UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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Case IPR2017-00225[1]
Patent 8,995,433

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

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
O. Box 1450
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[1] Snap Inc., which filed a petition in IPR2017-01611, as well as Facebook, Inc. and WhatsApp, Inc., which filed a petition in IPR2017-01634, 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), the Board overlooked or misapprehended two primary matters: (1) the Petition showed Abburi[2] explicitly expresses a desire to store audio messages on its client devices in addition to its server-based audio message store, and (2) the Petition's proposed combination does not allege bodily incorporation of Holtzberg's[3] database into the system of Abburi.

First, the Board focused on Abburi's centralized audio message store, determining that even though Abburi discloses recording an audio file on its client device prior to sending, "we are not persuaded that the existence of a memory for recording an audio file suggests either de-centralizing the audio message store or that the audio file would be stored in a database." (FWD, pp. 35-36.) Here, the Board overlooked the Petition's discussion of Abburi's express desire to locally store received audio messages, in addition to Abburi's centralized storage.

Second, the Board determined that the evidence provided by Patent Owner shows "that Abburi would have to be redesigned to account for additional functionality at the user device, where the trade-offs are the complexity of replication of data across the entire system." (FWD, p. 40.) But the Board

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[2] U.S. Patent Publication No. 2003/0147512 A1.

[3] U.S. Patent No. 6,625,261 B2.

overlooked or misapprehended the combination proffered in the Petition, which only proposes to incorporate Holtzberg's database *structure* into a database at Abburi's client device, avoiding the need for any redesign or additional functionality besides that associated with implementing a generic database. Thus, the purported disadvantages cited by the Board do not apply to the combination presented in the Petition.

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

For the reasons below, Petitioner respectfully requests that the Board reconsider its determination that claims 1-6 and 8 of the '433 patent have not been shown to be unpatentable over the combination of Abburi and Holtzberg.

A.   The Board overlooked the Petition's discussion of Abburi's express desire to store audio messages on its client devices

In its Decision, the Board alleged that Patent Owner "correctly points out that Abburi expressly relies on the server-side audio message store, with no

indication that a local audio message store is either warranted or desirable." (FWD, p. 35.) But the Board overlooked the Petitioner's discussion of Abburi's explicit disclosure expressing a desire to store received audio messages:

> Audio messages are delivered to intended recipients in one embodiment via audio streaming through the computer network **210** or the telecommunications network **212**. **Alternatively, system 200 delivers an audio message to its intended recipient as, e.g., an electronic audio file which the recipient can store and subsequently playback at his or her option**.

(Abburi, ¶ 32, emphasis added.)

The Petition explicitly relies on this disclosure in its rationale to combine Abburi and Holtzberg: "When an audio file is delivered to its intended recipient, 'the recipient can store and subsequently playback at his or her option.'" (Petition, p. 17 (citing Abburi, ¶ 32).) The Petition (pp. 26, 29) also discusses Dr. Forys's reliance on this storage at the recipient's user device to support his rationale to combine Abburi and Holtzberg, where Dr. Forys states:

> When an audio file is delivered to its intended recipient, "the recipient can **store** and **subsequently playback** at his or her option." (Abburi, [0032] (emphasis added).) Thus, Abburi teaches '*storing the instant voice message*' at the recipient's device.

(Forys Decl., ¶ 105 (emphasis in original).)

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