

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIGITAL ALLY, INC.,
Petitioner,

v.

UTILITY ASSOCIATES, INC.,
Patent Owner.

Case IPR2014-00725
Patent 6,831,556 B1

Before KALYAN K. DESHPANDE, JAMES B. ARPIN, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Utility Associates, Inc. (“Patent Owner”) filed a Request for Rehearing (Paper 28, “Req. Reh’g”) of the Final Written Decision (Paper 27, “Decision” or “Dec.”) determining that Digital Ally, Inc. (“Petitioner”) had shown by a preponderance of the evidence that claims 1–7, 9, 10, and 12–25 of U.S. Patent No. 6,831,556 B1 (Ex. 1001, “the ’556 patent”) are unpatentable. In the Request for Rehearing, Patent Owner argues that we misapprehended or overlooked several matters. For the reasons set forth below, the Request for Rehearing is *denied*.

II. ANALYSIS

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

A. Construction of the “Transmitting” Limitation

In the Decision, we determined that claims 1, 14, 15, 18, and 19 of the ’556 patent do not require transmitting the data stream *from storage* in the vehicle to a second location. Dec. 20–21. We explained that the challenged claims recite transmitting the data stream from the vehicle to a second location, but do not require specifically that the data stream be transmitted *from storage* in the vehicle to a second location. *Id.* We also explained that the Specification and prosecution history of the ’556 patent support that plain reading of the claim language. *Id.* at 21.

Patent Owner argues that we misapprehended the claim language, which dictates that, “[w]ithout the first step of storing, there would be no

‘data stream’ to transfer from the vehicle.” Req. Reh’g 5–6. We considered Patent Owner’s argument, but did not find it persuasive. *See* Dec. 20–21. Claim 1 of the ’556 patent recites “a server for digitally integrating the captured information into one data stream.” Ex. 1001, col. 8, ll. 47–49. This claim language indicates that the term “data stream” refers to a digital integration of the captured information (*id.*), and, at the oral hearing, Patent Owner agreed (Paper 26 (“Tr.”), 41:16–20). Thus, according to the claim language, the data stream exists as soon as the captured information is integrated; storage is not required. The Specification of the ’556 patent states that “all of the various types of information *are aggregated into a single data stream which is then stored* in the storage unit 270.” *Id.* at col. 4, ll. 36–38 (emphasis added). As such, the Specification, like the claim language discussed above, indicates that the data stream exists *before* it is stored in the storage unit. Further, some of the challenged claims recite transmitting the data stream to a second location, even though they do not recite storing the data stream in the vehicle. *See, e.g., id.* at col. 9, ll. 60–63, col 10, ll. 3–6. Those claims also demonstrate that the data stream exists and can be transmitted to a second location without being stored.

Patent Owner argues that we overlooked evidence showing that the claimed “data stream” is defined in the Specification as stored information, and, thus, must be transmitted from storage to a second location. Req. Reh’g 2–3. Patent Owner contends that this argument was presented previously at the oral hearing. *Id.* at 2 (citing Tr. 35:8–13). However, no new arguments may be presented at the oral hearing, and Patent Owner does not identify where this argument was presented prior to the oral hearing. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

Accordingly, we could not have misapprehended or overlooked this argument because Patent Owner had not presented this argument properly.

Moreover, Patent Owner's argument is not persuasive. Patent Owner identifies a portion of the Specification as allegedly defining the "data stream" to mean stored information. Req. Reh'g 2 (citing Ex. 1001, col. 6, ll. 4–9). The portion of the Specification cited by Patent Owner states:

When the vehicle 100 returns to the home base 210, it is connected via a high-speed, high-capacity Ethernet controller 285 (such as a 3COM 1 GB controller) to the home base server 211 via port 290 and *the digitally stored video/audio/related information (i.e., data stream)* is data dumped to a home base master storage repository 212.

Ex. 1001, col. 6, ll. 4–9 (emphasis added). This portion of the Specification describes a particular example in which the video/audio/related information is transmitted from storage in the vehicle to a master storage repository after the vehicle returns to the home base. *Id.* However, this example from the Specification should not be read into the claims. Dec. 7 (citing *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993)). The challenged claims of the '556 patent *broadly* recite transmitting the data stream from the vehicle to a second location. *See, e.g.*, Ex. 1001, col. 8, ll. 50–52, col. 9, ll. 62–63.

