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Paper 29
Entered: November 5, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CUSTOMPLAY, LLC,
Petitioner,

v.

CLEARPLAY, INC.,
Patent Owner.

Case IPR2013-00484
Patent 7,577,970 B2

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

GROSSMAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

CustomPlay, LLC ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–43 (all of the claims) of U.S. Patent No. 7,577,970 B2 ("the '970 patent") on multiple grounds. Paper 4 ("Pet."). On November 26, 2013, we instituted an *inter partes* review of claims 16, 27, 28, 30–34, and 40 on a single ground of unpatentability under 35 U.S.C. § 103 based on a proposed combination of Abecassis (Ex. 1002) and Malkin (Ex. 1004). Paper 10 ("Dec. on Inst."). ClearPlay, Inc. ("Patent Owner") filed a Patent Owner Response (Paper 17, "PO Resp."), and Petitioner filed a Supplemental Reply (Paper 22, "Reply").

Patent Owner did not file a motion to amend the claims.

An oral hearing was held on August 27, 2014, and a transcript of the hearing is included in the record. Paper 28 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine Petitioner has not shown by a preponderance of the evidence that claims 16, 27, 28, 30–34, and 40 are unpatentable.

A. The '970 Patent

The '970 patent relates generally to filtering multimedia content, such as scenes or language unsuitable for viewers of some ages. Ex. 1001, col. 1, ll. 16–17, 22–23. More specifically, the invention claimed in the '970 patent relates to a computerized system for identifying and filtering automatically portions of multimedia content during the decoding process. *Id.* at col. 1, ll. 17–20. The decoding process creates various continuous multimedia streams by identifying, selecting, retrieving, and transmitting content segments from a number of available segments stored on a content source, such as a DVD. *Id.* at col. 2, ll. 3–6. The

system disclosed in the ’970 patent permits filtering multimedia content at the output side of a decoder rather than at the input or source side of the decoder. *Id.* at col. 4, ll. 41–44.

The ’970 patent system creates “navigation objects” to define portions of the multimedia content that should be filtered. *Id.* at col. 4, ll. 47–49. As required in the challenged claims, each navigation object defines a start position, a stop position, and a filtering action for the portion of the multimedia content defined by the start position and stop position. *Id.* at col. 4, ll. 49–52. The Specification of the ’970 patent discloses several filtering actions: “skip” (Ex. 1001, col. 6, ll. 1–13); “mute” (*id.* at col. 5, ll. 21–32); and “reframe” (*id.* at col. 5, ll. 38–52). The ’970 patent also refers to these filtering actions as “editing actions.” *Id.* at col. 5, ll. 53–67. As disclosed, at least a “reframe navigation object” may be implemented “on a frame-by-frame basis.” *Id.* at col. 15, ll. 48–50.

The navigation objects are placed in an “object store.” The object store may be a file, such as a database, and the navigation objects may be records within the database. *Id.* at col. 11, ll. 52–62.

Figure 2 from the ’970 patent, shown below, is a block diagram showing the basic components of a system embodying the claimed invention.

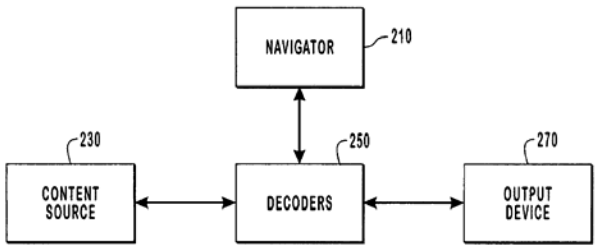

Figure 2 from the ’970 patent.

Figure 3a from the '970 patent, shown below, is an enhanced diagram that provides additional details for the basic components shown in Figure 2.

