UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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BLACKBERRY CORPORATION and BLACKBERRY LIMITED[1]
Petitioner

v.

MOBILEMEDIA IDEAS, LLC
Patent Owner
_____

Case IPR2013-00036
Patent 6,871,048
_____

Before JAMESON LEE, KEVIN F. TURNER, and JONI Y. CHANG,
*Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Termination of Proceeding
*37 C.F.R. § 42.72*

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[1] Petitioner originally identified as Research In Motion Corporation and
Research In Motion Limited changed their names to "BlackBerry
Corporation" and "BlackBerry Limited," respectively.  Paper 37.

## I. BACKGROUND

### A. *Introduction*

Petitioner, BlackBerry Corporation and BlackBerry Limited ("Blackberry"), filed a petition on October 30, 2012, for an *inter partes* review of claims 1-12 of US Patent No. 6,871,048 ("the '048 patent") pursuant to 35 U.S.C. §§ 311-319. That petition was followed by a corrected petition (Paper 7, "Pet."), filed on November 6, 2012. On March 18, 2013, the Board instituted trial on claims 1-12 of the '048 patent based on all grounds of unpatentability alleged in the petition. Paper 15. The Board has jurisdiction under 35 U.S.C. § 6(c).

After institution of trial, Patent Owner, MobileMedia Ideas LLC ("MobileMedia"), filed a patent owner response ("PO Resp."). Paper 27. Blackberry filed a reply. Paper 39. An oral hearing was held on October 18, 2013. A transcript of the oral hearing is included in the record as Paper 63.

On December 16, 2013, the parties filed a joint motion to terminate proceeding (Paper 60), which was *granted-in-part*. The Board terminated the proceeding with respect to Blackberry, but not with respect to MobileMedia. Paper 64.

For the reasons discussed below, we are unable to reach a determination on the alleged grounds of unpatentability over prior art. Accordingly, we terminate this proceeding under 37 C.F.R. § 42.72.

## B. The '048 Patent

The '048 patent relates to "a mobile communication apparatus for carrying out communication through radio waves" and "an information providing system using the mobile communication apparatus." Ex. 1001, 1:9-13. The specification of the '048 patent describes that for a wireless mobile communication apparatus, audio communication is mainstream, but there is an increasing need for "composite and multiple data communication of character information, image information, video information, or the like." *Id*. at 1:22-28. In the Background section, the specification describes that a user of a mobile communication apparatus often carries, in addition, a portable sound device for reproducing music data recorded on a magnetic tape, an optical disc, a magneto-optical disc, or the like, or a portable radio receiver for receiving AM broadcasting, FM broadcasting, TV sound, or the like. *Id*. at 1:36-43. In the Summary section, the specification states:

> In view of the fact that usage efficiency of a mobile communication apparatus is not absolutely high, and a user carries a portable sound device, a portable radio receiver, or the like in addition to the mobile communication apparatus, an object of the present invention is to provide a mobile communication apparatus and an information providing system using the mobile communication apparatus in which the functions of these devices are combined so that the user of the mobile communication apparatus can obtain information of desired contents at a desired time without additionally carrying other devices.

*Id*. at 1:48-58.

The claimed invention requires reproducing and outputting downloaded data when the apparatus is in a "stand-by" state. Claims 1 and 7 are the only independent claims. Claim 1 is directed to a mobile communication apparatus, and claim 7 is directed to an information providing system comprising a mobile communication apparatus.

Both claims 1 and claim 7 recite elements in means-plus-function format pursuant to 35 U.S.C. § 112, sixth paragraph, including (emphasis added):

> processing means *for encrypting* the information signals prior to storage in said memory means.

For context, the entirety of claim 1 is reproduced below:

> 1. A mobile communication apparatus, comprising:
>
> a) communication means for transmitting and receiving information signals to and from a base station via radio waves; said base station further transmitting and receiving information signals to and from a service provider through a public line network;
>
> b) input/output means for a user to interact with said mobile communication apparatus; said input/output means comprising a keypad, display means, a speaker, and a microphone;
>
> c) a removable semiconductor memory for storing received information signals; and
>
> d) processing means for encrypting the information signals prior to storage in said memory means;
>
> whereby said mobile communication apparatus is selectively operable to perform one of the operations of outputting received information signals at the time of reception,

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storing received information signals for output at a later time, and simultaneously outputting and storing received information signals; and

whereby said mobile communication apparatus is operable to reproduce and output downloaded data when said apparatus is in a stand-by state.