Thus, as explained in the Decision, the challenged claims should be construed to include the other embodiments in the Specification, such as those in which the data stream is transmitted live to a second location rather than from storage. Dec. 21; Ex. 1001, col. 3, ll. 17–20, col. 5 ll. 45–50.

Patent Owner's argument also is not persuasive because some of the challenged claims in the '556 patent specify that the second location to which the data stream is transmitted is a "remote location." Ex. 1001, col. 9, ll. 62–63, col. 10, ll. 5–6. However, the portion of the Specification cited by

Patent Owner as allegedly defining the term “data stream” only describes transmitting the data stream to a storage repository at the home base *after* the vehicle returns to the home base. *Id.* at col. 6, ll. 4–9. The home base is not a remote location when the vehicle also is located at the home base.

Because claim terms should be construed consistently throughout a patent (*see Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001)), the challenged claims that recite transmitting the data stream to a remote location demonstrate that the term “data stream” should not be limited to the example in the Specification identified by Patent Owner.

As mentioned above and explained in the Decision, the ’556 patent describes a “live transmission” of information from the vehicle to a second location, which indicates that the challenged claims are not limited to transmitting the data stream from storage to a second location. Dec. 21; Ex. 1001, col. 3, ll. 17–20, col. 5 ll. 45–50. Patent Owner argues that we overlooked evidence indicating that the live transmission described in the ’556 patent only relates to “some information,” not the claimed “data stream.” Req. Reh’g 3. Patent Owner contends that this argument was presented previously at the oral hearing. *Id.* (citing Tr. 36:6–37:22, 40:15–41:15). However, no new arguments may be presented at the oral hearing, and Patent Owner does not identify where this argument was presented prior to the oral hearing. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. Accordingly, we could not have misapprehended or overlooked this argument because Patent Owner had not presented this argument properly.

Moreover, Patent Owner’s argument is not persuasive. The Specification of the ’556 patent states:

In addition, live views of *video/audio/data information* may be transmitted from the vehicle 100 to a home base 210 through high speed local links, e.g., cellular devices, as discussed in further detail later.

Ex. 1001, col. 3, ll. 17–20 (emphasis added). The '556 patent often uses a forward slash (“/”) to indicate that certain functionality or information is integrated. *See, e.g., id.* at col. 3, l. 38 (“multiplexer/CODEC 250”), col. 4, l. 14 (“receiving/transmitting device 283”), col. 5, l. 59 (“remote/local camera control 264”), col. 6, ll. 7–8 (“digitally stored video/audio/related information (i.e., data stream)”), col. 9, ll. 2–4 (“said video/audio/data multiplexer integrates the video, audio, and data information into the data stream”). Thus, the term “video/audio/data information” refers to integrated video, audio, and data information. As discussed above, the term “data stream” also refers to integrated video, audio, and data information. Therefore, the portion of the '556 patent quoted above explains that live views of the video/audio/data information (or data stream) are transmitted from the vehicle to a home base. *Id.* at col. 3, ll. 17–20.

In the Decision, we explained that Figure 2 of the '556 patent shows that CPU 260 is connected directly to transmission unit 280, and, thus, can send the data stream to transmission unit 280 for transmission to second location 210 without having to access storage unit 270. Dec. 21. Patent Owner argues that we misapprehended Figure 2 because the '556 patent states that the “combined video/audio/data information stream is first sent to the RAM memory buffer 276.” Req. Reh’g 4 (quoting Ex. 1001, col. 5, ll. 3–6). However, Patent Owner does not identify where this specific argument was presented previously. Req. Reh’g 4. Accordingly, we could not have misapprehended or overlooked this argument. Moreover, Patent

Owner's argument is not persuasive. The portion of the '556 patent cited by Patent Owner specifies that the video/audio/data information (or data stream) is sent to the RAM memory buffer first before it is sent to the permanent storage memory. Ex. 1001, col. 5, ll. 3–6, col. 5, ll. 15–18. However, the cited portion of the '556 patent does not indicate that the data stream must be sent to the RAM memory buffer (or any other memory) before being transmitted to a second location via the transmission unit. *Id.*