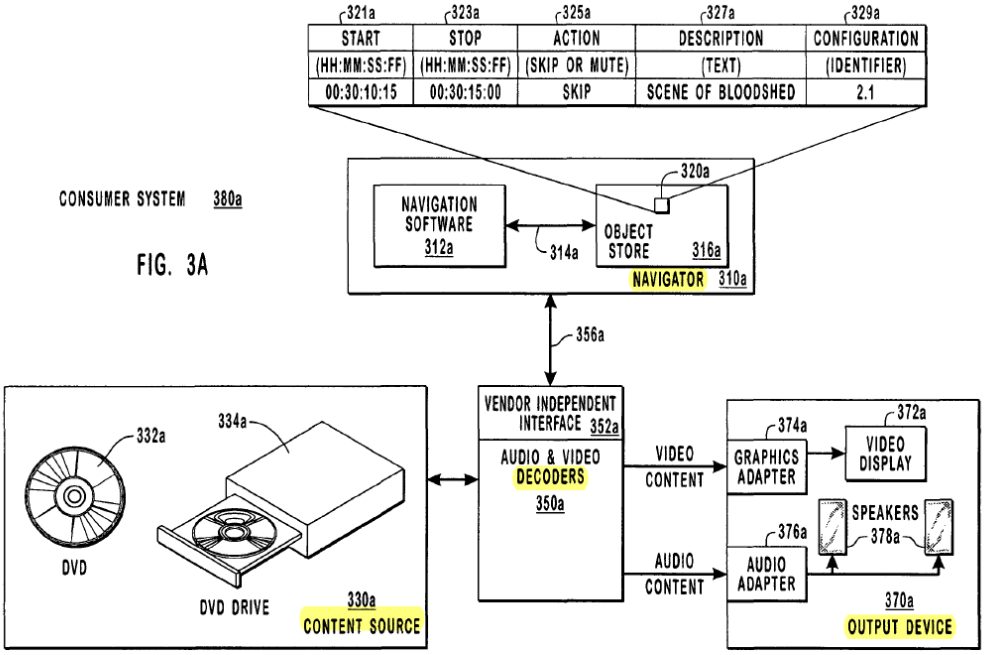

Figure 3a is annotated to highlight corresponding components in Figure 2.

B. Illustrative Claim

We instituted *inter partes* review of independent claims 16 and 27, and dependent claims 28, 30–34, and 40. Illustrative claim 16 follows:

> 16. In a computerized system for enabling a consumer to filter multimedia content that is comprised of video content, audio content, or both, and wherein a consumer computer system includes a processor, a memory, a decoder, and an output device for playing the multimedia content, a method for assisting the consumer to identify portions of the multimedia content that are to be filtered and to thereafter filter the identified portions, the method comprising the acts of:
>
> loading a plurality of navigation objects into the memory of the consumer computer system, each of which defines a portion of the multimedia content that is to be filtered by defining a start position and a stop position and a specific filtering action to be

performed on the portion of the multimedia content defined by the start and stop positions for that portion;

updating a position code in association with decoding the multimedia content on the consumer computer system;

comparing the position code with a navigation object to determine whether the position code corresponding to the multimedia content falls within start and stop positions defined by one of the navigation objects;

when the position code is determined to fall within the start and stop position defined by a particular navigation object, activating the filtering action assigned to the particular navigation object in order to filter the multimedia content for that portion of the multimedia content defined by the particular navigation object;

transferring the multimedia content to an output device, whereby the multimedia content is played at the output device excluding each portion thereof which is filtered in accordance with the plurality of navigation objects;

assigning a configuration identifier to the decoder;

comparing the configuration identifier of the particular navigation object with the configuration identifier of the decoder to determine if the particular navigation object applies to the decoder; and

determining that the particular navigation object applies to the decoder based on the configuration identifier of the particular navigation object matching the configuration identifier of the decoder.

