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Paper 36
Entered: January 17, 2019

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

Before, JENNIFER S. BISK, MIRIAM L. QUINN, and CHARLES J. BOUDREAU, *Administrative Patent Judges.*

QUINN, *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 Final Written Decision in this proceeding. Paper 34 ("Final Dec."). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1–3 of the '723 patent are unpatentable. *Id.* at 71. On March 4, 2019, Patent Owner filed a Request for Rehearing. Paper 35 (Req. Reh'g). Patent Owner argues three points. First, Patent Owner takes issue with our findings regarding the "transmitting" limitation of claim 1. Req. Reh'g 7–8. Second, Patent Owner argues that our analysis of the "attached" limitation, recited in claim 2, is flawed and inconsistent with prior findings. *Id.* at 9–12. Third, Patent Owner takes issue with our determination that Zydney teaches the further limitation recited in claim 3. *Id.* at 3–8.

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.

II. ANALYSIS

Arguments Concerning Claim 1

Claim 1 recites two phrases that recite the word "nodes." First, claim 1 recites "monitoring a connectivity status of *nodes* . . . , said connectivity status being available and unavailable." Second, claim 1 recites the phrase "transmitting a signal to a client including a list of the recorded

connectivity status for each of the *nodes* in the sub-set corresponding to the client. We construed the term "nodes" to refer to devices. Final Dec. 11. We also concluded that Griffin teaches the "monitoring" limitation, including the "connectivity status of the *nodes*" because Griffin maintains the presence status or "current" status for each identifier, tracks changes *to the mobile terminal's status 702*, and updates other terminals as to those changes, as shown in Figure 7 of Griffin. Final Dec. 39–40. We also noted in our Final Written Decision that Griffin describes the ID field of Figure 7 as representing a target recipient of a message, but that it is "associated directly with a mobile terminal that the person uses to connect to the network." *Id.* at 40 (citing Ex. 1005, 1:40–43, 4:11–13, 5:15–20). We also quoted Griffin as describing that the chat messages refer to messages directed to one or more mobile terminals and sent by mobile terminals. *Id.* at 40–41 (citing Ex. 1005, 5:6–9).

As for the "transmitting" limitation, we determined that Griffin's "buddy list" was evidence that Griffin associates a "sub-set of the nodes" with a client and that the "buddy list" message update is the required transmission of the recited "list of the recorded connectivity status for each of the nodes." *Id.* at 50–51. We determined that the "buddy list update message includes the presence status of each buddy in the particular buddy list." *Id.* at 52 (citing Ex. 1005, 7:48–49, 7:54–57). Patent Owner argues that presence manager 302 refers to a human participant instead of the "terminal," and, therefore, faults us for misapprehending that Griffin's presence status of "unavailable" refers to a *human participant's* status, whether or not the participant's *device* is presently connected. Req. Reh'g 8. We do not agree.

As stated above, we interpreted Griffin's presence manager to identify when the terminal's connection changes and that the identifier of a user of the system is associated directly with a mobile terminal. As we stated with reference to Figure 9 of Griffin, which depicts a buddy list screen: "This display alone is evidence that the mobile terminal ("client") contains a list of buddies (plural), each being a user of Griffin's system, and each communicating with a mobile terminal and having a presence status ('sub-set of the nodes')." Final Dec. 47. Thus, we determined that Griffin is not referring only to human participants when addressing the "nodes" or the "buddies." These entities require a mobile terminal in order to use the system, and the availability or unavailability status refers also to the capability of the mobile terminal to receive speech chat messages. *See* Final Dec. 41 (discussing Griffin's "Available" status as a determination that the *mobile terminal* can receive the message type, and that the "Off" status indicates that the *mobile terminal* is not available).

Furthermore, we also relied on the teachings of Zydney of the "Available" and "Not logged on" status to teach the "connectivity status being available and unavailable," thereby taking into account further teachings in the art that the connectivity status refers to the device and not merely the human participant. Final Dec. 42–43. For instance, we credited Dr. Haas's testimony that Zydney teaches the well-known technique of informing whether a terminal is available to receive a speech chat message, and that Zydney teaches the advantage of conveying the terminal's availability status to determine which software agent is able to exchange messages. *Id.*

Accordingly, we are not persuaded by Patent Owner's argument that we misapprehended Griffin's disclosure of the presence manager tracking the status of devices. We further note that Patent Owner's argument does not address the combination of Griffin and Zydney in this regard.

Arguments Concerning Claim 2

Patent Owner argues that we misapprehended the dispute concerning the "attachment" recited in claim 2. Req. Reh'g 9–10. In particular, Patent Owner contends that we construed the term "attachment" when neither party expressly set forth a construction for the term, and that the issue was not "how" the attachment is performed, but rather, which claim elements must be attached to each other. *Id.* Patent Owner posits that "[i]t is undisputed that neither Griffin nor Zydney discloses attaching." *Id.* at 10. Patent Owner also complains that it "was not provided due process ability to respond to the Board's construction and point out why it is incorrect." *Id.* at 11.

We are not persuaded by Patent Owner's arguments that we misapprehended the parties' arguments regarding the scope of the term or that it was not proper for us to construe the term. First, we expressly construed the term in this proceeding consistent with the claim language requiring the attachment to an audio file and the Specification's description of embodiments in which an instant voice message is in the form of audio file. Final Dec. 16 (describing the Specification's only description of "attachment" as providing some indication (e.g., linkages) that another file (or files) is associated with the instant voice message or the audio file). We noted that credible expert testimony confirmed our analysis because of the understanding of a person of ordinary skill in the art concerning attachment

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