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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,061	07/07/2008	6446045	23373-004RX1	8249

7590 05/23/2012  
Michael F. Heim  
HEIM, PAYNE & CHORUSH, LLP  
600 TRAVIS STREET  
SUITE 6710  
HOUSTON, TX 77002

EXAMINER
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GELLNER, JEFFREY L

ART UNIT	PAPER NUMBER
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3993

MAIL DATE	DELIVERY MODE
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05/23/2012

PAPER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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GOOGLE, INC.  
Third Party Requestor, Respondent

v.

FUNCTION MEDIA, L.L.C.  
Patent Owner, Appellant

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Appeal 2011-010724  
*Inter partes* Reexamination Control 95/001,061  
United States Patent 6,446,045 B1  
Technology Center 3900

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Before ALLEN R. MACDONALD, KEVIN F. TURNER, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL

Patent Owner Function Media L.L.C. (hereinafter “Patent Owner”), appeals<sup>1</sup> under 35 U.S.C. §§ 134(b) and 315(a) the Examiner’s decision to reject claims 1-23.<sup>2</sup> Google, Inc., (hereinafter “Requester”) is a party to the Patent Owner’s appeal under 35 U.S.C. § 315(b)(2) and disputes the Patent Owner’s contentions.<sup>3</sup>

On January 27, 2012, a Requirement for Further Briefing (hereinafter “Requirement”), was ordered *sua sponte*. In that Requirement, Patent Owner was required to submit a Supplemental Brief identifying the structure, material, or acts described in their Specification corresponding to the four means-plus-function limitations of independent claim 1.

(Requirement 6.) Requester was given a similar opportunity.

(Requirement 8.)

Patent Owner responded to this requirement in a response filed February 27, 2012, hereinafter “PO Response.” Requester submitted remarks in a response filed March 26, 2012, hereinafter “TPR Response.”

We have jurisdiction under 35 U.S.C. §§ 6, 134 and 315.

We REVERSE.

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<sup>1</sup> See Patent Owner’s Appeal Brief filed September 16, 2010, hereinafter “App. Br.,” at 1.

<sup>2</sup> See Right of Appeal Notice, mailed June 11, 2010.

<sup>3</sup> See Requester’s Respondent Brief filed October 13, 2010.

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## STATEMENT OF THE CASE

This proceeding arose from a request for *inter partes* reexamination filed by John C. Phillips, on behalf of Google Inc., Requester, on July 7, 2008, of United States Patent 6,446,045 B1 (“the '045 Patent”), issued to Lucinda Stone and Michael A. Dean, on September 3, 2002, based on U.S. Application No. 09/480,303, filed January 10, 2000.

The '045 Patent is related to United States Patents 7,240,025 (“the '025 Patent”), 7,249,059 (“the '059 Patent”), and 6,829,587 B2 (“the '587 Patent”) which all claim benefit of priority to the '045 Patent. The '025, '059, and '587 patents were recently under *inter partes* reexamination, control numbers 95/001,073, 95/001,069, and 95/001,068, respectively. The Board recently rendered decisions for the '025, '059, and '587 patents, appeal numbers 2011-101719, 2011-010893, and 2011-013241, respectively.

On March 26, 2012, Patent Owner filed a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit based upon the Board’s decision in appeal numbers 2011-101719, 2011-010893, and 2011-013241.

### *Related Litigation*

The '045, '025, and '059 patents were the subject of litigation styled as *Function Media L.L.C. v. Google Inc. and Yahoo, Inc.*, Civ. A. No. 2:07-cv-279-CE (E.D. Tex.), which is currently on appeal to the U.S. Court of Appeals for the Federal Circuit (Docket No. 2012-1020). (*See App. Br. 1.*)

## THE INVENTION

Patentee's invention relates to an advertising system which allows sellers to create presentations. The system "automatically applies not only editing, style, graphics, data, and content controls but also design specification and architectural requirements to the design environment of all forms of specific member media venues or outlets, both electronic print and all other media formats." (Col. 4, l. 60 – Col. 5, l. 5.)

