

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

UNILOC 2017 LLC,
Patent Owner

Case IPR2017-01800
Patent 8,243,723 B2

**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 34, 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 of the ’723 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. Nothing advanced during trial disturbs the Board’s original finding that the Petition fails to establish even *prima facie* obviousness for the “controlling” limitations of claim 3.

In addressing claim 3, the Board correctly observed in its original Institution Decision that “Petitioner acknowledges that Griffin does not explicitly disclose controlling the method of generating a speech chat message based upon a connectivity status of each recipient.” Paper 8 at 14-15 (citing Pet. 62); *see also* IPR2017-01799, Paper 9 at 30 (observing the same concession by Petitioner in addressing the same claim language recited in claim 3 of the ’747 patent).

The Petition relies on a combination with Zydney as allegedly curing this *admitted* deficiency of Griffin, arguing through Dr. Haas that “Zydney discloses controlling the method of generating an instant voice message based on the connectivity status of the recipient, because the connectivity status of the recipient determines whether the pack-and-send mode is mandatory or optional.” Final Written Decision (Paper 34) at 66 (citing Haas Decl. ¶¶ 188–191). This is precisely the same argument concerning Zydney that the Board has considered and flatly rejected in multiple related proceedings. *See, e.g.*, IPR2017-01257, Paper 8; IPR2017-02085, Paper 11; IPR2017-01799, Paper 9. It is also precisely the same argument the Board considered and rejected in denying institution in its original Institution Decision. *See* Paper 9.

Further scrutiny of the Board’s prior reasoning confirms it should be applied again here. In denying institution in IPR2017-02085, for example, the Board considered and rejected (as unsupported by the teachings of Zydney) nearly identical

arguments presented by Petitioner's expert there, Dr. Min. There, the Board characterized the relevant portion of Dr. Min's testimony as follows:

We acknowledge Dr. Min's testimony relied upon by Petitioner, including that "Zydney . . . discloses that the instant voice message is generated in different manners in [the pack and send and intercom] modes of operation," in support of which he testifies that "in the 'real time 'intercom' mode' Zydney discloses that '[a] small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed,'" and that "[i]n at least some embodiments, in the pack and send mode, the entire instant voice message is recorded prior to transmission." Ex. 1003 ¶ 73 (quoting Ex. 1004, 16:4–7; citing Ex. 1004, 11:1–13, 15:8–16:17). Nonetheless, neither Petitioner nor Dr. Min explains sufficiently for purposes of demonstrating anticipation how the cited portions of Zydney disclose that the method of generating the voice container differs depending on the selection of the mode. We note in this regard that the quoted portion of Zydney states that "a small portion of the digitized voice . . . is transmitted before the entire *conversation* has been completed" when intercom mode is invoked, which does not necessarily mean any portion of the digitized voice is transmitted before *a given message within that conversation* has been completed. Ex. 1004, 16:4–7 (emphasis added). By the same token, to the extent an "entire instant voice message" might be recorded prior to transmission in the pack and send mode, that would not preclude transmitting portions of a message "before the entire *conversation* has been completed." Indeed, Figure 7 of Zydney suggests that messages may be partitioned into smaller containers for transmission irrespective of the selected mode. *See* Ex. 1004, Fig. 7 ("1.1.6. Partitioning long voices into small containers to allow for faster delivery of containers between originators and recipients"). Regardless, even if we were to read Zydney as disclosing that voice containers would contain smaller chunks of voice data when the intercom mode is invoked than when pack and send mode is invoked (a contention the Petition does not explicitly state), that would not necessarily mean that

the *method of generating* the voice container is any different in the intercom mode than in the pack and send mode, such that we could conclude that Petitioner has proffered evidence of anticipation by Zydney performing the required “*controlling a method for generating.*”

IPR2017-02085, Paper 11 at 27–28 (emphasis original).

Here, nothing in the Petition or in Dr. Haas’ testimony even addresses, much less refutes, the Board’s prior observations in related matter IPR2017-02085 concerning the deficiencies of Zydney (as set forth in the block quotation above). For example, at least the following Board findings in related-matter IPR2017-02085 remain unrebutted by Petitioner and apply equally here: (1) Zydney’s statement that “a small portion of the digitized voice . . . is transmitted before the entire conversation has been completed” when intercom mode is invoked does not necessarily mean any portion of the digitized voice is transmitted before a given message within that conversation has been completed; (2) Figure 7 of Zydney suggests that messages may be partitioned into smaller containers for transmission irrespective of the selected mode; (3) to the extent an “entire instant voice message” might be recorded prior to transmission in the pack and send mode, that would not preclude transmitting portions of a message “before the entire *conversation* has been completed; and (4) even if the Board were to read Zydney as disclosing that voice containers would contain smaller chunks of voice data when the intercom mode is invoked than when pack and send mode is invoked (a contention neither the Petition nor Dr. Haas explicitly states), that would not necessarily mean that the *method of generating* the voice container is any different in the intercom mode than in the pack and send mode. *Id.*

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