

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

IPR2017-1799

PATENT 8,199,747

**PATENT OWNER RESPONSE TO
PETITIONER'S REQUEST FOR REHEARING**

To obtain a rehearing, Petitioner bears the burden of showing that the Board abused its discretion in denying institution. 37 C.F.R. § 42.71(c)-(d). “An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Star Fruits SNC v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005). Petitioner has not made that showing, the Board did not abuse its discretion, and the Request should be denied.

Petitioner first faults the Board for applying consistent reasoning across related matters: “It appears the Board’s reasoning is similar to the reasoning in its decision denying institution in a prior IPR involving the ’747 patent.” Paper 11 (“Req.”) at 3. Applying consistent reasoning in related matters clearly is not an abuse of discretion.

There likewise is no merit to Petitioner’s argument that it was an abuse of discretion to apply consistent reasoning here, ostensibly, because the instant Petition had presented different grounds than a previously denied petition. Petitioner is conspicuously ambiguous as to which “prior IPR” decision had applied similar reasoning in denying institution. To the extent Petitioner intended to refer to related matter IPR2017-1257, the Board in that matter denied institution of a similar (if not identical) challenge against the same claim 3 of the same patent based exclusively on the same *Zydney* reference. IPR2017-1257, Paper 8 at 20-23.

Here, the Board correctly recognized that Petitioner relies on *Zydney* (and not *Griffin*) for certain limitations of claim 3, including “controlling a method of generating ...”, which is the focus of Petitioner’s Request for Rehearing. Paper 9

(Institution Decision) at 30. Given that both related petitions relied on the same *Zydney* reference for the same limitation of the same claim of the same patent, it clearly was not an abuse of discretion for the Board to apply what Petitioner characterizes as “similar ... reasoning” in reaching a similar conclusion here. *See* Req. at 3.

Next, Petitioner falsely suggests that the Board’s decision here to deny institution on claim 3 is somehow inconsistent with related matter IPR2017-1800, ostensibly, because the Board there instituted trial on a “claim containing a nearly identical limitation in another patent.” *Id.* To say Petitioner’s argument is misleading is an understatement.¹ Petitioner neglects to mention that the Board in IPR2017-1800 did not weigh the sufficiency of evidence in that petition against the specific rebuttal presented here by Patent Owner in addressing a different claim of a different patent. While Petitioner does not identify which claim challenged in IPR2017-1800 allegedly has “a nearly identical limitation,” to the extent Petitioner had intended to refer to dependent claim 3,² the only discussion of that claim in the Board’s prior Institution Decision in IPR2017-1800 is the following statement:

Patent Owner does not argue [dependent] claim 3 separately from claim 1. For the same reasons as stated regarding claim 1 and based on our review of Petitioner’s arguments and evidence directed to the

¹ Notably, under 37 CFR § 412.12(2), the Board may impose a sanction against a party for “advancing a misleading or frivolous argument or request for relief.”

² Claim 3 of U.S. Patent No. 8,243,723 (challenged in IPR2017-01800) recites “[t]he method for instant voice messaging over a packet-switch network according to claim 1, further comprising the step of: controlling a method of generating the instant voice message based upon the connectivity status of said one or more recipient.”

additional limitations of claim 3, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claims 3 is unpatentable for obviousness over Griffin and Zydney.

IPR2017-1800, Paper 8 at 20 (emphasis added). Given that the Board in IPR2017-1800 did not consider any Patent Owner rebuttal evidence for anything resembling the claim language in question when the Board rendered its preliminary decision, the Board here (in IPR2017-1799) did not reach an inconsistent decision, and certainly did not abuse its discretion, by considering and finding persuasive Patent Owner's rebuttal addressing claim language specific to claim 3 of the '747 patent.

Finally, Petitioner faults the Board for allegedly misunderstanding the arguments presented in the Petition concerning the limitation "controlling a method of generating ...", as recited in claim 3. However, even a cursory review of the Board's Decision confirms that the Board considered, comprehended, and rejected the very argument petitioner emphasizes in its Request for Rehearing. More specifically, Petitioner argues that the point allegedly misapprehended by the Board was Petitioner's reliance on *Zydney's* alleged teaching of choosing between two alternative modes of generating a message—namely, a "pack and send" option and an "intercom" option. Req. at 6. This argument is restated in the Board's detailed summary of the Petition, which includes the following relevant observations (among others):

Petitioner argues, more particularly, that Zydney discloses "two different modes of generating an instant voice message," namely,

Zydney’s “pack and send” and “intercom” modes. Pet. 59; see supra Section III.B.3. Petitioner contends that Zydney explains that the mode of messaging used is determined based on whether the intended recipient of the message is “online” or “offline”[.]

Paper 9 at 30-31. After confirming an understanding of Petitioner’s argument, the Board then summarized Patent Owner’s rebuttal and held (among other findings) that “[a]s Patent Owner points out (Prelim. Resp. 44–45), the Petition does not persuasively demonstrate that either the pack and send mode or the intercom mode of operation is controlled in any manner by a connectivity status of a recipient.” *Id.* at 32-33. Petitioner may be disappointed by this outcome, but a request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence.

For at least the foregoing reasons, the Board did not abuse its discretion; and its determinations regarding claim 3 should not be disturbed. Accordingly, the Request for Rehearing should be denied.

Date: February 22, 2018

Respectfully submitted,

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