C. References Relied Upon

The ground of unpatentability in this *inter partes* review is based on the following references:

Reference	Pat. Number	Date	Exhibit Number
Abecassis	U.S. 6,408,128 B1	June 18, 2002 (filed Nov. 12, 1998)	Ex. 1002
Malkin	U.S. 6,317,795 B1	Nov. 13, 2001 (filed July 22, 1997)	Ex. 1004

D. Ground of Unpatentability

This *inter partes* review addresses the issue of whether claims 16, 27, 28, 30–34, and 40 would have been obvious under 35 USC § 103(a) based on Abecassis and Malkin.

II. ANALYSIS

A. Claim Interpretation

In the Decision on Institution, we used the broadest reasonable claim interpretation standard and interpreted various claim terms of the ’970 patent as follows:

Term or Phrase	Construction
Filtering/Filter	Editing or rejecting some multimedia content while allowing other multimedia content to pass unchanged.
Defining a Filtering Action	Describing or specifying a distinct filtering operation.
Navigation Object	Information that defines both (1) a portion of multimedia content to filter and (2) the filtering action to be taken on the defined portion of multimedia content.
Position Code	Information that identifies a location in the multimedia content.
Start Position	Information that defines a beginning of a portion of multimedia content

Term or Phrase	Construction
Duration from the Start Position	A continuance in time from the start position.

See Dec. on Inst. 14–15.

Patent Owner indicates that our construction of the claim term "navigation object" in our Decision on Institution is correct "as long as it encompasses the requirement that a navigation object must define when to start applying the filtering action and when to stop applying the filtering action." PO Resp. 4. Because we base our Final Decision on other claim limitations, however, we need not reach this claim interpretation.

The parties otherwise do not dispute the interpretations set forth in our Decision on Institution, and we discern no reason based on the record before us to change them for purposes of the Final Decision. Accordingly, to the extent necessary to reach this Final Decision, we adopt our claim constructions from the Decision on Institution.

B. Asserted Ground of Unpatentability

1. Obviousness Based on Abecassis and Malkin

a. Configuration Identifier

In claim 16, a "configuration identifier" determines when a particular navigation object is applied. Claim 16 is the only claim before us that includes a configuration identifier.

Claim 16 requires the step of assigning a configuration identifier to the decoder. Ex. 1001, col. 21, l. 53. Claim 16 also requires the step of comparing "the configuration identifier of the particular navigation object" with the configuration identifier of the decoder to determine if "the particular navigation object" applies to the decoder. *Id.* at col. 21, ll. 54–57. Claim 16 also requires the

step of determining whether "the particular navigation object" applies to the decoder based on the configuration identifier of "the particular navigation object" matching the configuration identifier of the decoder. *Id.* at col. 21, ll. 58–61.

Claim 16 requires the step of "comparing the configuration identifier *of* the particular navigation object" to the configuration identifier of the decoder (emphasis added). Therefore, claim 16 inferentially claims that the particular navigation object has a "configuration identifier." Additionally, claim 16 requires the step of determining whether the configuration identifier of the particular navigation object matches the configuration identifier of the decoder.

As explained in the Specification of the '970 patent with reference to Figure 3A, the configuration identifier "is an identifier (329a) used to determine if navigation object 320a applies to a particular consumer system." Ex. 1001, col. 12, ll. 2–5. Figure 3A shows that configuration identifier 329a is included within navigation object 320a. The configuration identifier identifies the hardware and software configuration of a consumer system to which the navigation object applies. *Id.* at col. 14, ll. 7–8; *see also id*. at col. 14, ll. 13–17 ("The motivation behind configuration 499 [in Figure 4B] is that different consumer systems may introduce variations in how navigation objects are processed. As those variations are identified, navigation objects may be customized for a particular consumer system without impacting other consumer systems.").

