” *Id.* at col. 12, ll. 60–62 (emphasis added).

According to Patent Owner, “the claims require [the start and end] indicators to be associated with separate positions.” Req. Reh’g. 5. For purposes of our Decision, we agreed, and so stated in our Decision, as summarized above. Indeed, Patent Owner acknowledges that we “correctly clarified” that a navigation object is defined as having “(1) a start indicator *associated with a first position* in the multimedia content presentation (e.g., a movie); (2) an end indicator *associated with a second position* in the multimedia content presentation; and (3) a skip filtering action associated with the start and end indicators.” *Id.* at 8 (emphasis added), *citing* Decision 8. Thus, we construed the claims as requiring start and end

indicators associated with first and second positions, respectively, and Patent Owner appears to agree with our claim construction. We are not persuaded that our claim construction is “clearly erroneous” (*id.* at 10) or an abuse of our discretion.

Skip Filtering Action

Patent Owner also asserts that our claim construction “overlooks the direct association between the skip filtering action and the start and end indicators.” Req. Reh’g. 7. We directly addressed the “skip filtering action” called for in the claims in a subsection of our Decision labelled “*Skip Filtering Action.*” Decision 13. We stated that “Malkin discloses the step of skipping video frames and video segments based on the control specification and the content specification. Ex. 1005, col. 21, ll. 63–65, col. 25, ll. 26–28.” *Id.* We also stated that Patent Owner acknowledged in the Preliminary Response that Malkin discloses “skipping.” Decision 13, *citing* Prelim. Resp. 25. Indeed, Malkin claims a method of “skipping” video frames and video segments. *Id.* at col. 21, ll. 62–65, *see also id.* at col. 25, ll. 25–28.

In a subsection of the Decision labeled “*Filtering Action Performed Between Start And Stop Positions,*” we linked the “skip filtering action” to the start and end positions. Decision 14. We determined, based on the current record, that Malkin discloses a specific filtering action that is performed on the portion of multimedia content between the start and stop positions. *Id.* (“Malkin discloses the start and stop position of a ‘navigation object,’ as recited in the challenged claims”). We also stated that the evidence on which Patent Owner relied did not preclude “the start and stop position of a ‘navigation object,’ as recited in the challenged claims, from defining a single frame to which a filtering action is applied,” as is disclosed

in Malkin. *Id.*⁴ Thus, our Decision determined that the claimed start and stop positions were separate and applied that determination in our analysis of the references on which Petitioner relied. We are not persuaded that we misapprehended or overlooked the claimed relationship between the skip filtering action and the start and end indicators.

Obviousness Analysis

Patent Owner's dispute with our Decision appears to be with the application of the claim construction to the facts before us ("when *applying* this [correct] construction, the Board fails to require that the start and end indicators be separate"). Req. Reh'g. 8 (emphasis added). Patent Owner again focuses on Malkin's example of using "fuzz-balls" as a filtering action and asserts that "Malkin's fuzz-balls individually identify frames which is not the same as identifying two separate positions within the content." *Id.* According to Patent Owner, we did "not explain[] how Malkin could teach or suggest a skip filtering action that is associated with both a start indicator and an end indicator." *Id.* at 9. Patent Owner argues that "Malkin's control specification merely defines fuzz-balls that are individually applied to a single frame as defined by a single frame identifier." *Id.* at 9. As we discussed above, Patent Owner's analysis of Malkin is too narrow. Based on the current record, we are persuaded that Malkin discloses a system in which multimedia content is filtered by a control specification between a start or first position and an end or second position.

Moreover, our Decision is based on Petitioner's arguments and evidence regarding what Malkin and Abecassis, taken together, would have suggested to a person or ordinary skill in the relevant technology. Decision 20 ("... we are

⁴ A single frame is not the same as a single position. A frame, as disclosed in Malkin, has a "known dimension." Ex. 1005, col. 7, l. 37.

persuaded that there is a reasonable likelihood that Petitioner would prevail with respect to claims 1–29 based on Abecassis and Malkin”).

Based on the analysis above, Patent Owner has not persuaded us that there was an abuse of discretion, or that we misapprehended or overlooked any material matter.

III. CONCLUSION

For the foregoing reasons, Patent Owner has not demonstrated that we abused our discretion in instituting an *inter partes* review of claims 1–29 of the ’318 patent. 37 C.F.R. § 42.71. The request for rehearing is *denied*.

This is a decision on Patent Owner’s Request for Rehearing under 37 C.F.R. § 42.71. We have not made a final determination on the patentability of the challenged claims.

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