Notable features of the claimed mobile device are that it transmits and receives information signals to and from a base station via radio waves, that the base station further transmits and receives information to and from a service provider through a public line network, that the device encrypts received information signals prior to storing them, and that the device may perform one of three selectable operations: (1) outputting received information at the time of reception; (2) storing the received signals for outputting at a later time; and (3) simultaneously outputting and storing the received information. The device is also operable, while in stand-by mode, to reproduce and output downloaded data.

## C. Prior Art References

| Rydbeck et al. ("Rydbeck") | US Patent No. 7,123,936 B1 | Oct. 17, 2006 | Exhibit 1002 |
|---|---|---|---|
| Hageltorn et al. ("Hageltorn") | US Patent No. 6,006,117 | Dec. 21, 1999 | Exhibit 1003 |
| Allard et al. ("Allard") | US Patent No. 5,422,656 | June 6, 1995 | Exhibit 1006 |
| Kleiman | US Patent No. 5,959,945 | Sept. 28, 1999 | Exhibit 1007 |
| Salomäki | Int. Pub. WO97/28649 | Aug. 7, 1997 | Exhibit 1004 |
| RealPlayer | RealPlayer Plus 4.0 Manual, Progressive Networks, Inc. | 1997 | Exhibit 1005 |

## D. Alleged Grounds of Unpatentability

| Claims | Ground | References |
|---|---|---|
| Claims 1-5 and 7-11 | § 103 | Rydbeck, Hageltorn, Salomäki, and RealPlayer |
| Claims 6 and 12 | § 103 | Rydbeck, Hageltorn, Salomäki, RealPlayer, and Allard |
| Claims 1-5 and 7-11 | § 103 | Rydbeck, Hageltorn, Kleiman, and RealPlayer |
| Claims 6 and 12 | § 103 | Rydbeck, Hageltorn, Kleiman, RealPlayer, and Allard |

## II.    DISCUSSION

### A. Introduction

A determination of anticipation and obviousness over prior art begins with claim construction.  *See In re Hiniker Co*., 150 F.3d 1362, 1369 (Fed. Cir. 1998) ("[T]he name of the game is the claim." (quoting Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims— American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990))).  It is axiomatic that we first must know what is being claimed.

Not every such patentability analysis, however, necessarily ends with a determination with respect to the prior art.  The language used in a claim to define the scope of coverage, read in light of the specification, may be indefinite and thus fail to indicate the scope of the claimed invention.  *See, e.g., In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

A patent 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) differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations of nonobviousness.  *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

As explained below, the scope of the claims of the '048 patent cannot be determined without speculation. Consequently, the differences between the claimed invention and the prior art cannot be determined. In this circumstance, the analysis begins and ends with the claims, and we do not attempt to apply the claims to the prior art. *See In re Wilson*, 424 F.2d at 1385; *In re Steele*, 305 F.2d at 862-63; *accord United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 237 (1942) (indefiniteness moots consideration of prior art issues).

### B. The Law on the Construction of a Computer-Implemented Means-Plus-Function Element

With regard to a claim element set forth in "means-plus-function" form, its scope and meaning are governed by 35 U.S.C. § 112, sixth paragraph, which provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim *shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof*.

(emphasis added).[2]

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[2] Section 4(c) of the America Invents Act, Pub. L. 112-29, 125 Stat. 284, 329 (2011) ("AIA") re-designated 35 U.S.C. § 112, sixth paragraph, as 35 U.S.C. § 112(f). Because the '048 patent has a filing date prior to September 16, 2012, the effective date of the AIA, we refer to the pre-AIA version of 35 U.S.C. § 112.

The above-quoted rule of construction applies regardless of the tribunal attempting to interpret a claim, e.g., the United States Patent and Trademark Office or a United States District Court. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (*en banc*).

