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Paper 37
Entered: May 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC., HUAWEI DEVICE CO., LTD., LG ELECTRONICS, INC., and APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01667[1]
Patent 8,724,622 B2

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

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01668[2]
Patent 8,724,622 B2

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[1] Huawei Device Co., Ltd. and LG Electronics, Inc., which filed a petition in Case IPR2017-02090, and Apple Inc., which filed a petition in Case IPR2018-00579, have been joined as petitioners in IPR2017-01667.

[2] Apple Inc., which filed a petition in Case IPR2018-00580, has been joined as a petitioner in IPR2017-01668.

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

BOUDREAU, *Administrative Patent Judge.*

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

I. INTRODUCTION

On January 16, 2019, the Board issued a consolidated Final Written Decision in the above-captioned proceedings. Paper 37[3] ("Final Dec."). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 3, 6–8, 10–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (the '622 patent) are unpatentable. *Id.* at 112. On February 15, 2019, Patent Owner filed a Request for Rehearing. IPR2017- Paper 38 ("Req. Reh'g"). The Request for Rehearing contends the Board misapplied its construction of the claim term "instant voice message." *Id.* at 3–6.

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 Patent Owner to show we misapprehended or overlooked the matters it requests that we review. We are not persuaded that Patent Owner has shown that we misapprehended or overlooked the matters raised in the Request for Rehearing.

II. ANALYSIS

Claim 27 of the '622 patent recites that an "instant voice message application includes a document handler system for attaching one or more files to [an] instant voice message." Ex. 1001, 26:28–30. We determined in the Final Written Decision that the term "instant voice message" refers to a

[3] Unless otherwise noted, all Paper and Exhibit numbers cited herein refer to filings in IPR2017-01667.

"data content including a representation of an audio message." Final Dec. 15. Also, we construed the term "attach[ing] . . . to the instant voice message" to mean indicating that another file (or files) is associated with the "instant voice message." *Id.* at 22.

In its Request for Rehearing, Patent Owner contends the Board misapplied its construction of instant voice message by determining that that construction did not resolve all of the disputes surrounding that term. Req. Reh'g 4 (citing Final Dec. 19). More particularly, Patent Owner alleges that the Board erred in determining that "Patent Owner ha[d] not shown that the specification supports its narrow position that the recited attachment to an 'instant voice message' requires a direct attachment to only the data content." *Id.*; Final Dec. 22. In particular, according to Patent Owner, "[h]aving won on claim construction that instant voice message means 'data content,' it was not then Patent Owner's burden to defend that construction in application," but "[r]ather, it was Petitioner's burden to show 'attaching one or more files to [data content including a representation of an audio message]." Req. Reh'g 4. Patent Owner further contends that the Board applied the definition of "instant voice message" in a manner never urged by any party, and, according to Patent Owner, "advanced an argument for Petitioner *sua sponte*." *Id.* at 5–6. In particular, Patent Owner asserts, "[n]o party argued that 'associating' A to B is satisfied by associating A to C (a distinct and separately-generated container for B)," and "[i]t was Petitioner's burden, not Patent Owner's, to defend such a construction and to prove invalidity under such a construction." *Id.* at 5.

We have carefully considered Patent Owner's contentions but are not persuaded that we misapprehended or overlooked the issues Patent Owner

raises. In essence, Patent Owner acknowledges that it had an opportunity to brief claim construction but faults us for determining the scope of the phrase "document handler system for attaching one or more files to the instant voice message." The Decisions on Institution in the captioned proceedings noted that the construction of that term was raised in connection with Patent Owner's arguments in its Preliminary Responses and that the parties would have an opportunity during trial to fully brief claim construction." Paper 6, 23. Similarly, in our Final Written Decision we noted that simply construing "instant voice message," without more, does not resolve the dispute of the parties because Patent Owner raised arguments distinguishing the prior art on the basis of "attaching" a file to the data content itself. Final Dec. 19. The Board construes terms that resolve the dispute of the parties, and "attaching" was one of those terms. *Id.*; *see Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

Patent Owner, therefore, had notice of the issues needed to be resolved based on its own arguments distinguishing the prior art. More significantly, the Petition gave Patent Owner notice of Petitioner's reliance, in part, on Figure 6 of Zydney (referring to "associat[ing]" a multimedia file to a voice container), and Patent Owner included argument regarding "attachments" in its Supplemental Brief on claim construction, which we considered. *See* Final Dec. 19, 21–22 (citing Paper 33, 4–5); *see also, e.g.*, Paper 36 (arguing that files must be attached to the content that is transferred or to an audio file, but not to the data structure). Thus, Patent Owner had an

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