UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA. INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

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Case IPR2017-01797 and IPR2017-01798
Patent 8,724,622 B2

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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 31, 2019, the Board issued a consolidated Final Written Decision in the above-captioned proceedings. Paper 32[1] ("Final Dec."). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (the '622 patent) are unpatentable. *Id.* at 104. On March 4, 2019, Patent Owner filed a Request for Rehearing. Paper 33 ("Req. Reh'g"). The Request for Rehearing raises two principal arguments. First, Patent Owner contends, the Board's findings concerning limitations requiring "connecting" a client device to a packet-switched network or that a client device be "connected to" a packet-switched network are "based on an overbroad construction and a misunderstanding of Griffin." Req. Reh'g 3–8. Second, Patent Owner contends, the Board misapplied its construction of the claim term "instant voice message." *Id.* at 8–10.

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. We address each of Patent Owner's arguments in turn.

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[1] Unless otherwise noted, all Paper and Exhibit numbers cited herein refer to identical papers and exhibits filed in both captioned cases.

## II.    ANALYSIS

### A.  *"Connecting" and "Connected To" Limitations*

Claims 27 and 38 of the '622 patent each recite "a network interface coupled to [a] client device and *connecting* the client device to a packet-switched network."  Ex. 1001, 26:19–20, 27:13–14 (emphasis added). Claim 3 of the '622 patent similarly recites "a network interface *connected to* a packet-switched network." *Id.* at 24:13–14 (emphasis added).  In the Final Written Decision, we explained that we understood Patent Owner's arguments in its analysis of the prior art to imply that the recited network interface must be "directly" connected to the "packet-switched network." Final Dec. 18 (citing IPR2017-01797, Paper 12, 13–19 (Patent Owner's Response to Petition)).  We considered those arguments, but we agreed with Petitioner that such a reading is contrary to both the disclosure of the '622 patent itself and Patent Owner's expert's deposition testimony.  *Id.* at 18–19 (citing IPR2017-01797, Paper 17, 6–8 (Petitioner's Reply to Patent Owner's Response); Ex. 1001, 1:66–2:21, 7:37–52, 8:32–39, 9:17–21, 22:67–23:3, Fig. 5; Ex. 1040, 103:10–104:22, 139:20–146:22, 61:7–13).

In the Request for Rehearing, Patent Owner argues that "[t]he Board should reconsider its claim construction because it impermissibly renders the 'connecting' and 'connected to' claim language meaningless in this context." Req. Reh'g 3.  According to Patent Owner:

> 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).

Req. Reh'g 3–4.

Patent Owner further contends that "[t]he Board appears to have misunderstood the '622 patent" in referring to an embodiment in which a legacy telephone is connected indirectly to a packet-switched network as supporting the interpretation adopted in the Final Written Decision, and "overlooked a much more relevant passage of the '622 patent that uses 'connected to' language in the context of a *client*." *Id.* at 4–5 (citing Final Dec. 18; Ex. 1001, 4:1–18). According to Patent Owner, the passage cited by the Board in the Final Written Decision "does not support the Board's construction at least because it does not identify the *legacy telephone* 110 as being a 'client' as claimed," whereas, in the passage cited by Patent Owner, "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 by the external network.'" *Id.* (emphasis in original). Patent Owner contends, "[t]here can be no question that the '622 patent uses 'connected to' in this passage to refer to direct connections only," and "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*." *Id.* at 5 (emphases in original).

We have considered Patent Owner's arguments but are not persuaded of any error in our Final Written Decision. First, Patent Owner's arguments do not persuade us that a connection to a network would be understood by a person of ordinary skill in the art to require a direct physical connection akin to the connection to the slots at issue in the *Ethicon* case cited by Patent Owner. Whether or not a network interface is itself a "physical structure," we do not understand a "packet-switched network" to be a physical structure in the same sense. To be sure, there may be physical structures such as routers, switches, and cables within such a network, but we do not understand any of those components themselves to be the network. Accordingly, it is unclear what it would mean for a network interface to be connected "directly" to a network, even if the claims had included such a recitation.

Second, notwithstanding Patent Owner's contention that the cited embodiments do not identify legacy telephone 110 as being a "client," we remain persuaded by Petitioner's argument that Patent Owner's expert, Mr. Easttom, confirmed in his deposition that "the specification supports [the Board's] understanding by describing embodiments that 'facilitat[e] instant voice messaging according to the present invention' using a legacy telephone 110 that has an indirect connection to a packet-switched network through a [public switched telephone network] PSTN network." IPR2017-01797, Paper 17, 6 (quoting Ex. 1001, 7:37–52) (citing Pet. 13; Ex. 1001,

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