The United States Court of Appeals for the Federal Circuit has given considerable, clear, and consistent guidance, with regard to the construction of a computer-implemented means-plus-function claim element under 35 U.S.C. § 112, sixth paragraph. Except for a narrow exception explained in *In re Katz*, 639 F.3d 1303, 1316 (Fed. Cir. 2011), concerning generic functions performed by a general-purpose computer, such as "processing," "receiving" and "storing," a computer-implemented means-plus-function element is indefinite unless the specification discloses the specific algorithm used by the computer to perform the recited function. *Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1318 (Fed. Cir. 2013); *In re Katz*, 639 F.3d at 1315; *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008); *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008); *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Techs., Inc.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

The following explanation from the Federal Circuit in *Function Media* is instructive:

> Section 112, paragraph 6 allows for a limited exception [to the particularly pointing out and distinctly claiming requirement of Section 112, second paragraph], permitting "a claim [to] state the function of the element or step, and the 'means' covers the

'structure, material, or acts' set forth in the specification and equivalents thereof." [*Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1383 (Fed. Cir. 2011)]. The trade-off for allowing such claiming is that "the specification must contain sufficient descriptive text by which a person of skill in the field of the invention would 'know and understand what structure corresponds to the means limitation.'" *Id*. at 1383-84 (quoting *Finisar Corp. v. DirecTV Grp., Inc*., 523 F.3d 1323, 1340 (Fed. Cir. 2008)).

. . . . When dealing with a "special purpose computer-implemented means-plus-function limitation," we require the specification to disclose the algorithm for performing the function. The "specification can express the 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." *Id*.

708 F.3d at 1317-18.

The need for disclosure of the specific algorithm used to program the computer is explained in *WMS Gaming, Inc. v. International Game Technology*: "In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general-purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." 184 F.3d 1339, 1349 (Fed. Cir. 1999) (citation and footnote omitted). Consequently, the specification must disclose enough of a specific algorithm to provide the necessary structure under § 112, sixth paragraph. *Finisar*, 523 F.3d at 1340. Indeed, allowing a computer programmed to perform a specialized function to be claimed without disclosure of the algorithm used for that programming would exhibit the same type of

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impermissible overbreadth of purely functional claims. *Net MoneyIN*,
545 F.3d at 1367.

> The Federal Circuit stated, in *Aristocrat*, 521 F.3d at 1333:

> For a patentee to claim a means for performing a particular
> function and then to disclose only a general purpose computer
> as the structure designed to perform that function amounts to
> pure functional claiming. Because general purpose computers
> can be programmed to perform very different tasks in very
> different ways, simply disclosing a computer as the structure
> designated to perform a particular function does not limit the
> scope of the claim to "the corresponding structure, material, or
> acts," that perform the function, as required by section 112[,]
> paragraph 6.

"The point of the requirement that the patentee disclose particular structure
in the specification and that the scope of the patent claims be limited to that
structure and its equivalents is to avoid pure functional claiming." *Id.*

Thus, the disclosure of a general-purpose computer is insufficient to
provide the corresponding structure required by 35 U.S.C. § 112, sixth
paragraph, for a means-plus-function element recited as performing anything
other than a basic generic function of a general-purpose computer. For
example, in *Aristocrat*, 521 F.3d at 1333, the court affirmed a district court's
ruling that the claims were indefinite because of lack of disclosure of any
specific algorithm used by the disclosed computer to perform the function
recited in a means-plus-function element. The outcome is the same for one
or more claims in *Function Media*, 708 F.3d at 1319, *Net MoneyIN*,
545 F.3d at 1367, *Blackboard*, 574 F.3d at 1385, and *Finisar*, 523 F.3d
at 1340-41.

C. "processing means for encrypting the information
signals prior to storage in said memory means"

Each of independent claims 1 and 7 recites: "processing means for encrypting the information signals prior to storage in said memory means." Both Blackberry and MobileMedia identify this claim language as reciting a means-plus-function element under 35 U.S.C. § 112, sixth paragraph. Pet. 14; PO Resp. 24. Both Blackberry and MobileMedia recognize the function recited as "encrypting the information signals prior to storage in said memory means." *Id*. We agree with the identification of the parties.

