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Paper 31
Entered: September 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-00225
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge.*

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

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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.

I. INTRODUCTION

On May 23, 2018, the Board issued the Final Written Decision in this proceeding. Paper 29 ("Final Dec."). On June 22, 2018, Petitioner filed a Request for Rehearing. Paper 30 (Req. Reh'g.). Petitioner makes two arguments: (1) that the Board overlooked Abburi's teachings concerning storing at the recipient device; and (2) that the Board overlooked or misapprehended Petitioner's arguments for combining Abburi and Holtzberg. *Id.*

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 Petitioner to show we misapprehended or overlooked the matters it requests that we review.

II. ANALYSIS

As to the first argument, Petitioner points out the Petition's reliance on Abburi's disclosure of "an electronic audio file which the recipient can store and subsequently playback at his or her option." Req. Reh'g. 3 (quoting Ex. 1005 ¶ 32; citing Pet. 17). Petitioner also points out Dr. Forys's reliance on that disclosure and argues that the Petition presents the contention that Abburi "suggests at least storage of received audio messages in persistent memory, to allow a user to 'subsequently playback at his or her option.'" Req. Reh'g. 4 (citing Pet. 14; Ex. 1003 ¶¶ 105, 109, 66). According to Petitioner, the Board overlooked the disclosure of storage of received files, because it was given "no consideration in determining that it

would not have been obvious to store audio messages in a database at Abburi's client device." *Id.* at 5.

We do not agree with Petitioner's argument that we overlooked the Abburi disclosures pointed out in the Request for Rehearing. As stated in the Final Written Decision, Petitioner presented two alternatives concerning the "message database" limitation. Final Dec. 32–33. The first focused on Abburi, alone. *Id.* at 32. The Final Written Decision specifically notes Petitioner's arguments regarding Abburi's device "storing audio messages." Final Dec. 32 (noting, as one of the arguments, that Petitioner argues Abburi states that a recipient can store and subsequently play back at his or her option the audio file). We found, however, that neither of the cited disclosures of "storing" in Abburi teaches the recited "message database." *Id.* at 33 ("Therefore, we find that neither of Petitioner's two 'storing' examples in Abburi teaches the 'message limitation of claims 1 and 6."). Therefore, we did not overlook Abburi's disclosure of storing received files.

We analyzed the alternative argument based on Abburi in combination with Holtzberg's teaching of storing voice messages in a database. Final Dec. 33. In the course of our analysis of that alternative argument, we also found that the potential, generic benefit that would be provided by Abburi storing received messages in a local database would not outweigh the particular benefits of audio message storage in a centralized database already disclosed by Abburi and Holtzberg. Final Dec. 40 (citing PO Resp. 26; Ex. 2001 ¶ 54; Ex. 1005 ¶¶ 5–7).[2]

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[2] We also noted the weaknesses of Petitioner's obviousness contentions based on Abburi's recorded and sent messages. We found that, at best, sent

Accordingly, in the obviousness analysis, we weighed the Abburi disclosures that Petitioner provided, together with the testimony of Dr. Forys in support, to reach our finding that a person of ordinary skill in the art would not have been motivated to combine Abburi and Holtzberg as Petitioner alleged in the Petition. Thus, we are not persuaded that we overlooked the evidence that Petitioner raises in the Request for Rehearing.

We also are not persuaded, as to Petitioner's second argument, that we misapprehended or overlooked Petitioner's argument for a reason to combine. The Request for Rehearing provides two reasons. Req. Reh'g. 6. First, Petitioner argues that the Petition did not rely on incorporation of Holtzberg's database into Abburi's device. *Id.* We disagree. As we noted in the Final Written Decision, the Petition expressly relies on "incorporation." Final Dec. 33 (citing Pet. 29, which states that a "POSITA would have found it obvious to *incorporate* Holtzberg's database structure into Abburi because such *incorporation* . . . ."). Petitioner now attempts to cast the proffered rationale as focusing instead on "storage and organization techniques." *Id.* The argument is unpersuasive. The plain reading of the Petition is an express reliance of *incorporating* the *database structure* of Holtzberg into the Abburi device. Pet. 29.

With regard to the second reason, Petitioner argues that our analysis improperly weighs the evidence relevant to obviousness. Req. Reh'g. 8–14.

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messages are stored temporarily in local memory, until the message is delivered to the server for storage there, begging the question of why modify Abburi's centralized storage design to incorporate a *local* database for organizing and retrieving sent messages that are actually stored at the server. Pet. 35–37.

A request for rehearing is not an opportunity to boost the strength of Petitioner's evidence in light of Petitioner's disagreement with the analysis of that evidence. Petitioner argues that we misapprehended that the Petition did not require distribution of a centralized database and that Abburi teaches storing a received message at the device. *Id.* at 11–12. Even if we were to agree that Abburi's device may store a received audio message, that storage, alone, is not indicative of whether it would have been desirable to implement a "message database" in Abburi's device. We stated in the Final Written Decision that our analysis searches for a reason a person of ordinary skill in the art would de-centralize Abburi's storage of voice messages. *Id.* at 34. Our analysis viewed Abburi as centralizing message storage (message store 206), even if a recipient is given an option to store a received message locally. *Id.* at 24–26, 34. But the inquiry did not focus only on Abburi's disclosures of local storage versus centralized message storage. Our analysis also focused on Holtzberg's incorporation arguments presented in the Petition and the arguments and evidence provided by Patent Owner in opposition. *Id.* at 37 (crediting Patent Owner's expert testimony regarding Holtzberg's database and noting the weaknesses in Petitioner's arguments with regard to Holtzberg).

In the end, we were persuaded by Patent Owner's argument and evidence that a person of ordinary skill in the art would not have combined Abburi and Holtzberg's teachings because the benefit of local storage did not outweigh the loss of other functionality and design, among other reasons. Final Dec. 40. We credited that evidence. *Id.* (relying expressly on Ex. 2001 ¶ 54). We also were persuaded that Petitioner's rationale regarding the Holtzberg centralized voicemail database was deficient for failure to explain

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