In the Decision, we explained that, during prosecution, the patentee amended the claims to require transmission of “stored information” to a second location and attempted to distinguish the cited prior art on that basis, but subsequently removed the term “stored information” from the claims. Dec. 21; Ex. 1002, 60, 65, 87. Patent Owner argues that we overlooked evidence showing that the Patentee replaced the term “stored information” with the term “data stream,” which indicates that those two terms are “interchangeable.” Req. Reh'g 5. Patent Owner contends that this argument was presented previously at the oral hearing. *Id.* (citing Tr. 63:5–10). However, it is not apparent from Patent Owner's citation to the transcript that this particular argument was presented at the oral hearing. *See* Tr. 63:5–10. Also, no new arguments may be presented at the oral hearing, and Patent Owner does not identify where this argument was presented prior to the oral hearing. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. Accordingly, we could not have misapprehended or overlooked this argument because Patent Owner had not presented this argument properly.

Moreover, Patent Owner's argument is not persuasive. The Patentee's decision to replace one term (“stored information”) with a different term (“data stream”) indicates that those terms were not intended to mean the

same thing. During prosecution, the Patentee also replaced the term “captured information” with the term “data stream.” Ex. 1002, 85. This demonstrates that the Patentee did not intend the term “data stream” to be limited solely to stored information.

B. *Disclosure of the “Transmitting” Limitation by Monroe ’320*

In the Decision, we determined that Monroe ’320 discloses storing the data stream in the vehicle and transmitting the data stream to a remote location. Dec. 21–23. As explained in the Decision, Monroe ’320 discloses that a combined, comprehensive output signal (or data stream) is sent to the vehicle recorder (via line 233 in Figure 15) and transmitted to the base station (via lines 235 and 246 in Figure 15). *Id.* at 22. Patent Owner argues that we misapprehended the disclosure of Monroe ’320 because the signal on lines 233, 235, and 246 in Figure 15 can be selected independently using a controller, and, thus, may differ from one another. Req. Reh’g 7–8. We considered Patent Owner’s argument, but did not find it persuasive. *See* Dec. 20–23. The portions of Monroe ’320 cited by Patent Owner disclose that the controller can select “any single sensor signal, or any combination” thereof. Ex. 1004, col. 23, ll. 17–33; Dec. 20. *Any* combination of sensor signals includes *all* of the sensor signals. Dec. 20. Because Monroe ’320 discloses that the controller can select all of the sensor signals for each of lines 233, 235, and 246 in Figure 15, Monroe ’320 discloses that the same data stream can be stored in the vehicle recorder and transmitted to the base station.

Patent Owner also argues that “a person of ordinary skill in the art would have known that the bandwidth limitations of an aircraft radio at the time of the ’556 patent would not have allowed ‘all data’ being stored on

record 70 to be wirelessly transferred.” Req. Reh’g 9–10. Patent Owner contends that this argument was presented previously at the oral hearing. *Id.* (citing Tr. 49:17–51:22). However, no new arguments or evidence may be presented at the oral hearing, and Patent Owner does not identify where this argument was presented prior to the oral hearing. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. Accordingly, we could not have misapprehended or overlooked this argument because Patent Owner had not presented this argument properly.

Moreover, Patent Owner’s argument is not persuasive. Patent Owner’s argument is inconsistent with the express disclosure of Monroe ’320 that indicates the controller can select “any combination” of sensor signals for transmission to a remote location. Ex. 1004, col. 23, ll. 17–33. Further, Patent Owner does not identify any evidence regarding what a person of ordinary skill in the art would have known at the time of the ’556 patent. Req. Reh’g 9–10. Patent Owner also does not explain what the bandwidth limitation of an aircraft radio was at the time of the ’556 patent or what bandwidth would have been required to transmit all the data to a remote location. *Id.*

C. *Petitioner’s Reply Arguments*

Patent Owner contends that we misapprehended Patent Owner’s argument regarding the improper scope of Petitioner’s Reply. Req. Reh’g 11–15. Specifically, Patent Owner argues that “[t]he proper focus is whether Petitioner ‘changed [its] unpatentability rationale’ through its Reply.” *Id.* at 12. According to Patent Owner, Petitioner argued in the Petition that the challenged claims require transmitting the data stream *from storage* in the vehicle to a second location, but, in the Reply, “abandoned its original

position and adopted a new argument” that the challenged claims do not require transmitting the data stream *from storage* to a second location. *Id.* at 12–13. We considered Patent Owner’s argument, but did not find it persuasive. Dec. 22, n.4.