Blackberry identifies the corresponding structure in the specification of the '048 patent as "*recording/reproducing section 18 (Fig. 1)*" and notes that that section is described in the specification of the '048 patent as "*made of a microprocessor and the like*." Pet. 14 (citing Ex. 1001, 4:41-42). MobileMedia identifies the corresponding structure in the specification of the '048 patent as "microprocessor or the like, or an equivalent thereof, programmed as described in the patent to perform the claimed function." PO Resp. 24. For the reasons stated below, we determine that neither proposed construction provides sufficient corresponding structure, as required under 35 U.S.C. § 112, sixth paragraph.

The specification describes that recording/reproducing section 18 "encrypts the music data or news data" to keep data in the memory secure (Ex. 1001, 5:64 to 6:3), and that recording/reproducing section 18 "is made of a microprocessor and the like" (Ex. 1001, 4:42-43). Because the "processing means for encrypting the information signals prior to storage in

said memory means" is a computer-implemented means-plus-function
element under 35 U.S.C. § 112, sixth paragraph, the specification must
disclose a specific algorithm with which to program the general-purpose
microprocessor, to provide a corresponding structure. This is not a
circumstance falling within the narrow exception explained in *In re Katz*,
639 F.3d at 1316, where the function recited is generic and can be performed
by any general-purpose computer without special programming, *e.g.*,
"processing," "receiving," "storing." At issue, here is the specialized
function of *encrypting information signals* prior to storage.

In the circumstance here, involving a specialized function of
encrypting information signals, the corresponding structure to the means-
plus-function recitation cannot be a general-purpose computer, but must be a
special purpose computer programmed to perform *a disclosed algorithm*
causing the computer to accomplish the recited function. *WMS Gaming*,
184 F.3d at 1349, *see also Harris Corp. v. Ericsson, Inc.*, 417 F.3d 1241,
1253 (Fed. Cir. 2005) ("A computer-implemented means-plus-function term
is limited to the corresponding structure disclosed in the specification and
equivalents thereof, and the corresponding structure is the algorithm.").

It is not in dispute that the specification of the '048 patent discloses no
specific algorithm with which to program the microprocessor to achieve the
function of "encrypting the information signals prior to storage in said
memory means." In its petition, Blackberry states that the '048 patent does
not disclose an algorithm for performing the claimed encrypting function.

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Pet. 14.  At final hearing, counsel for MobileMedia acknowledged that the
specification of the '048 patent does not describe an encryption algorithm:

> [Counsel]:  The specification describes the hardware for doing
> it, not the encryption algorithm.  That's right.  We don't do the
> encryption algorithm, because it doesn't matter for this
> invention what the encryption algorithm is, it's that there's a
> processor in the phone for encrypting.  And it's not -- doesn't
> matter and that's really what's important here that it's all taking
> place on the phone.  All right?

Paper 63, 39:3-9.

MobileMedia's belief that disclosure of an encryption algorithm is
unimportant is refuted by the plain language of the statute and specific
reasons that prompted Congress to enact 35 U.S.C. § 112, sixth paragraph.
The sixth paragraph of 35 U.S.C. § 112, when enacted, was a statutory
response to the Supreme Court's decision in *Halliburton Oil Well
Cementing Co. v. Walker*, 329 U.S. 1, 8-9 (1946),[3] which held as
impermissible use of a "means-plus-function" term, purely functional, to
encompass any and all structures for achieving that a result, including those
which were not what an applicant had invented.

In *Greenberg v. Ethicon Endo-Surgery Inc.*, the Federal Circuit stated:

> As this court has observed, "[t]he record is clear on why
> paragraph six was enacted."  *In re Donaldson Co.*, 16 F.3d
> 1189, 1194, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc).

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[3] *Halliburton* was the culmination of a long line of cases dealing with the
use of terms such as "means" and "mechanisms" in claims.  *See, e.g.*, A.W.
Deller, *Walker on Patents*, § 166, 790-94 (Deller's Ed. 1937).

