

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
Patent 8,724,622 B2

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

v.

UNILOC 2017 LLC,
Patent Owner

Case IPR2017-01668
Patent 8,724,622 B2

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

In response to the Final Written Decision entered January 16, 2019 (Paper 37) and pursuant to 37 CFR § 42.71(d), Patent Owner hereby respectfully request a rehearing and reconsideration by the Patent Trial and Appeal Board of its Final Decision.

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

A. The Board misapplied its construction of “instant voice message”.

Patent Owner respectfully submits that the Board misapprehended the proper application of its construction of “instant voice message”. In its decision, the Board accepted Patent Owner’s definition, properly construing “instant message” as “data content including a representation of an audio message.” Paper 37 at 15. The Board correctly recognized that the “content” of the message refers to “user’s speech . . . in some digitized form.” *Id.* at 16 (“These embodiments, thus, paint a picture of the ‘instant voice message’ as first and foremost being **the content of the message**, or the user’s speech, **in some digitized form.**”) (emphasis added); *id.* at 17 (“In all embodiments, the ‘instant voice message’ refers, at a minimum, **to the digitized speech**, regardless of whether it is contained in an audio file, successive portions stored in a buffer, or a block of data in an object field.”).

Claim 27 requires that the “instant voice message application includes a document handler system *for attaching one or more files to the instant voice message.*” See Paper 37 at 19. Substituting in the Board’s construction yields “instant voice message application includes a document handler system *for attaching one or more files to [data content including a representation of an audio message].*”

Rather than apply this construction, however, the Board held that its claim construction “does not resolve all the disputes surrounding the term because Patent Owner also argues that attaching files to an ‘instant voice message’ must be limited to attachments to the *data content itself*.” *Id.* The Board later stated “we determine that **Patent Owner has not shown** that the specification supports its narrow position that the recited attachment to an ‘instant voice message’ involves a direct attachment to only the data content.” *Id.* at 22 (emphasis added).

This was error. Having 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. Rather, it was Petitioner’s burden to show “*attaching one or more files to [data content including a representation of an audio message]*.” This Petitioner did not do. It could not do so because it is undisputed that Zydney does not disclose attaching one or more files to “data content,” which the Board characterized as “user’s speech . . . in some digitized form.”

B. The Board applied the definition of “instant voice message” in a manner never urged by any party.

The Board also erred in suggesting this deficiency is somehow cured by substituting the term “attaching” with, instead, the word “associating.”¹ Even if the

¹ Patent Owner does not hereby waive its objection to the improper construction of “attaching” to mean “associating”. Even accepting this erroneous construction of “attaching,” however, the Board’s correct construction of “instant voice message” – properly applied – should be dispositive in Patent Owner’s favor.

Petition had attempted to defend such a claim construction with supportive argument and evidence, and it does not, Petitioner nevertheless has still failed to prove “[associating] one or more files to [*data content*]”—i.e., to the digitized speech.

In applying its construction of “instant voice message,” the Board advanced an argument on behalf of Petitioner *sua sponte*. Paper 37 at 22 (“we determine that Patent Owner has not shown that the specification supports its narrow position that the recited attachment to an ‘instant voice message’ involves a direct attachment to only the data content.”). No party argued that “associating” A to B is satisfied by associating A to C (a distinct and separately-generated container for B).

It was Petitioner’s burden, not Patent Owner’s, to defend such a construction and to prove invalidity under such a construction. 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)).

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