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 IPR2017-01799
Patent 8,199,747 B2

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

In response to the Final Written Decision entered January 31, 2019, (Paper 40, hereinafter "Decision") and pursuant to 37 CFR § 42.71(d), Uniloc 2017 LLC ("Patent Owner") hereby respectfully request a rehearing and reconsideration by the Patent Trial and Appeal Board ("Board") of its Final Decision finding unpatentable Claims 1−3, 12 and 13 of the '747 patent. Patent Owner's request for rehearing is based upon the following considerations.

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's analysis of the "attaching" limitations is legally and factually flawed and inconsistent with its repeated prior rulings.

Claim 1 of the '747 patent recites "generating an instant voice message, wherein generating includes recording the instant voice message in an audio file and *attaching one or more files to the audio file*." Claim 13 depends from claim 1 and thus requires the same. It is undisputed and indisputable that this claim language expressly differentiates the "audio file" from the "instant voice message" by reciting both elements in the same claim.

The Board acknowledges in its Final Written Decision that claim 1 expressly requires attaching one or more files *to the audio file*. Final Written Decision (Paper 40) at 12−13. Prior to rendering its Final Written Decision, the Board had also *repeatedly* and *consistently* held that attaching a file to a message is *not* the same as attaching a file to an audio file included in that message. *See, e.g.*, IRP2017-01257, Paper 8 at 18–19; IPR2017-02085, Paper 11 at 18–21; IPR2017-01799, Paper 9 at 22; IPR2017-01800, Paper 8 at 22–23. This consistent and repeated precedent correctly recognizes the claim language means what it says. Nevertheless, the Final Written Decision here adopts an invalidity theory that alleges this claim language is satisfied, instead, by attaching one or more files to a *container* of a distinct and separately-generated audio file, as opposed to an attachment *to the audio file itself*.

The Final Written Decision misapprehends the dispute injected by the Petition as being directed to how "attachment" is performed. Final Written Decision (Paper 40) at 13−15. Neither the Petition nor the Response filed by Patent Owner identifies

"attachment" as a term that requires construction and neither document expressly sets forth a proposed construction for that term. The dispute injected by the Petition was not *how* "attachment" is performed but rather precisely which claim *elements* must be attached to each other (regardless of how such an attachment is effected). Patent Owner's Response simply relies upon the Board's prior repeated and consistent findings (of which the Board could have taken judicial notice) that attaching a file to a message is *not* the same as attaching a file to an audio file included in that message. Response (Paper 21) at 22–26.

As the Board correctly observed in related matter IPR2017-01800, Petitioner has conceded that Griffin "does not describe attaching one or more files to the audio file in the speech chat message." IPR2017-01800, Paper 34 at 28 (citation omitted). This admission alone should have ended the inquiry, particularly given that the Board has repeatedly considered and rejected the theory that Zydney discloses this claim language by attaching one or more files to a voice container that allegedly only *contains* a distinct a separately-generated audio file,

The Final Written Decision suggests its reversal of the Board's precedent is based on a construction of "one or more file files attached to an audio file" to mean "indicating that another file (or files) is associated with the audio file." Final Written Decision (Paper 34) at 18.[1] The Petition did not advance this construction, much less explain and defend it with some rational underpinning.

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[1] The Board bases its new construction, at least in part, on its own characterization of certain statements from Dr. Easttom's cross-examination in distinct matters involving the distinct '622 patent. Final Written Decision (Paper 40) at 14 and 51 (both citing Ex. 1040). Not only is the cited testimony far outside the scope of direct,

Patent Owner was not provided due process ability to respond to the Board's construction and point out why it is incorrect. *See In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (". . . 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."). The Board appears to have overlooked, for example, that the inventor's use of the words "associating" and "attached" in the same claim (*see, e.g.*, claim 2 of the '723 patent) unambiguously confirms that the inventor recognized these terms have distinct and separate meanings. *See, e.g., Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) (reversing lower court's ruling that a "pusher assembly" and a "pusher bar" have the same meaning).

Even if Patent Owner had been provided due process ability to respond to this new claim construction *and* the record nevertheless supported interpreting "attached" to mean "associated," which is not the case here, the Petition's reliance on attaching files to Zydney's *voice container* that allegedly only *contains* a distinct and separately-generated audio file is still distinguishable from "the instant voice

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it is offered entirely outside the context of the '747 patent, let alone the specific claim language recited in claim 1 of the '747 patent. Moreover, any cross-examination testimony Mr. Easttom offered concerning how attaching might be affected in the abstract and outside the context of the claim language does not somehow warrant rewriting unambiguous and specific requirements of "generating an instant voice message, wherein generating includes recording the instant voice message in an audio file and *attaching one or more files to the audio file*," as recited in claim 1. When addressing the specific context of the claim language, Dr. Easttom testified that "[a]ttaching a file to [Griffin's] message 400 does not disclose attaching a file to an audio file in which the claimed "instant voice message" is recorded, and also does not disclose attaching a file to any purported file or contents within the message 400." Ex. 2001 ¶ 44.

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