> In *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 67 S.Ct. 6, 91 L.Ed. 3, 71 USPQ 175 (1946), the Supreme Court held invalid a claim that was drafted in means-plus-function fashion. Congress enacted paragraph six, originally paragraph three, to overrule that holding. In place of the *Halliburton* rule, Congress adopted a compromise solution, one that had support in the pre-*Halliburton* case law: Congress permitted the use of purely functional language in claims, but it limited the breadth of such claim language by restricting its scope to the structure disclosed in the specification and equivalents thereof. *See Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1041-42, 25 USPQ2d 1451, 1453-54 (Fed. Cir. 1993); *In re Fuetterer*, 50 C.C.P.A. 1453, 319 F.2d 259, 264 n.11, 138 USPQ 217, 222 n.11, 138 USPQ 217, 222 n.11 (CCPA1963).

91 F.3d 1580, 1582 (Fed. Cir. 1996).

Thus, means-plus-function type purely functional claim language is now permissible but only under the restrictive conditions of 35 U.S.C. § 112, sixth paragraph, i.e., limited in scope to the corresponding structure, material, or acts disclosed in the specification and equivalents thereof. The statutory provision creates a *quid pro quo*—in order to use purely functional language to set forth a claim element, a patentee must describe in the specification the corresponding structure, material, or acts, and coverage of the functional claim language is limited to such disclosed structure, material, or acts. *See Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381-82 (Fed. Cir. 1999).

1. MobileMedia's Argument That Encrypting Data Was Well Known

MobileMedia argues that at the time of invention of the '048 patent, encryption of digital content was well known, citing the testimony of its expert witness Dr. Vijay Madisetti. PO Resp. 26:4-5 (citing Ex. 2006 ¶ 40). That argument is misplaced, and does not help MobileMedia's position with regard to the lack of disclosure in the '048 patent of any algorithm for performing the recited function. The same argument was made by a patentee and rejected squarely by the Federal Circuit in *Function Media,* 708 F.3d at 1319 ("Having failed to provide any disclosure of the structure for the 'transmitting' function, FM cannot rely on the knowledge of one skilled in the art to fill in the gaps."). In that case, the court stated:

> Furthermore, it is well established that proving that a person of ordinary skill *could* devise some method to perform the function is not the proper inquiry as to definiteness—that inquiry goes to enablement. *See Blackboard*, 574 F.3d at 1385.

*Id.* The Federal Circuit also has provided additional clear guidance:

> A patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function. To allow that form of claiming under section 112, paragraph 6, would allow the patentee to claim all possible means of achieving a function. *See Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 (Fed. Cir. 1999) ("consideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification").

That ordinarily skilled artisans could carry out the recited function in a variety of ways is precisely why claims written in "means-plus-function" form must disclose the particular structure that is used to perform the recited function. By failing to describe the means by which the access control manager will create an access control list, Blackboard has attempted to capture any possible means for achieving that end. Section 112, paragraph 6, is intended to prevent such pure functional claiming. *Aristocrat*, 521 F.3d at 1333.

*Blackboard*, 574 F.3d at 1385. Accordingly, in the context of identifying disclosed structure corresponding to a means-plus-function claim element, where no algorithm is described for programming the microprocessor to perform encryption, it is of no moment that one with ordinary skill in the art would have known how to design and create an encryption algorithm.

### 2. MobileMedia's Argument That the Specification's Mention of "and the like" is a Disclosure of Other Structures

MobileMedia points to the specification's description that recording/reproduction section 18 "is made of a microprocessor *and the like*" (Ex. 1001, 4:42-43, emphasis added), and cites to the testimony of Dr. Vijay Madisetti (Ex. 2006 ¶ 44), to argue that a person of ordinary skill at the time of the invention would understand that "and the like" includes processor structures other than a general purpose computer. PO Resp. 25:2-5. MobileMedia further argues that at the time of the invention of the '048 patent, it was common for encryption to be performed by specialized

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dedicated hardware, and not by a general purpose computer. *Id.* at 25:5-7 (citing Ex. 2006 ¶¶ 44-45).

