

## Fed. Circ. Urged To Revive Billionaire's Call Routing Patent

By **Michael Macagnone**

*Law360, Washington (September 10, 2015, 9:03 PM EDT)* -- Billionaire investor Ronald A. Katz told the Federal Circuit on Thursday that the Patent Trial and Appeal Board used an incorrect claim construction to nix as obvious a patent on an automated phone call routing system he asserted in a series of infringement suits.

Katz's attorney Lowell D. Mead of Cooley LLP said the board incorrectly construed the meaning of a claim in the at-issue patent, which has been asserted in a swath of federal infringement suits, when comparing it to prior art. Mead said the structure referred to in the key claim included both a call data analyzer and a separate programmed structure that routed calls to the proper destination.

When doing its analysis, the PTAB was incorrect to refer only to the call data analyzer, rather than the combination of the analyzer and another structure that actually performed the routing, according to Mead.

"It is certainly part of the structure that is claimed," Mead said.

Mead said the board went beyond the examiners in the patent prosecution to deliver the obviousness finding, and he urged the panel to revive the patent's claims. Although the patent has since expired in the long-running case, Mead said the intellectual property can still be asserted in a case in Tennessee against FedEx Corp. if the panel overturns the PTAB decision.

However, U.S. Patent and Trademark in-house counsel Robert McBride said the fact that the specification required a connection between the call data analyzer and the rest of the system does not automatically include it in a means plus function test.

"Just because a connection is required for a corresponding structure to help perform a claimed function does not make the connection part of the structure," McBride said.

He said Katz erred by relying on the specification's description of the route a call takes through the system, which does not give sufficient grounds to overturn the board's decision.

"It just describes how the call is routed. It is not describing the corresponding structure for the means plus function test," McBride said.

U.S. Circuit Judge Raymond C. Clevenger repeatedly questioned the USPTO on the narrow grounds to decide obviousness.

“The problem here is the board did not give you an alternate ground for obviousness,” Judge Clevenger said. “I would feel obligated to send it back if we agree with Katz on the merits.”

The patent-in-suit is U.S. Patent Number 5,815,551.

U.S. Circuit Judges Sharon Prost, Raymond C. Clevenger and Todd M. Hughes sat on the panel for the Federal Circuit.

Katz is represented by Frank V. Pietrantonio, Lori R. Mason and Lowell D. Mead of Cooley LLP.

The USPTO is represented in-house by Nathan K. Kelley, Thomas W. Krause, Stacy B. Margolies and Robert K. McBride.

The instant case is In re: Ronald A. Katz Technology, case number 15-1170, in the U.S. Court of Appeals for the Federal Circuit.

The Tennessee case is Ronald A. Katz Technology Licensing LP v. FedEx Corp., case number 2:15-cv-02329, in the U.S. District Court for the Western District of Tennessee.

--Editing by Edrienne Su.