

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 IPR2016-00835
Patent 6,084,643

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

BISK, *Administrative Patent Judge*.

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

INTRODUCTION

A. *Background*

Petitioner, listed above, filed a Petition requesting *inter partes* review of claims 1–4 (the “challenged claims”) of U.S. Patent No. 6,084,643 (issued July 4, 2000) (Ex. 1001, “the ’643 patent”). Paper 2 (“Pet.”). Sony Corporation (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). On September 29, 2016, we granted the Petition, instituting trial on whether the challenged claims would have been obvious over the combination of (1) Wasilewski,¹ Rosenberger,² and Ishikawa,³ and (2) Wasilewski and Ejima.⁴ Paper 10 (“Institution Decision” or “Inst. Dec.”). Patent Owner filed a Request for Rehearing of the Institution Decision (Paper 13, “Reh’g Req.”) and we denied that Request (Paper 21, “Reh’g Dec.”).

Following institution, Patent Owner filed a Response (Paper 22, “PO Resp.”), Petitioner filed a Reply (Paper 26, “Reply”), and, with authorization from the panel (Paper 29), Patent Owner filed a Sur-Reply (Paper 32, “Sur-Reply”). We held an oral hearing on June 29, 2017. Paper 37 (“Tr.”). After the hearing, we authorized Patent Owner to file a 3-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 35 (“Supp. Auth.”). We authorized Petitioner to file a 3-page response. Paper 36 (“Resp. Supp. Auth.”).

¹ U.S. Patent No. 5,600,378; Feb. 4, 1997 (Ex. 1005) (“Wasilewski”).

² EP 0612150 A2; Feb. 12, 1994 (Ex. 1007) (“Rosenberger”).

³ U.S. Patent No. 5,315,392; May 24, 1994 (Ex. 1020) (“Ishikawa”).

⁴ A certified English translation of Japanese Unexamined Patent Application Pub. No. H7-131727; May 19, 1995 (Ex. 1010) (“Ejima”).

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*.

B. Related Matters

The parties indicate that the '643 patent is involved in litigation in the District of Delaware. Pet. 1; Paper 5, 2.

C. The '643 Patent

The '643 patent relates to a method for swiftly selecting a desired television channel. Ex. 1001, Abstract. In particular, the '643 patent addresses the problem, in digital television broadcasting, in which continuously pressing the up/down channel button on a remote leads to a delay in the display of each of the selected channels. *Id.* at 1:25–32. This delay occurs because digital television pictures and sounds are broadcast in a compressed format, which the receiving equipment has to expand in order to display the programming of that channel. *Id.* at 1:28–36. Because switching channels in a sequential order using an up/down button causes the display of programming for each successively selected channel, the user may encounter significant delay—up to two to three seconds—between each channel switch. *Id.* at 1:18–37. This is inconvenient when the user wishes to quickly move through successive channels without necessarily seeing each channel's programming.

In response to this problem, the '643 patent describes receiving equipment with stored network information tables (“NITs”) mapping “service_id[s]” to the particular channel number to display. *Id.* at 6:56–7:19. The remote transmits the relevant service_id along with actual program data

to the receiving equipment when a user selects a channel. *Id.* at 7:25–34, Fig. 8. If the up/down keys are continuously pressed, only the channel number displayed on the screen is changed—the programming for the channel is not displayed. *Id.* at 7:62–8:3. Only when the user stops pressing the up/down key is the programming for that channel displayed. *Id.* at 8:8–23.

Of the challenged claims, only claim 1 is independent. Claims 2–4 depend directly from claim 1. Claim 1 recites:

1. A receiving equipment comprising:

transmission signal receiving means for receiving transmission signals including a plurality of channels;

command receiving means for receiving a command from a channel selection key operated by a user;

channel number display control means operative in accordance with the command received by the command receiving means commanding to switch the channels in a predetermined order for switching channel numbers being displayed in the predetermined order;

control means for controlling the transmission signal receiving means to receive the transmission signal of a channel indicated by the channel number being displayed when the command received by the command receiving means is broken,

wherein the channel numbers being switched are displayed without displaying a channel selection until operation of the channel selection key is discontinued by the user; and

storage means for storing a plurality of the channel numbers representing channels of transmission signals actually received, wherein the channel number display control means switches the channel numbers being displayed based on the channel numbers stored in the storage means.

Ex. 1001, 10:2–30 (emphasis added).

ANALYSIS

A. *Legal Principles*

To prevail in an *inter partes* review, a petitioner must prove the unpatentability of the challenged claims by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “[T]he petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion never shifts to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review). Furthermore, a petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in

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