Patent Owner does not identify any portion of the Petition where Petitioner argued that the challenged claims require transmitting the data stream *from storage* in the vehicle to a second location. *Id.* at 11–15. Rather, Petitioner construed the challenged claims more broadly to mean transmitting the data stream from the vehicle to a second location. Paper 2 (“Pet.”), 35–36. Specifically, Petitioner’s argument in the Petition regarding the “transmitting” limitation of the challenged claims is reproduced below.

Monroe discloses wirelessly transmitting the muxed data from the aircraft and to the ground station: “Where desired, selected portions of the systems data on the aircraft may be down-linked to the ground or base station 18 (see FIG. 4) as the combined, comprehensive output signal on line 246 *to be transmitted to the ground station via the aircraft radio system 80 and the antenna 82.* As previously described, the information may also be transmitted to a wireless satellite via transceiver 280 and dedicated antenna 282.” (23:17-22; *see also*, 14:3-6: “FIGS. 4a and 4b show two different schemes permitting transmission of monitor system data from a transport 10 to a base station monitor 18 using a wireless transmission scheme as indicated at 12.”). The ground station 18 is a second location remote from the aircraft. (*See*, e.g., Figs. 3 & 18).

Additionally, it is the master controller 241 that transfers the muxed data to the ground station: “The system controller receives commands and streaming audio information from other system elements and distributes them to controlled devices. The controller performs a command decoding function to sort out command and data streams directed toward specific devices and components of the system.” (23:2-7).

Id. (emphasis added). In the above excerpt, Petitioner argued that Monroe '320 discloses “transmitting the muxed data *from the aircraft* and to the ground station,” which indicates that Petitioner construed the challenged claims only to require transmitting the data stream from the aircraft to a second location. *Id.* (emphasis added). Notably, Petitioner did not argue that Monroe '320 discloses transmitting the data *from storage* in the aircraft to the ground station. *Id.* In a section of the Petition entitled “Brief Summary of the '556 Patent Technology,” Petitioner mentioned an example from the Specification of the '556 patent that describes transmitting information from the memory in the vehicle to a remote storage depository. *Id.* at 3. However, Petitioner did not argue or suggest that the challenged claims are limited to that particular example in the Specification. *Id.*

In the Response to the Petition, Patent Owner presented two arguments regarding the “transmitting” limitation. Patent Owner first argued that Monroe '320 does not anticipate claims 1, 14, 15, 18, and 19, because it does not disclose transmitting the data stream from storage in the vehicle to a second location. Paper 13 (“PO Resp.”), 26–31. Patent Owner acknowledged, though, that Petitioner may dispute whether the challenged claims require transmitting the data stream from storage in the vehicle to another location. *Id.* at 30. Therefore, Patent Owner also argued that Monroe '320 does not disclose transmitting the same data stream to the recorder for storage and the transceiver for transmission to the ground station. *Id.* at 31–34.

In the Reply, Petitioner *responded* to the arguments in the Response. *See* 37 C.F.R. § 42.23(b). As Patent Owner expected, Petitioner argued that the “transmitting” limitation does not require transmitting the data stream

from storage in the vehicle to a second location. Paper 16 (“Pet. Reply”), 8. Petitioner’s argument in the Reply regarding the proper construction of the “transmitting” limitation was consistent with Petitioner’s arguments in the Petition regarding that limitation. Pet. 35–36. Petitioner also argued in the Reply that Patent Owner’s reading of Monroe ’320 was incorrect because Monroe ’320 discloses that the same multiplexed data is sent to the recorder for storage and the transceiver for transmission to the ground station. Pet. Reply 8–11. This argument also was consistent with Petitioner’s argument in the Petition that Monroe ’320 discloses “transmitting the muxed data from the aircraft and to the ground station.” Pet. 35. Therefore, Patent Owner does not demonstrate that Petitioner changed its unpatentability rationale between the Petition and the Reply, or that the arguments in the Reply otherwise were improper. *See Belden Inc. v. Berk-Tek LLC*, No. 2014-1575, 2015 WL 6756451, at *10–15 (Fed. Cir. Nov. 5, 2015).

III. CONCLUSION

We are not persuaded that the Request for Rehearing demonstrates that we misapprehended or overlooked any matters in the Decision.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is *denied*.

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