

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS INTERNATIONAL PLC, ARRIS GLOBAL LTD.,
PACE AMERICAS, LLC, PACE AMERICAS HOLDINGS, INC.,
and PACE AMERICAS INVESTMENTS, LLC,
Petitioner,

v.

SONY CORPORATION,
Patent Owner.

Case IPR2016-00834
Patent 6,097,676

Before JENNIFER S. BISK, BART A. GERSTENBLITH, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

ARRIS International plc, Pace Ltd.,¹ Pace Americas, LLC, Pace Americas Holdings, Inc., and Pace Americas Investments, LLC (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 5 and 8 of U.S. Patent No. 6,097,676 (Ex. 1001, “the ’676 patent”). Paper 2 (“Pet.”). Sony Corporation (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On September 30, 2016, we instituted trial on one of the grounds presented in the Petition—that Yoshio² would have rendered the subject matter of claims 5 and 8 obvious to one of ordinary skill in the art at the time of the invention. Paper 13 (“Institution Decision” or “Inst. Dec.”).

Following institution, Patent Owner filed a Request for Rehearing of the Institution Decision (Paper 14, “Reh’g Req.”), and we denied that Request (Paper 21, “Rehearing Decision” or “Reh’g Dec.”). Patent Owner then filed a Response (Paper 24, “PO Resp.”), and Petitioner filed a Reply (Paper 29, “Reply”). Petitioner also filed a Motion to Exclude Evidence (Paper 35, “Mot. Excl.”), to which Patent Owner filed an Opposition (Paper 41, “Opp. Mot. Excl.”), and Petitioner filed a Reply to Patent Owner’s Opposition (Paper 44, “Reply Mot. Excl.”). Patent Owner also filed a Motion for Observation with respect to the cross-examination of

¹ According to updated mandatory notice information filed under 37 C.F.R. § 42.8, original petitioner “Pace Ltd. . . . changed its name to ARRIS Global Ltd. in May of 2016.” Paper 16, 1. We have updated the caption accordingly.

² U.S. Patent No. 5,130,816 to Junichi Yoshio (Ex. 1005)

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Petitioner's Reply Witness, Dr. Samuel H. Russ (Paper 37, "Obs."), in response to which Petitioner filed a Response (Paper 40, "Obs. Resp.").

We held an oral hearing on June 29, 2017. A transcript of the hearing is included in the record. Paper 52 ("Tr."). After the hearing, we ordered Patent Owner to file complete copies of a claim construction brief and a joint claim construction statement filed in related district court litigation, partial copies of which brief and statement Patent Owner had filed concurrently with its Patent Owner Response (Exs. 2003, 2004) and were the subject of a Motion to Exclude filed by Petitioner (Paper 35). Paper 45, 2 ("Order"). In the Order, we also authorized Petitioner and Patent Owner to file a Brief (Paper 49, "Pet.'s Brief on Claim Constr.") and Reply Brief (Paper 50 "PO's Reply Brief on Claim Constr."), respectively, to address whether Petitioner should be bound by the parties' agreement in the related litigation as to the construction of a claim term disputed in this proceeding. Paper 45, 3-4. Lastly, we authorized Patent Owner to file a three-page Notice of Supplemental Authority related to the Federal Circuit's decision in *IPCom GmbH & Co. v. HTC Corp.*, 861 F.3d 1362 (Fed. Cir. 2017), which issued after the hearing (Paper 47, "Supp. Auth."), and we authorized Petitioner to file a three-page response to Patent Owner's Notice (Paper 48, "Resp. Supp. Auth.").

This is a Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth the below, we conclude that Petitioner has shown by a preponderance of evidence that the challenged claims are *unpatentable*.

II. BACKGROUND

A. *Related Proceedings*

The parties indicate that the '676 patent is involved in *Sony Corp. v. Pace plc*, No. 1:15-cv-00288 (D. Del.), filed April 1, 2015. Pet. 1–2; Paper 5, 2; Paper 16, 2.

B. *The '676 Patent*

The '676 patent, titled “Information Recording Medium and Reproducing Device Therefor with Codes Representing the Software Category and Channels of Recorded Data,” describes “an information recording medium such as a compact disk, video disk and magneto-optical disk,” and “a reproducing device for reproducing information recorded in such an information recording medium.” Ex. 1001, at [54], 1:11–15.

In what is termed the “third aspect . . . according to the present invention,” the reproducing device is provided with “storing means for storing designation information for designating audio information to be reproduced,” “reading means for reading codes representing kinds of audio information,” and “reproducing means for reproducing the audio information designated by the designation information from plural kinds of audio information.” *Id.* at 3:4–11. Audio information designated as a “default” is “selected from audio information of plural kinds,” and “the audio information thus selected is reproduced.” *Id.* at 3:31–35, 3:57–61. Thus, for example, audio data for a movie may be translated into different languages for various countries and multiplexedly recorded in an information recording medium, with each language correspondingly identified by identifiers, such as 0, 1, 2, and 3 for English, French, German, and Japanese, respectively. *Id.* at 10:61–67. One of the identifier numbers is set as a default value in a

nonvolatile memory in the information reproducing device—in products to be used in the United States or the United Kingdom, for instance, the identifier number 0 for English is set as the default value; in products to be used in France, the identifier number 1 for French is set as the default value; and so on. *Id.* at 10:67–11:9, Fig. 15. Accordingly, information reproducing devices for use in multiple countries “may be made common provided that the default is to be changed and set for every destination country”; “the predetermined audio information selected from various audio information can be always reproduced”; and “any other audio information can also be reproduced as desired by changing the default.” *Id.* at 3:40–43, 61–64.

A preferred embodiment is described with reference to Figure 7, reproduced below.³

³ We note that the '676 patent states that the preferred embodiment of the third aspect is “described with reference to FIG. 1” (Ex. 1001, 3:12–13), but that appears to be a typographical error. The description following that statement refers to “nonvolatile memory 16” (*id.* at 3:15), which is depicted only in Figure 7, and the Brief Description of the Drawings and Detailed Description sections of the '676 patent identify Figure 7 as a block diagram showing a construction of the third preferred embodiment (*id.* at 4:35–37, 7:54–56; *cf. id.* at 4:17–19 (identifying Figure 1 as a block diagram showing a construction of “a *first* preferred embodiment” (emphasis added))).

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