Exemplary claim 1 on appeal reads as follows (emphases added):

1. A method of using a network of computers to contract for, facilitate and control the creating and publishing of presentations, by a seller, to a plurality of media venues owned or controlled by other than the seller, comprising:

a) providing a media database having a list of available media venues;

b) providing *means for applying* corresponding guidelines of the media venues;

c) providing *means for transmitting* said presentations to a selected media venue of the media venues;

d) providing *means for a seller to select* the media venues; and

e) providing *means for the seller to input information*;

whereby the seller may select one or more of the media venues, create a presentation that complies with said guidelines of the media venues selected, and transmit the presentation to the selected media venues for publication.

(CA-i.)

## PRIOR ART REJECTIONS

The Examiner adopted, with modification, multiple rejections proposed by the Requester for claims 1-23 under 35 U.S.C. §§ 102 and 103 (*see* RAN 70-138).

## ISSUE

While acknowledging the rejections adopted by the Examiner, we find that a preliminary issue of claim scope, the subject of our Requirement for Further Briefing, must be addressed before the propriety of the Examiner's adoption of the cited rejections can be ascertained. As such, the issue to be addressed in this appeal is:

Does the '045 Patent Specification disclose adequate structure corresponding to the four means-plus-function limitations recited by independent claim 1 such that it complies with the requirements of 35 U.S.C. § 112, sixth paragraph?

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

### *'045 Patent*

1. The '045 Patent describes that the Presentation Generation Program **1710** in conjunction with Presentation Rules Database **1640** creates a presentation (i.e., advertisement) for media outlets. (Col. 3, ll. 29-35; Col. 17, ll. 4-11 and 41-45; Col. 42, ll. 39-43; Col 43, ll. 42-51.)

2. The '045 Patent describes that algorithms in Presentation Rules Database **1640** apply information within Presentation Generation Program **1710**. (Col. 43, ll. 14-19.)

3. Figure 2a depicts Presentation Generation Program **1710** on the Central Controller and Presentation Processor **1000**. (Fig. 2a.)

#### PRINCIPLES OF LAW

The use of means-plus-function language in a claim does not excuse an appellant from complying with the claim definiteness requirement of 35 U.S.C. § 112, second paragraph. *See Ergo Licensing, LLC v. CareFusion 303 LLC, Inc.*, 673 F.3d 1361 (Fed. Cir. 2012); *Noah Sys., Inc. v. Intuit Inc.*, No. 2011-1390, 2012 WL 1150216 at \*7 (Fed. Cir. Apr. 9, 2012). If an Applicant does not disclose structure for a means plus function term, the claim is indefinite. *Ergo Licensing, LLC v. CareFusion 303 LLC, Inc.*, 673 F.3d at 1361.

When 35 U.S.C. § 112, sixth paragraph, is invoked, the corresponding structure cannot be “the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999), (citing *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (en banc)). “[T]he patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6 . . . . [A] patentee [may] express that algorithm in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.” *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008) (citation omitted). “Simply disclosing software, however, ‘without providing some detail about the means to accomplish the function[,] is not

enough.”” *Id.* at 1340–41 (citation omitted). Where a means-plus-function limitation of a claim lacks sufficient disclosure of structure under 35 U.S.C. § 112, sixth paragraph, that claim is unpatentable as indefinite under 35 U.S.C. § 112, second paragraph. *In re Aoyama*, 656 F.3d 1293, 1296-97 (Fed Cir. 2011) (citing *Aristocrat Techs. Austl. PTY Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1337-38 (Fed. Cir. 2008)).

#### ANALYSIS<sup>4</sup>

Independent claim 1 recites four means-plus-function limitations. There is no issue between the parties as to whether these limitations invoke 35 U.S.C. § 112, sixth paragraph. Accordingly, the question is whether the '045 Patent Specification discloses adequate structure corresponding to those various means. *See In Re Donaldson Co. Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

In light of Patent Owner’s Appeal Brief and Response to our Request for Further Briefing, we find that the '045 Patent Specification lacks both a concrete corresponding structure and a comprehensible function for the four “permitting means” of independent claim 1. By way of example, for the “means for applying corresponding guidelines of the media venues,” Patent Owner contends that the “Presentation Generation Program” (PGP) is the corresponding structure which performs this function and sets forth various portions of the '045 Patent Specification that allegedly correspond to this means. (PO Response 2.) Additionally, Patent Owner contends that the

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<sup>4</sup> We select claim 1 as the representative claim and confine our discussion to claim 1, with the remaining dependent claims 2-23 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

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Specification links the PGP to these functions in blocks 11230 and 11232 of Figure 4d and blocks 11290-11320 of Figure 4e. (PO Response 2.)

