

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC., WHATSAPP INC., LG ELECTRONICS, INC., and  
HUAWEI DEVICE (SHENZHEN) CO. LTD. D/B/A HUAWEI DEVICE,  
Petitioners

v.

UNILOC 2017 LLC,  
Patent Owner

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Case IPR2017-01428  
Patent 8,995,433

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**PATENT OWNER'S REQUEST FOR  
REHEARING UNDER 37 C.F.R. § 42.71(D)**

In response to the Final Written Decision entered November 30, 2018, (Paper 40, hereinafter “Decision”) and pursuant to 37 CFR § 42.71(d), Uniloc 2017 LLC (“Patent Owner”) hereby respectfully requests a rehearing and reconsideration by the Patent Trial and Appeal Board (“Board”) of its Final Decision finding unpatentable Claims 9–12, 14–17, 25, and 26 of the ’433 patent. Patent Owner’s request for rehearing is based upon the following considerations.

## **I. APPLICABLE STANDARDS**

“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 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.* The Board reviews a decision for an abuse of discretion. 37 C.F.R. §42.71(c).

Claim construction is a question of law. *Markman v. Westview Instruments*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996). In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2142 -46 (2016).

## II. ARGUMENT

The Board *sua sponte* provided a definition of the term “attaches” that was not advanced by Petitioner or supported by any evidence of record. Such an approach denies Patent Owner due process and is also contrary to the Federal Circuit’s decision in *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016).

The term “attaches” appears in Independent Claim 9 as follows:

9. A system comprising:
  - an instant voice messaging application comprising:
    - a client platform system for generating an instant voice message;
    - a messaging system for transmitting the instant voice message over a packet-switched network; and
    - wherein the instant voice messaging application *attaches* one or more files to the instant voice message.

In multiple related proceedings (and this proceeding as well), Patent Owner argued that “attaches” means what it says – the one or more files must be attached to the audio file (i.e., the instant voice message). The Board previously agreed with this interpretation of attaching.

In particular, in a first decision denying institution of a petition advanced by some of the same Petitioners as here, the Board concluded the applied Zydney reference failed to disclose the claimed attaching because Zydney discloses “attaching additional files (e.g., a multimedia file) to a voice

container, **rather than to an audio file.**” *Facebook et al. v. Uniloc Luxemburg S.A.*, IPR2017-01257 (Paper 8) at 18 (PTAB Dec. 4, 2017) (emphasis added).

Similarly, in a second decision the Board reached the same interpretation of “attaches”:

We agree with Patent Owner that our reasoning in denying the petition in IPR2017-01257, wherein claim 1 was asserted to have been obvious over Zydney, is applicable here as well. In that case, we were not persuaded that the petitioner there had established sufficiently that Zydney teaches or suggests “attaching one or more files to the audio file,” as recited in claim 1, to demonstrate a reasonable likelihood of succeeding on the asserted ground. **We agreed with Patent Owner in that case that the portions of Zydney now relied upon by Petitioner as allegedly disclosing this limitation instead disclose attaching additional files (e.g., a multimedia file) to a voice container, rather than to an audio file as recited in claim 1.**

*Google LLC v. Uniloc Luxemburg S.A.*, IPR2017-02085 (Paper 11) at 19 (PTAB April 16, 2018) (emphasis added).

To emphasize the meaning of “attach,” the Board quoted itself in the ‘1257 Decision:

“[e]ven if we regard Zydney’s voice data as being an audio file, however, we are not persuaded that Zydney’s disclosure that another file may be attached to a voice container that contains such an audio file teaches or suggests attaching that other file to the audio file.”

*Id.* at quoting the ‘1257 Decision.

Now, in a contrary fashion, the Board *sua sponte* concluded that “attaches” does not require attaching; rather, the Board opined that things that are attached simply requires some degree of “association” between them.

More particularly, the Board determined that the Claim 9 no longer requires an attachment of the one or more files to the audio file (i.e., the instant voice message). Decision at 20-21. Rather, the Board opined that “as long as the client has sufficient information that the “instant voice message” has an attachment, the recited “attachment” is performed.” *Id.* at 21. In reaching this new interpretation, the Board points to no evidence of record or arguments advanced by Petitioner. Rather, the Board engaged in a new *sua sponte* analysis. This was improper. A Board must evaluate the Petition’s arguments ***as presented***. See *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016) (rejecting an argument that the Board properly “ma[de] an obviousness argument on behalf of [petitioner]” that “could have been included in a properly-drafted petition,” because “petitioner . . . bears the burden of proof” and, thus, the Board “must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond,” and is not “free to adopt arguments on behalf of petitioners” (citations omitted)).

Cognizant of due process consideration, the Board was concerned with an interpretation of “instant voice message” and invited post-hearing briefing on the issue; however, the Board did not invite any briefing on the meaning of “attaches.” Accordingly, the new *sua sponte* analysis of a separate term was surprising – especially given the Board’s contrary determinations of the same

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