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Paper 33
Entered: September 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., FACEBOOK, INC., and WHATSAPP, INC.,[1]
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-00222
Patent 8,243,723 B2

Before, JENNIFER S. BISK, MIRIAM L. QUINN, and CHARLES J. BOUDREAU, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
ON PATENT OWNER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

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[1] Facebook, Inc. and WhatsApp, Inc. filed a petition and motion for joinder in IPR2017-01635, which we granted, and, thus, these entities are joined, as Petitioner, to this proceeding. Paper 12.

I. INTRODUCTION

On May 23, 2018, the Board issued the Final Written Decision in this proceeding. Paper 29 ("Final Dec."). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1 and 2 of the patent-at-issue are unpatentable over Vuori and Malik.[2] On June 22, 2018, Patent Owner filed a Request for Rehearing. Paper 31 (Req. Reh'g.). Patent Owner argues deprivation of due process because it was not given an opportunity to address our determination that the claims do not exclude transmitting the recited "list" one value at a time. Req. Reh'g. 3–4. Patent Owner also argues that in reaching our determination regarding Vuori's teaching of the recited "list," the Board acted *sua sponte* by not relying on Petitioner's argument or evidence.

According to 37 C.F.R. § 42.71(d), "[t]he 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." The burden here, therefore, lies with Patent Owner to show we misapprehended or overlooked the matters it requests that we review.

II. ANALYSIS

Patent Owner faults us for deciding an issue of claim construction it allegedly had no opportunity to brief. However, Patent Owner was given notice in our Decision on Institution that its arguments concerning the recited "list" were arguments concerning claim scope and that Patent Owner

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[2] Vuori: U.S. Patent Appl. Pub. No. US 2002/0146097 A1 (Ex. 1005); Malik: U.S. Patent Appl. Pub. No. US 2003/0219104 A1 (Ex. 1019).

had provided no factual support at that time sufficient to overcome a reasonable likelihood threshold. Paper 7, 17–18; *see also* Paper 25, 74:13–78:24 (presenting claim construction position for the claim term "list" in response to the Board's Decision on Institution). During trial, Patent Owner again raised claim scope arguments, which we noted in our Final Written Decision in our claim construction analysis of the term "list." Final Dec. 16–17. We noted that Patent Owner's argument seemed to depend on both how the values in a list are transmitted and the quantity of those values. *Id.* But we found no disclosure in the Specification supporting a contention that the claims require any particular manner of transmitting. *Id.* Patent Owner in the Request for Rehearing does not argue that we misapprehended the Specification or the claim language in our determination. Therefore, we see no reason to disturb our Final Written Decision. In other words, Patent Owner's request for rehearing does not raise an issue for which additional briefing is warranted as Patent Owner has not shown how we misapprehended the evidence, the claim language, the Specification or any point of law that shows reconsideration of the claim construction of "list" is appropriate.

Regarding Patent Owner's second argument, we do not agree that we have not followed the holding in *In re Magnum Oil Tools Int'l*, 829 F.3d 1364 (Fed. Cir. 2016). Req. Reh'g. 3–4. With regard to claim construction, it was Patent Owner, not Petitioner, who attempted to paint Vuori as teaching transmission of "one value at a time." Final Dec. 31 ("Patent Owner urges that we focus on Vuori's explanation of distributing presence information . . . 'one value at a time'."). We analyzed Figure 8 of Vuori because Patent Owner relied on that figure as support for its contention that

Vuori did not teach transmitting a "list." Final. Dec. 32 (noting that Patent Owner relies on language in the Specification describing Figure 8); Prelim. Resp. 13–14. Then, we made two factual determinations based on the evidence of record, in light of Figure 8, which Patent Owner raised, and in light of the description of Figure 10, which Petitioner relied on as disclosing the "list." *See, e.g.*, Final Dec. 31 (noting arguments by Petitioner regarding Figure 10 and paragraph 47 of Vuori). Thus, we supported our determination based on evidence of record provided by Patent Owner and Petitioner. We discussed the testimony of Mr. Easttom and ultimately did not credit it in its entirety. *Id.* at 33 (explaining that Mr. Easttom's testimony of "one value at a time" "at best, appears to focus only on the SVM fetcher, which requests the 'current' value of some SVM presentity's information," and finding that Vuori does not support the testimony or Patent Owner's narrow view of Vuori in this regard).

In sum, we do not agree with Patent Owner's contention that our determination concerning whether Vuori transmits a "list" relies on improper argument or evidence. As stated above, our reasoning discusses the evidence and arguments Petitioner and Patent Owner, itself, provided, in the record, in support of each party's contentions concerning the term "list." Finally, Patent Owner's request for rehearing fails to show that we misapprehended or overlooked any of Patent Owner's evidence or arguments.

III. ORDER

Patent Owner's Request for Rehearing is *denied*.

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