

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC, GOOGLE INC. AND APPLE INC.

Petitioners

v.

ARENDI S.A.R.L.

Patent Owner

Case IPR2014-00203

Patent 8,306,993 B2

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(c)

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CERTIFICATE OF SERVICE i

Petitioners respectfully request rehearing of the "Decision Denying Institution of Inter Partes Review", issued June 5, 2014 ("June 5 Decision"). Petitioners focus on Grounds 1 and 2 to limit the length of the request.

I. SUMMARY

Petitioners respectfully ask the panel to consider: **(A)** whether the panel appreciated the nature of the Petitioners' arguments under 35 U.S.C. § 103 with respect to Grounds 1 and 2 (based on the combination of Bonura and Magnanelli); **(B)** whether the panel adopted the broadest reasonable construction consistent with the specification for the "allowing the user..." claim limitation.

II. ARGUMENT

A. Grounds 1 and 2 (Bonura in view of Magnanelli) meet the claim construction proposed by the Patent Owner.

The June 5 Decision declined to adopt Grounds 1 and 2 based on the limitation:

"allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database".

This limitation will be referred to in this request as "the allowing limitation".

The June 5 Decision adopted the Patent Owner's construction of the "allowing limitation", finding that it meant "*presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.*"

(June 5 Decision, p. 11).

The June 5 Decision then found that (1) neither Bonura nor Magnanelli disclosed the allowing limitation in full, and (2) that the Petitioners had not:

"provided a reason why a person of ordinary skill in the art would modify the combination to arrive at the claimed invention and, in particular, the single step of making a single decision whether to store contact information as a new contact or, alternatively, to update an existing contact." (June 5 Decision, p. 16).

The quoted holding is, respectfully, clearly erroneous. The Petition provided extensive motivation to reach *even the Patent Owner's strict construction*.

1. Overview of the argument for Grounds 1 and 2 in the Petition.

The Petition's argument under Grounds 1 and 2 will be presented in detail below, but can be summarized as follows: Bonura is the base system. The Bonura base system scans documents (in a manner that meets the other elements of the claims) for information of a specific types. When these specific types of information are found, Bonura presents the user with a pop-up menu of options to choose from. The user chooses between the options in the pop-up menu—and thus the options are "competing alternatives". The Petition further demonstrated that when the information is *contact information*, there was motivation to present *both* "storing" and "updating" options to the user. The storing option was motivated by Bonura itself, while the "updating" option was motivated by Magnanelli. (Petition, pp. 12-21). Thus, while neither Bonura nor Magnanelli, standing alone, taught the

"allowing" limitation as construed in the June 5 Decision, the Petition presented strong motivation to combine Bonura and Magnanelli in a way that meets the "allowing" limitation. The full reasoning and its support in the Petition will be presented in detail in the next section.

It is noted that the panel may not have focused on the argument described above. The June 5 Decision only makes reference to the Petition's element-by-element analysis (*i.e.* its claim chart). (June 5 Decision, p. 15)("The Petition, in its element-by-element mapping, asserts this limitation is taught or suggested by..."). The most relevant discussion in the Petition, however, was found in the section of Ground 1 *before* the claim chart. Petition, pp. 12-21. The June 5 Decision did not address the reasoning presented on pages 12-21 of the Petition. Petitioners respectfully remind the panel that Petitioners were not allowed to put motivation to combine arguments in the claim charts (even though the arguments were double-spaced). *See* Notice of Filing Date Accorded, Dec. 12, 2013, p. 2.

2. Detailed discussion—express motivation to combine.

The Petition presented a detailed motivation to reach even the Patent Owner's strict construction of the allowing limitation. The Petition first put forward Bonura as a base system. (Petition, pp. 12, 17). As stated in the Petition, the base system of Bonura recognizes text within a document according to the other elements of the claims, and provides the user with a number of choices that are appropriate for the

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