In its Patent Owner Response, Patent Owner asserts that because neither Abecassis nor Malkin discloses a navigation object, these references also cannot teach or suggest a navigation object with a configuration identifier or the steps of selectively applying navigation objects based on the configuration identifier of the decoder, as required in claim 16. PO Resp. 11. Patent Owner also asserts that Abecassis does not disclose a configuration identifier. *Id.*

Petitioner has not directed us to any evidence that Malkin discloses or suggests a "configuration identifier" as part of a navigation object. Petitioner relies on the disclosure in Abecassis for evidentiary support that Abecassis discloses the claimed steps involving the "configuration identifier." Petitioner asserts that Abecassis recognizes that different multimedia players have different configurations. Pet. 38 (citing Ex. 1002, col. 27, ll. 25–28). The mere fact that a system has different potential configurations, however, does not mean that it performs the specific "assigning," "comparing," and "determining" steps as recited in claim 16 pertaining to the "configuration identifier."

Petitioner also asserts that Abecassis discloses the correlation of a video-map configuration and a multimedia-player configuration. *Id.* (citing Ex. 1002, col. 23, ll. 48–52 ("When completed, the map may be automatically keyed or configured to accommodate the requirements of the particular device to which the video is to be downloaded.")). The portion of Petitioner's Reply addressing the "configuration identifier" also focuses exclusively on the disclosure in Abecassis. Reply 11–13. The cited portion in Abecassis applies to a completed video map, not to particular navigation objects. In our Decision on Institution, we determined that the video map in Abecassis was not a navigation object, as required by the claims of the '970 patent. Dec. on Inst. 19.

Petitioner maintains that Abecassis discloses a variety of video map configurations and that it would be illogical to key or configure a video map "and then exclude the configuration identification." *See* Reply 13. Petitioner points out that Abecassis's video maps are automatically "'configured or keyed to accommodate the requirements of [a] particular device.'" *See id*. at 12 (quoting Ex. 1002, col. 23, ll. 48–52). This disclosure shows that each map does not necessarily need to carry a configuration identifier, because in Abecassis, each map

has been designed to correspond to a specific device. Petitioner has not provided any persuasive evidence or argument that shows that the combination of Abecassis and Malkin discloses or suggests the "configuration identifier" limitations recited in claim 16.

Petitioner cites the Declaration of Dr. Robert Louis Stevenson for evidentiary support that Abecassis discloses the claimed steps involving the "configuration identifier." Pet. 38 (citing Ex. 1006 ¶ 57). Dr. Stevenson cites substantially the same passages from Abecassis as cited by Petitioner and concludes that Abecassis discloses a configuration identifier, as claimed in claim 16. Ex. 1006 ¶ 57.

Petitioner also has not directed us to any persuasive evidence or argument that it would have been obvious to modify the configuration technology used for completed video maps in Abecassis to provide configurable navigation objects, each with configuration identifiers, as required in claim 16. Moreover, Petitioner has not provided any persuasive evidence or argument that it would have been obvious to compare each navigation object's configuration identifier to a decoder's configuration identifier, as claim 16 also requires. No apparent need would exist for this type of comparison step in the system of Abecassis, because each video map is configured to a specific device. Accordingly, the preponderance of the evidence does not establish that the combination of Abecassis and Malkin, on which this *inter partes* review is based, discloses or suggests the "configuration identifier" limitations recited in claim 16. Accordingly, Petitioner has not demonstrated by a preponderance of the evidence that claim 16 is unpatentable over Abecassis and Malkin.

b. Disabling a Navigation Object

Claim 27 requires the step of "providing for disabling of one or more of the navigation objects such that the specific filtering action specified by the disabled navigation object is ignored." Ex. 1001, col. 23, ll. 41–43. The Specification states that "[n]avigation objects may be disabled by including an indication within the navigation objects that they should not be part of the filtering process." *Id.* at col. 18, ll. 64–66. The Specification also states that the step of retrieving navigation objects may ignore navigation objects that have been marked as disabled so they are not retrieved, or, alternatively, a separate step could be performed to eliminate disabled navigation objects from being used in filtering multimedia content. *Id.* at col. 18, l. 66–col. 19, l. 4.

