

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC., FACEBOOK, INC., and WHATSAPP, INC.,  
Petitioner

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,  
Patent Owner

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Case IPR2017-00222<sup>1</sup>  
Patent 8,243,723

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**PETITIONER APPLE INC.'S REQUEST FOR  
REHEARING OF FINAL WRITTEN DECISION**

***Mail Stop "Patent Board"***

Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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<sup>1</sup> Facebook, Inc. and WhatsApp, Inc., who filed a petition in IPR2017-01635, have been joined as petitioners in this proceeding.

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## I. Summary of Issues for Rehearing

In its Final Written Decision (Paper 29) (hereinafter “FWD”), the Board overlooked or misapprehended two primary matters.

First, the Board asserts that claim 3 recites (a) determining connectivity status and then (b) controlling generating of an instant voice message based on the determined connectivity status. But then the Board misapprehends the Petition’s discussion of Vuori<sup>2</sup>-Malik<sup>3</sup>. In contrast to the Board’s statements on Malik not teaching using connectivity status to control generating of an instant voice message, the Petition shows how Figure 4 of Malik shows that it (a) determines connectivity status at step 425 and then (b) controls generating of an instant voice message based on that determined connectivity status at steps 460 and 470.

Second, the Board’s additional reasoning that Malik does not teach claim 3 “because [an instant voice message] is always generated in the same manner [in Malik]—recording mode” misapprehended claim 3. Claim 3 does not recite “two manners” of storing and then transmitting instant messages after they have been generated, which the Board appears to imply are recording or intercom modes. Rather, the Board’s two “manners” of storing and then transmitting instant

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<sup>2</sup> U.S. Patent Appl. Pub. No. 2002/0146097 A1.

<sup>3</sup> U.S. Patent Appl. Pub. No. 2003/0219104 A1.

messages after they have been generated appear to be recited in claim 4, not claim 3.

## II. Standard of Review

“A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board.” 37 C.F.R. § 42.71(d). The “burden of showing a decision should be modified lies with the party challenging the decision,” and the request “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

## III. Argument and Relief Requested

Petitioner respectfully requests that the Board reconsider its determination that claims 3-7 of the '723 Patent have not been shown to be unpatentable over Vuori-Malik for at least two reasons: *first*, the Board misapprehended the Petition's discussion of Malik since Malik determines connectivity status before controlling generating of an instant voice message, and *second*, the Board misapprehended the scope of claim 3.

### **1. The Board misapprehended the Petition and Malik's teachings for controlling a method for generating the instant voice message based upon the connectivity status of said one or more recipient.**

In its FWD, the Board alleged that “[a]ll the passages Petitioner relies on describe Malik's *sending* of the voice instant message or the Jabber messages, not

the *generating* of the voice instant message.” FWD, 40. Petitioner disagrees. The Petition explains, and Malik expressly teaches, that a recipient’s availability (i.e., connectivity status) is considered before the message is generated:

The VIM client 320 of the second user, however, *detects that the first user is not present and/or available* and, therefore, does not initiate the sending of the instant message, *as shown in block 425*. Accordingly, in blocks 430-435, the VIM client 320 of the second user checks to see if the computing device of the VIM client 320 is capable of *generating a voice recording*. Malik, [0032].

Petition, 24 (citing Malik, Ex. 1019, [0032]), emphasis added.

The Petition is best understood by looking at Malik’s Figure 4 and elements 425, 460, and 470. For example, the Petition demonstrates, and Malik’s Figure 4 shows, that VIM client 320 detects whether the first user (i.e., recipient) is not present and available in block 425 (i.e., connectivity status), which occurs several steps before the voice recording (i.e., instant voice message) is generated (at steps 460/470). *See* Petition, 18-21, 23-25 (citing, *inter alia*, Ex.1019, [0032]-[0034]).

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