

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC. and SQUARE ENIX, INC.,
Petitioner,

v.

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

Case IPR2017-01290
Patent 6,510,466 B1

Before MIRIAM L. QUINN, ROBERT J. WEINSCHENK, and
JESSICA C. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Ubisoft, Inc. and Square Enix, Inc. (collectively, “Petitioner”) seeks rehearing (Paper 13, “Request” or “Req. Reh’g”) of our determination in the Decision on Institution (Paper 12, “Decision” or “Dec.”) not to institute an *inter partes* review of claims 1, 2, 7, 8, 15–17, 22, 23, 30, 35, and 36 (all challenged claims) of U.S. Patent No. 6,510,466 B1 (Ex. 1001, the “’466 patent”). We have considered Petitioner’s Request, but for reasons that follow, we decline to modify our Decision.

II. LEGAL STANDARD

37 C.F.R. § 42.71(d) provides: “The burden of showing a decision should be modified lies with the party challenging the decision. 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.” In addition, “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

III. DISCUSSION

Petitioner contends our Decision misapprehended and/or overlooked:

1) the ‘466 patent’s disclosure of “installing” does not exclude “configuring”; 2) Petitioner’s proposed structure – the configuration operations of Figure 5 – is “clearly linked” to the claimed function of “installing a plurality of application programs on a server”; 3) the corresponding structure adopted by the Board – steps 112-116 of Figure 8 – does not relate to “installing” at all, and is not “clearly linked” to the claimed function; and 4) Sonderegger in view of Hughes discloses both the function (and method) of “installing application programs”

as well as the appropriate corresponding structure from Figure 5 as described in the '466 patent.

Req. Reh'g 3–4.

We are not persuaded that we misapprehended or overlooked any matter that was previously presented to us. In the Petition, Petitioner did not propose a specific construction for “installing” or “application program” but contended it “includes, for example, ‘setting up the users and software to be managed,’ to make the application program ‘recognized and available to users at clients served by the server.’” Pet. 19. Petitioner also identified proposed corresponding structure for the “means for installing” limitations in claims 15 and 16, but did not explain why such structure is clearly linked to the claimed function. Pet. 3, 19. We fully considered this proposed corresponding structure in our Decision and determined that Petitioner had not adequately shown it was clearly linked to the claimed function. *See* Dec. 7–12.

We are not persuaded that we abused our discretion in making this determination. For example, Petitioner now argues that “installing” does not exclude “configuring.” Req. Reh'g 4–6. Petitioner, however, did not address this issue in its Petition, as Patent Owner pointed out (Prelim. Resp. 12). And as Petitioner acknowledges, it could have anticipated this issue because the Board previously found a related patent distinguished between installation and registration. Req. Reh'g 6 n.1 (citing *Unified Patents Inc. v. Uniloc USA Inc.*, IPR2017-00184, Paper 9 at 13 (Apr. 18, 2017)). Instead, Petitioner identified corresponding structure that assumed the installing function was coextensive with configuration without explanation. Pet. 3 (stating that block 232 of Figure 4 describes “the installation/configuration process” and that “the configuration/installation step at block 232 is further

detailed in” Figure 5 without elaboration); *see also id.* at 19 (stating that “installing” includes “‘setting up the users and software to be managed’ to make the application program ‘recognized and available to users at clients served by the server’” without elaboration). We could not have misapprehended or overlooked arguments that were not presented to us.

Petitioner further contends we misapprehended or overlooked that its proposed corresponding structure for the “means for installing” limitations is clearly linked to the claimed function. Req. Reh’g 6–10. Petitioner’s arguments in this regard are premised on its argument that configuration operations are the same as “installing.” *Id.* at 7–8. Petitioner also contends that the ’466 patent “specifically states that installing software (i.e., application programs) on a server is accomplished *by defining the software to the database* on the server.” *Id.* at 8 (citing Ex. 1001, 8:60–64). Again, these are arguments that were not made in the Petition, and therefore, we could not have misapprehended or overlooked them. *See* Pet. 3 (referring only to “configuration/installation” without elaboration); *id.* at 19 (stating that “installing” includes “‘setting up the users and software to be managed’ to make the application program ‘recognized and available to users at clients served by the server’” without elaboration).

Petitioner also contends that the structure identified in our Decision is not clearly linked to the recited installing function. Req. Reh’g 10–11. We need not address these arguments because even if correct, they would not change the outcome of our Decision as to claims 15–17, 22, 23, 30, 35, and 36. In particular, if none of Patent Owner’s proposed corresponding structure is clearly linked to the claimed function, then we would be left with no corresponding structure identified by either party. In the absence of

corresponding structure, we are not free to treat the “means for installing” limitations as if they were purely functional limitations. *See IPCom GmbH & Co. v. HTC Corp.*, 861 F.3d 1362, 1371 (Fed. Cir. 2017), as corrected (Aug. 21, 2017). Thus, even if neither party identified proper corresponding structure, we would still deny institution of claims 15–17, 22, 23, 30, 35, and 36.

Finally, Petitioner contends that we misapprehended or overlooked that “Sonderegger in view of Hughes discloses ‘installing’ as described in the ‘466 patent.” Req. Reh’g 12. Specifically, Petitioner relies on its arguments discussed above (*id.* at 12–13), which we have found are not properly made on rehearing. Petitioner further argues that Sonderegger “expressly discloses that the application programs themselves (i.e., the code associated with underlying application program functions) are stored on a network drive accessible to the database server on which the application objects are stored.” *Id.* at 13–14. While Petitioner points to portions of Sonderegger it cited in the Petition (*id.* at 13–15), it does not show that it ever made such a contention in the Petition.

As we noted in our Decision, claim 1 is a method claim and so is not limited to the corresponding structure required for claims 15 and 16. Dec. 15. Petitioner’s analysis of the “installing” limitation of claim 1 in the Petition referred only to its analysis of the means-plus-function limitation of claim 15. Pet. 15. For that limitation, Petitioner stated that Sonderegger performed the “installing” function “by configuring the users and application programs to be managed by a server 14 through a set of application management routines 48, thereby making application programs available to appropriate users or groups.” *Id.* at 19 (citing Ex. 1002, 4:66–5:6, 7:11–20,

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