UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.
Petitioner

v.

TLI Communications, LLC
Patent Owner

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Case IPR2014-00566
U.S. Patent No. 6,038,295

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PETITIONER REQUEST FOR RECONSIDERATION
UNDER 37 C.F.R. § 42.71(c)

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I.   INTRODUCTION

On April 1, 2014, Facebook, Inc. ("the Petitioner") filed a petition requesting *inter partes* review ("IPR") of U.S. Patent No. 6,038,295. (Paper No. 1 ("Petition").) On September 15, 2014, the Board issued a decision declining to institute IPR.   (Paper No. 14 ("Decision").)[1] The Petitioner respectfully seeks reconsideration of that decision only as to claims 17 and 21-24. As explained in detail below, the Board's decision not to institute IPR on the grounds presented was based on a misapprehension of the Petition's mapping for the claimed

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[1] The '295 patent has been asserted in a related Multidistrict Litigation (MDL) in the Eastern District of Virginia against 30 defendants. *In re TLI Comms. LLC Patent Litig.*, No. 1:14-md-02534-TSE-JFA (E.D. Va. 2014). The case had been stayed pending the outcome of the Petitioner's IPR request. The district court lifted the stay following the Board's decision and put a schedule in place. The '295 patent was also recently sold to another patent licensing entity, Marathon Patent Group, who issued a press release discussing the Board's September 15, 2014 decision. *See* http://ir.marathonpg.com/company-news/detail/704/correction---marathon-patent-group-acquires-tli-communications-llc.

"server," possibly because of misrepresentations made by the patent owner in its Preliminary Response regarding the Petition. Accordingly, the Petitioner respectfully requests that the Board find that the Petition established a reasonable likelihood that the Petitioner will prevail in showing that (1) claims 17, 21 and 24 are unpatentable over Hassan in view of Witek, (2) claim 22 is unpatentable over Hassan in view of Witek and Quinn, and (3) claim 23 is unpatentable over Hassan in view of Witek, Burgess and RFC 937.

This request is authorized under 37 C.F.R. § 42.71(c), and prior authorization of the Board is not required for filing of such a request. 37 C.F.R. § 42.71(d). This request is timely because it was filed within 30 days of the Board's September 15, 2014 decision. 37 C.F.R. § 42.71(d)(2).

II.   LEGAL STANDARD

"When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. §42.71(c). An abuse of discretion "occurs when a court misunderstands or misapplies the relevant law or makes clearly erroneous findings of fact." *Renda Marine, Inc. v. U.S.*, 509 F.3d 1372, 1379 (Fed. Cir. 2007) (quoting *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1572 (Fed. Cir. 1988). "A finding is clearly erroneous when, despite some supporting

evidence, 'the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.'" *Forest Labs., Inc. v. Abbott Labs.*, 339 F. 3d 1324, 1328 (Fed. Cir. 2003) (quoting *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948)).

III.   ARGUMENT

A.   The Petition Established a Reasonable Likelihood of Showing that Claim 17 Is Obvious Over Hassan in View of Witek

The sole basis for the Board's decision not to institute IPR as to claim 17 was its conclusion that Witek did not teach the claimed step of "storing the digital images in the server, <u>said step of storing taking into consideration the classification information</u>." (Decision at 16 (underlining added); *see also generally id.* at 16-17.) The Petitioner respectfully submits that the mapping set forth in the Petition demonstrated that Witek discloses this limitation.

The Board correctly noted that the optical character recognition software (**16**) in Witek processes the stored PICT fax file (**15**), among other reasons, "to route the fax transmission to the proper destination." (Decision at 15 (citing Witek, 2:55-57, 2:65-3:2).) As explained in the Petition:

> Once the computer (**12**) receives a fax transmission from a sending device, it stores it in a "pict fax file" (**15**) in memory (**13**). (Witek, 2:17-23, 6:42-46.) The computer then performs optical character

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