These arguments are unpersuasive. They essentially are the same as the argument already rejected above in Section II.C.1., only presented again in a different form. We reiterate that it does not matter what one with ordinary skill in the art would have known about other structures useable to perform encryption of data. Those structures must be described specifically in the specification to be regarded as corresponding to the claimed means-plus-function element with the function of encrypting data. Also, the phrase "and the like" does not mean "and anything else." Rather, it refers to components comparable to the microprocessor described in the specification, for which the specification sets forth no specific encryption algorithm. Thus, all of the "and the like" components are, like the general-purpose microprocessor, equally without specific structure.

We do not credit the testimony of Dr. Madisetti, that one skilled in the art at the time of the invention of the '048 patent would understand that "and the like" includes processor structures other than a general-purpose computer (Ex. 2006 ¶ 44), because he does not explain why the structure of a special-purpose computer programmed with a specific encryption algorithm would be "like" the structure of a general-purpose computer without the algorithm. Dr. Madisetti also does not explain why the structure of any specialized dedicated hardware component used for encryption would be "like" the structure of a general-purpose computer with no encryption algorithm.

In any event, no specific encryption algorithm is disclosed in the specification, and neither is the structure of any specialized dedicated hardware encryption component. The phrase "and the like" does not add specific structure to the disclosure, to constitute a sufficiently specific structure corresponding to the claimed "processing means for encrypting the information signals prior to storage in said memory means."

We do not credit the above-noted testimony of Dr. Vijay Madisetti, also in part because, in paragraph 44 of his declaration (Ex. 2006), he testifies, without explanation, that the description of the '048 patent does not link the function of "encrypting" to a microprocessor. That testimony is contradicted plainly by express description in the specification of the '048 patent that recording/reproducing section 18 performs the encryption (Ex. 1001, 6:1-2) and that recording/reproducing section 18 is made of a microprocessor and the like (Ex. 1001, 4:42-43). MobileMedia has not made the argument that the means-plus-function element reciting the function of encrypting data is not linked to the microprocessor, and even identifies the microprocessor as the corresponding structure. PO Resp. 24.

Similarly, to the extent that MobileMedia also argues that equivalent structures are covered, expressly by statute, by the claimed means-plus-function element, that argument is ineffective to add specific disclosure of any particular structure to the specification. That a means-plus-function element is construed to cover corresponding structure described in the specification and equivalents thereof does not mean the specification is deemed to have described any non-disclosed structure. In any event, if what

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has been described specifically is insufficiently specific, then structures equivalent thereto also would be insufficiently specific.

### 3. MobileMedia's Argument for Doing Prior Art Analysis Without the Corresponding Structure

MobileMedia asserts that, with respect to a means-plus-function claim element, it is not necessary to identify the corresponding structure disclosed in the specification if the prior art does not account for the recited function. PO Resp. 22:15-17. That argument is unpersuasive. In essence, MobileMedia urges us to conduct the prior art analysis based on only the functional recitation of the means-plus-function element. We decline to do so. As discussed above, that is contrary to the requirements of both 35 U.S.C. § 112, sixth paragraph, and 35 U.S.C. § 103. The obviousness determination is directed to the claimed invention as a whole, not to any partial invention that does not include all of the requirements of the claim. 35 U.S.C. § 103; *Graham*, 383 U.S. at 17-18. Furthermore, an obviousness determination based on less than all of the claimed elements is speculative as to the meaning or scope of the claims. *See In re Steele*, 305 F.2d at 862-63 (the prior art grounds of unpatentability must fall, *pro forma*, because they are based on speculative assumption as to the meaning of the claims). Without ascertaining the proper claim scope, we cannot conduct a necessary factual inquiry for determining obviousness—ascertaining differences between the claimed subject matter and the prior art. *See Graham*, 383 U.S. at 17-18.

CONCLUSION

For the foregoing reasons, we are unable to determine obviousness of claims 1-12 of the '048 patent under 35 U.S.C. § 103.  Accordingly, it is appropriate to terminate the proceeding under 37 C.F.R. § 42.72.

ORDER

It is

ORDERED that Blackberry's Motion to Exclude Evidence (Paper 50) is *dismissed* as moot;

FURTHER ORDERED that we do not proceed to a final written decision under 35 U.S.C. § 318(a); and

FURTHER ORDERED that this proceeding is hereby terminated under 37 C.F.R. § 42.72.


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