UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner

Cases IPR2017-01797 and IPR2017-01798
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 ("FWD") entered January 31, 2019 (Paper 32) 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 should reconsider its findings concerning the "connecting" and "connected to" claim language because it is based on an overbroad construction and a misunderstanding of Griffin.

Several claims of the '622 patent recite limitations requiring a network interface of a client device to be connected to a packet-switched network. For example, among other limitations, claims 27 and 38 each require "a network interface coupled to the client device and *connecting* the client device to a packet-switched network" and claim 3 requires "a network interface *connected to* a packet-switched network." The Final Written Decision bases its finding of invalidity, in part, on the overbroad interpretation that "network interface" and the "packet-switched network" can be separated from each other by an intermediary network. FWD (Paper 32) at 18.

The Board should reconsider its claim construction because it impermissibly renders the "connecting" and "connected to" claim language meaningless in this context. The claim language expressly identifies the connecting component as a "network interface"—i.e., a physical structure of the "client device" that, as the term itself expresses, *interfaces* the "client device" with *a network*. The claim language also expressly identifies the specific network to which the "network interface" must interface—i.e., the "packet-switched network." The surrounding context, therefore, confirms the claim language would be rendered meaninglessly empty if read broadly to include two distant elements which are not connected to and interface with each other, but rather only communicate via intervening elements. *See Ethicon Endo-*

Surgery, Inc. v. U.S. Surgical Corp., 93 F.3d 1572, 1579 (Fed. Cir. 1996) (finding the term "connected to" in the phrase "connected to the slots" would be rendered "meaninglessly empty" if read broadly to include two distant elements which are separated by interposed elements).

The Board appears to have misunderstood the '622 patent in concluding it describes an embodiment that supports the interpretation adopted in the Final Written Decision. Specifically, the Board appears to offer the following statement as a direct quotation from the specification (though it is not): ". . . a legacy telephone 110 that has an indirect connection to a packet-switched network through a [public switched telephone network] PSTN network." FWD (Paper 32) at 18 (citing '622 patent at 7:37−52). The couplet "indirect connection" does not appear in the cited passage of the '622 patent, or anywhere in the patent for that matter. In any event, the cited passage does not support the Board's construction at least because it does not identify the *legacy telephone* 110 as being a "*client*" as claimed,[1] let alone a "client" that has a "network interface" allegedly *indirectly* connecting the legacy telephone 110 to a packet-switched network. In short, the claim language speaks for itself, as does the passage from the '622 patent cited in the Final Written Decision, and neither supports the construction applied in the Final Written Decision.

[1] Claim 27, for example, defines certain requirements for the "client" as follows: "an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface, wherein the instant voice messaging application wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message."

The Board appears to have overlooked a much more relevant passage of the '622 patent that uses "connected to" language in the context of a *client*. *See* Patent Owner Response (Paper 12) at 15−16 (quoting '622 patent at 4:1−18). In that passage, a client and server communicate with each other, though the patent describes the client as "connected to the local network" and the server as "connected to the external network." *Id*. There can be no question that the '622 patent uses "connected to" in this passage to refer to direct connections only. Indeed, interpreting the "connecting" and "connected to" limitations as encompassing so-called *indirect* connections would make the patent's description nonsensical, given that the client and server are described as "connected to" only selective ones of either the local network or the external network, *but not both*.

Dr. Haas similarly described Fig. 2 of Griffin in a manner that confirms the mobile terminals are only connected to the wireless carrier infrastructure:

> As I look at the 19 Figure 2, the Figure 2 that you asked me to look at shows that the mobile terminal 1, 2, 3, 4 are connected to wireless carrier 1 or wireless carrier 2, and those two, wireless carrier 1 and wireless carrier 2, are connected to the network 203, sir.

Ex. 2007 48:18–49:2. Tellingly, in summarizing his interpretation of the "connected to" structure of Griffin's system, Dr. Haas did not testify that the mobile terminals are themselves "connected to" network 203. This testimony, which the Board appears to have overlooked, further undermines the construction adopted in the Final Written Decision.

The Board also appears to overstate the significance of Dr. Easttom's statement concerning Figure 3 of Griffin. FWD (Paper 32) at 18–19 (citing Ex. 1040

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