

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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Case IPR2017-01291  
Patent 6,728,766 B2

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Before SALLY C. MEDLEY, MIRIAM L. QUINN, and  
JESSICA C. KAISER, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION  
Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

Ubisoft, Inc. and Square Enix, Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1, 3, 7, 9, 13, and 15 of U.S. Patent No. 6,728,766 B2 (“the ’766 patent”) pursuant to 35 U.S.C. § 311–319. Paper 1 (“Pet.”). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner” or “Uniloc”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On November 1, 2017, we issued a Decision on Institution in which we instituted *inter partes* review for claims 1 and 3, but denied institution as to claims 7, 9, 13, and 15. Paper 9 (“Decision” or “Dec.”).

Petitioner filed a Request for Rehearing on November 15, 2017, urging that the panel reconsider our Decision and institute *inter partes* review of the denied claims. Paper 11 (“Request” or “Req. Reh’g”). For the reasons that follow Petitioner’s Request for Rehearing is *denied*.

The party requesting rehearing has the burden of showing that the decision should be modified, and “[t]he 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.” 37 C.F.R. § 42.71(d). In our Decision, we disagreed with Petitioner’s proposed construction of “means for maintaining” as encompassing the structure of “a database and equivalents thereof.” Dec. 6. We determined that Petitioner’s argument and evidence did not show that the database was clearly linked to the recited function. *Id.* Instead, we were persuaded by Patent Owner’s showing that the Specification of the ’433 patent linked the function of “maintaining license management policy information for a plurality of application programs at a license management server” to algorithms for maintaining license management policy information. *Id.* at 7–8.

Petitioner’s Request does not show a matter that we misapprehended or overlooked. For instance, Petitioner argues that “the Board’s construction appears to have overlooked or misapprehended the disclosure of the ’766 patent, as the specification does not disclose—and the Board’s construction does not identify—any algorithmic structure.” Req. Reh’g 3. Further, Petitioner argues that the “database and equivalents thereof” is the only structure that is clearly linked to the function and that does not render the claims indefinite. Req. Reh’g. 4. These arguments amount to expressing mere dissatisfaction with the Board’s decision, not identifying a matter that we overlooked or misapprehended. As we noted in the Decision, Petitioner did not proffer any argument as to how “a database and equivalents thereof” is linked to the function of “maintaining” the license management policy at the server. Dec. 6. The argument presented in Rehearing does not point out any argument or evidence included in the Petition that we did not consider or that we misapprehended. The Rehearing merely restates what we already found lacking: that the “database” is the linked structure.

We are also not persuaded by Petitioner’s contention that the “database” is the *only* structure that is clearly linked such that the claims are not indefinite. Req. Reh’g 12. Our reviewing court has made clear that we are not permitted to adopt an insufficient corresponding structure. *See IPCom GmbH & Co. v. HTC Corp.*, 861 F.3d 1362, 1371 (Fed. Cir. 2017), as corrected (Aug. 21, 2017). It stands to reason, therefore, that if the “database” has not been shown to be sufficient structure, we are not permitted to adopt that structure merely because to not do so would render the claims indefinite.

Now we turn to Petitioner’s argument against our construction of the term “means for maintaining.” This argument centers on the contention that the Specification of the ’766 patent does not disclose an “algorithm.” Req. Reh’g 3–11. This argument is not persuasive for two reasons. First, the Petition did not proffer any contentions, argument, or evidence regarding whether the ’766 patent disclosed a sufficient (or any) algorithm, and, therefore, we could not have misapprehended or overlooked the matter. It is Petitioner’s burden to show that the matter was presented previously, and that we overlooked or misapprehended the matter. Absent such a showing, the Rehearing Request presents new arguments akin to an unauthorized reply to the preliminary response, which is not the role of a Request for Rehearing under our rules.

Second, even if we were to agree with Petitioner’s Rehearing argument, the claim term “means for maintaining” allegedly would lack proper disclosure in the ’733 patent Specification, rendering us powerless to review the denied claims. Petitioner’s argument is that “the ’766 Patent provides no disclosure of an algorithm, instructions, or steps for setting license management policy information[,which] renders the Board’s construction of the ‘means for maintaining’ limitation indefinite.” Req. Reh’g 9–10. In the end, given that we have not been persuaded by Petitioner’s showing that the “database” is the linked structure, a finding of no “algorithm” would result in denial of *inter partes* review of claim 7, 9, 13, and 15 based on our inability to construe the claim.

In summary, Petitioner has not persuaded us that we misapprehended or overlooked arguments or evidence that a “database and equivalents thereof” is clearly linked to the function recited in the “means for

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maintaining” limitation. Further, Petitioner has not persuaded us that we misapprehended or overlooked any contention that the ’766 patent does not disclose an “algorithm” for the “means for maintaining,” as such contention was not presented. Consequently, Petitioner’s Request for Rehearing is *denied*.

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