In its Patent Owner Response, Patent Owner asserts that "because neither Abecassis nor Malkin teaches or suggests a navigation object, these references also cannot teach or suggest the disabling of a navigation object." PO Resp. 12. Patent Owner also asserts that the "supervisor preview" in Abecassis, on which Petitioner relies for disclosing the "providing for disabling" step, is performed during the creation of the video map and is therefore irrelevant to the process of employing navigation objects during the process of outputting multimedia content. *Id.*

In its Petition, Petitioner asserts that Abecassis discloses the claimed "providing for disabling" step in the context of the asserted ground of anticipation based on Abecassis alone. Pet. 40. The Petition did not address the "disabling" step in the context of the asserted ground of obviousness based on Abecassis and Malkin. Petitioner asserts that Abecassis discloses "a supervisor's previewing flagged segments and making individualized determinations to skip or include the segments, where an 'include' decision entails disabling the segment information (or navigation object)." *Id.* (citing Ex. 1006 ¶¶ 37–38). Petitioner also asserts that

when a viewer establishes content preferences in the Abecassis video map system, the result is "ignoring the segment information for segments that are deemed acceptable under the viewer's preferences." *Id.* (citing Ex. 1006 ¶¶ 74–75). Neither of these assertions establishes that a navigation object can be disabled, as required in claim 27. A viewer's content preferences, which define which segments are played and which are not, do not disable a navigation object, as required by claim 27. Claim 27 specifically requires "playing the multimedia content at the output device excluding the portion thereof which is filtered in accordance with the corresponding navigation object *and ignoring the filtering action specified by any disabled navigation objects*." Ex. 1001, col. 23, ll. 54–58 (emphasis added). Thus, in claim 27, the disabling step ignores a specified filtering action during playback, not at some earlier time as in Abecassis.

Dr. Stevenson's Declaration, on which Petitioner relies for evidentiary support, repeats Petitioners assertions in the context of the ground of anticipation based on Abecassis alone. We also find Dr. Stevenson's conclusions unpersuasive.

Petitioner has not directed us to any persuasive evidence or argument that creating a video map with viewer content preferences, as disclosed in Abecassis, discloses or suggests the steps of "providing for disabling" a navigation object and "ignoring the filtering action specified by any disabled navigation objects," as required in claim 27. Moreover, Petitioner has not provided any persuasive evidence or argument that it would have been obvious to include the asserted video map "disabling" technology disclosed in Abecassis to provide for disabling one or more of the navigation objects of Malkin. Accordingly, the preponderance of the evidence does *not* establish that the combination of Abecassis and Malkin, on which this *inter partes* review is based, discloses or suggests providing for disabling a navigation object and ignoring filtering actions specified by any

disabled navigation objects, as required in claim 27. Accordingly, Petitioner has not demonstrated by a preponderance of the evidence that claim 27 is unpatentable over Abecassis and Malkin.

d. Dependent Claims 28, 30–34, and 40

Dependent claims 28, 30–34, and 40 depend, directly or indirectly, from claim 27, and thus include all its elements and limitations. 37 C.F.R. § 1.75(c) ("One or more claims may be presented in dependent form, referring back to and *further limiting* another claim or claims in the same application" (emphasis added)). Accordingly, for the same reasons as discussed above for claim 27, Petitioner has not demonstrated by a preponderance of evidence that claims 28, 30–34, and 40 are unpatentable over Abecassis and Malkin.

III. CONCLUSION

Based on the evidence and arguments, Petitioner has not demonstrated by a preponderance of the evidence that claims 16, 27, 28, 30–34, and 40 of the '970 patent are unpatentable under 35 U.S.C. § 103(a) based on Abecassis and Malkin.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that claims 16, 27, 28, 30–34, and 40 of the '970 patent have not been shown, by a preponderance of the evidence, to be unpatentable.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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