

UBISOFT Entertainment SA v. Princeton Digital Image Corp: Final Written Decision of Expired Patent Uses Phillips Construction IPR2014-00635

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: For an expired patent, the Board may apply the Phillips standard to construe claim language; under Phillips, claims are given their ordinary and customary meanings as understood by an ordinary artisan at the time of the invention.

In its [Final Written Decision](#), the Board held that Petitioner has shown by a preponderance of the evidence that claims 1-13, 15-18, and 21-23 are unpatentable. The '129 patent, as described by the Board, relates to systems and methods for controlling a computer system, particularly a virtual reality computer system, using audio signals. Petitioner challenged that patentability of the '129 patent as follows: (1) claims 10 and 11 are allegedly anticipated by Tsumura, (2) claims 5-7, 9-12, 16-18, 22, and 23 are allegedly anticipated by Lytle, (3) claims 1, 12, 13, 15, and 21 are allegedly anticipated by Adachi, (4) claims 1, 8, 12, 13, 15, and 21 are allegedly obvious over Lytle and Adachi, and (5) claims 1-4, 12, 13, 15, and 21 are allegedly obvious over Thalmann and Williams.

The '129 patent expired on July 14, 2013. Thus, the Board applied the *Phillips v AWH Corp.* standard to construe the claim language. Under *Phillips*, words of a claim are generally given their ordinary and customary meaning as understood by an ordinary artisan at the time of the invention. The Board construed “virtual environment” to include “parenthetical statements of intent,” but under *Phillips*, the Board construed the term to encompass the embodiments of the specification. Thus, “virtual environment” was construed broadly to include graphic displays. The Board also construed several means plus function claim limitations and identified the corresponding structure associated with each recited function.

Petitioner alleged that claims 10 and 11 of the '129 patent are anticipated by Tsumura. Relying on its declarant, Patent Owner argued that Tsumura does not disclose that the computer system is operated in response to a prerecorded control track having audio or control information. According to Patent Owner, Tsumura merely displays the words of a song along with suggestions to a singer while playing music. The Board determined that Tsumura discloses operating a system according to a “control track” in that the system will display messages to a user that depend on a comparison of the stored data and the user’s vocal performance, as recited in claim 10. The Board also agreed with Petitioner that Tsumura teaches synchronized playback with the display of lyrics and vocal instructions to the user. According to the Board, this corresponds to the features disclosed in claim

As for Petitioner's anticipation challenge based on Lytle, Patent Owner argued that Lytle does not disclose operating the virtual reality computer system in response to a prerecorded control track to generate the virtual environment. Petitioner countered that Patent Owner's argument relies on a narrow interpretation of "virtual environment" that is inconsistent with the specification of the '129 patent. The Board agreed with Petitioner. Next, Patent Owner argued that Petitioner improperly picked and chose different parts from different systems from Lytle. Petitioner argued that it relied upon Fig. 199 system in Lytle and did not combine two systems to make its anticipation argument. The Board agreed with Petitioner that the system depicted in Fig. 199 of Lytle performs both steps recited in claims 5 and 10. The Board also determined that claims 6, 7, 9, and 11 are anticipated by Lytle.

Patent Owner advanced the same arguments for why Lytle did not anticipate claim 12 that it presented above with respect to claims 5 and 10. Patent Owner also argued that Lytle lacks structural features that are recited in claim 12 such as a second processor, an audio amplifier, an audio source, a multichannel audio digitizer, etc. Petitioner argued that Patent Owner's position relies upon a faulty means plus function claim construction analysis. The Board agreed with Petitioner and determined that Lytle anticipates claim 12 as well as dependent claims 13-15.

Regarding claims 16 and 22, Patent Owner made the same arguments that were made with respect to claims 5 and 10 above, and that Lytle does not disclose certain structural features similar to the argument made with respect to claim 12. The Board dismissed these arguments for the reasons stated above. Patent Owner also argued that Lytle does not disclose structure corresponding to the function recited in the "means for producing a virtual environment in response to the prerecorded control track" as recited in claims 16 and 22. The Board disagreed, stating the Lytle discloses the corresponding structures, and even if it did not, Patent Owner did not argue that the corresponding structure included all of the allegedly missing components. Thus, the Board concluded that claims 16 and 22, as well as claims 17, 18, and 23 are anticipated by Lytle.

The Board next addressed Petitioner's assertion that Adachi anticipates claims 1, 12, 13, 15, and 21. Patent Owner argued that Adachi does not disclose the "means for supplying" as recited in claim 12. As above, Petitioner argued that Patent Owner's response is based on an improper means plus function claim construction and the Board agreed. Patent Owner argued that Adachi does not disclose generating a virtual environment or operating a virtual reality computer system as recited in claims 1, 12, and 21. The Board noted that when a "virtual environment" is properly construed in light of the Specification, it does not require a change in perspective as a user moves. Thus, the Board disagreed with Patent Owner's interpretation and concluded that claims 1, 12, 13, 15, and 21 are anticipated by Adachi.

Petitioner argued that the combination of Lytle and Adachi renders claims 1, 8, 12, 13, 15, and 21 obvious. Patent Owner argued that the combination of references does not disclose "virtual environment" or generating such an environment as recited in claims 1 and 5. Patent Owner made similar arguments to those above, which relied on an improper claim construction. Thus, the Board found Patent Owner's arguments unpersuasive.

As for the obviousness challenge of claims 1-4, 12, 13, 15, and 21 over Thalmann and Williams, the Board determined that one of ordinary skill in the art would have known to modify Thalmann to process a music signal to generate a control signal as taught by Williams. The Board did not agree with Patent Owner's arguments based on the same analysis it provided above. Thus, the Board

concluded that claims 1, 8, 12, 13, 15, and 16 would have been obvious over the combination of Thalmann and Williams.

**UBISOFT ENTERTAINMENT SA v. PRINCETON DIGITAL IMAGE CORPORATION,
IPR2014-00635**

Paper 24: Final Written Decision

Dated: October 16, 2015

Patent 5,513,129

Before: Benjamin D. M. Wood, Trenton A. Ward, and Beth Z. Shaw

Written by: Wood

Related Proceedings: *Princeton Digital Image Corp. v. Ubisoft Entertainment SA*, Case No. 1:13-cv-00335-LPS-CJB (D. Del.); *Princeton Digital Image Corp. v. Harmonix Music Systems, Inc.*, Case No. 1:12-cv-01461 (D. Del); *Princeton Digital Image Corp. v. Activision Publishing, Inc.*, Case No. 2:12-cv-01134 (C.D. Cal.) (dismissed); and *Harmonix Music Sys., Inc. v. Princeton Digital Image Corp.*, Case IPR2014-00155

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