However, we find that the identified portions do little more than recite the functions of the means in different words, without providing any details about how the “corresponding structures” are programmed to perform their respective functions, and fail to disclose to the ordinarily skilled artisan any algorithms or other structure for performing the functions. “[P]urely functional language, which simply restates the function associated with the means-plus-function limitation, is insufficient to provide the required corresponding structure.” *Noah Sys., Inc. v. Intuit Inc.*, 2012 WL 1150216 at \*11; (citing *Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371, 1384 (Fed.Cir.2009); *Aristocrat*, 521 F.3d at 1334). Moreover, we find that the referenced blocks depicted in figures 4d and 4e are no more than high level flow charts, which fail to provide any additional disclosure of the algorithms of the recited means, particularly the “means for applying corresponding guidelines of the media venues.” *See In re Aoyama*, 656 F.3d at 1298. This comports with Requester’s Response. (See TPR Response 4-9.) Thus, we find that the '045 Patent Specification fails to disclose to the satisfaction of an ordinarily skilled artisan enough of an algorithm in understandable terms to provide the necessary corresponding structure under 35 U.S.C. § 112, sixth paragraph, for the means-plus-function limitations of claim 1.

Accordingly, we find the claim to be fatally ambiguous. The remedy for this sort of ambiguity is not to read limitations in from the Specification (which is not possible in this case anyway) or to read the claim broadly, as the Examiner attempts, but rather to reject the claim as indefinite. 35 U.S.C.

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§ 112(2); *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010).

For that reason, if this were a patent application or a claim amended during reexamination, we would enter a new ground of rejection under 37 C.F.R. § 41.50(b) on the basis of 35 U.S.C. § 112, second paragraph, and not reach the rejections under 35 U.S.C. §§ 102 and 103, since they would necessarily be based on speculative assumptions as to the meaning and scope of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

However, in the present case, it would be pointless to enter a new ground of rejection on the basis of indefiniteness because such rejections are beyond the scope of reexamination for issued claims, and as such, the Examiner would be barred by rule from enforcing the rejection. 37 C.F.R. § 1.906(c). Yet, without a discernable claim construction, an anticipation or obviousness analysis cannot be performed since the constructs of 35 U.S.C. § 112, sixth paragraph, require us to construe the claim “to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112(6). “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function [or step-plus-function] language is that statutorily mandated in paragraph six.” *See In Re Donaldson Co. Inc.*, 16 F.3d at 1194-95.

Consequently, we find that proper disposition of this appeal is to reverse the speculative prior art rejections of record without prejudice to its reinstatement if the patent owner files an amendment or reissue application to cure the indefiniteness. While we understand this disposition leaves a critical issue with the claims unresolved, we cannot ignore the fact that

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paragraph six does not absolve an applicant or appellant from complying with the remaining paragraphs of 35 U.S.C. § 112. *See In Re Donaldson Co. Inc.*, 16 F.3d at 1195; (citing *In re Lundberg*, 244 F.2d at 547-48, 113 USPQ at 534 (CCPA 1957)).

### CONCLUSION

We conclude that the '045 Patent Specification fails to disclose adequate structure corresponding to the four means-plus-function limitations recited by independent claim 1, and as such, renders independent claim 1 indefinite.

### DECISION

The Examiner's decision to reject claims 1-23 is REVERSED.

Requests for extensions of time in this inter partes reexamination proceeding are governed by 37 C.F.R. §§ 1.956 and 41.77(g).

REVERSED

cc:

ack

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PATENT OWNER:

MICHAEL F. HEIM  
HEIM, PAYNE & CHORUSH, LLP  
600 TRAVIS STREET  
HOUSTON, TX 77002

THIRD PARTY REQUESTER

JOHN C. PHILLIPS  
FISH & RICHARDSON P.C.  
12390 EL CAMINO REAL  
SAN DIEGO, CA 92130