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.,
Petitioners

v.

UNILOC 2017 LLC,
Patent Owner

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Case IPR2017-01801
Patent 8,995,433 B2

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

Pursuant to 37 CFR § 42.71(d), Patent Owner respectfully requests a rehearing and reconsideration of the Final Written Decision entered January 31, 2019 (Paper 31, hereinafter "Decision"). 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).

II. ARGUMENT

Patent Owner respectfully submits that the Final Written Decision should be reconsidered at least because it misapplies the Board's construction of "instant voice message" to mean "data content including a representation of an audio message." *See, e.g.*, FWD (Paper 13) n.3 ("We previously construed "instant voice message" as data content including a representation of an audio message. Facebook, Inc. v. Uniloc 2017 LLC, Case IPR2017-01428, slip op. at 12−18 (PTAB November 30, 2018) (Paper 40)."). In related matters, the Board clarified that "data content" in this context refers to "user's speech . . . in some digitized form." *See, e.g.*, IPR2017-1797, FWD (Paper 32) at 14−15.

Here, the term "attaches" appears in independent claim 9 as follows:

> 9. A system comprising:
> an instant voice messaging application comprising:

a client platform system for generating an instant voice message;

a messaging system for transmitting the instant voice message over a packet-switched network; and

wherein the instant voice messaging application **attaches** one or more files to the instant voice message.

Substituting in the Board's construction for "instant voice message" into the remainder of this recitation yields, "wherein the instant voice messaging application attaches one or more files to the [*data content including a representation of an audio message*]." The Petitioner did not meet its burden to prove obviousness under such a construction. The Petitioner could not because it is undisputed that neither Griffin nor Zydney expressly or inherently discloses attaching *one or more files* to *data content* (i.e., to what the Board characterized as referring to user's speech in some digitized form).

To be clear, and contrary to what the Board suggests in its Final Written Decision, Patent Owner has not advanced a narrowing construction by arguing that the claim language explicitly directed to attaching one claim term ("one or more files") to another claim term ("the instant voice message") means what it says. It was Petitioner's burden, not Patent Owner, to advance and defend a construction (in the Petition itself) that departs from explicit claim language that unambiguously identifies the *specific elements* that must be attached.

The Board has repeatedly observed that Petitioner concedes Griffin "does not describe attaching one or more files to the audio file in the speech chat message." IPR2017-01800, FWD (Paper 34) at 28; *see also* IPR2017-01797, FWD (Paper 32) at 27 (citing Pet. 65−66). Here, Petitioner's declarant, Dr. Hass

likewise expressly concedes that "Griffin does not explicitly describe attaching one or more files to a speech chat message." Haas Decl. ¶ 191.

Notwithstanding these concessions, the Final Written Decision concludes Griffin alone renders obvious "attaches one or more files to the instant voice message" ostensibly because Griffin discloses attaching files only to text messages and it would have been obvious to modify Griffin to implement the same attaching in the entirely different context of speech chat messages. FWD (Paper 31) at 68 (citing Griffin at 6:38−44 and 12:63−67). The cited portions of Griffin, however, do not disclose attaching one or more files to *data content*, as characterized by the Board in its construction of "instant voice message." Neither the Petition nor its attached declaration argues otherwise. Petitioner could not because, in the embodiment cited by the Board, Griffin expressly distinguishes *message 400* from the *message content 406*; and it is undisputed that Griffin does not expressly or inherently disclose that the attachments 407 are attached to the *message content 406* itself. Griffin at 6:38−44. Accordingly, the proposed modification (which relies on mere conclusory speculation extraneous to the express disclosure in Griffin) would still fail to map unto what the claim language explicitly requires.

The Petition attempts to cure the conceded deficiency of Griffin by alleging it would have been obvious to modify Griffin based on the alleged teaching in Zydney of attaching one or more files to a voice container that only contains a distinct and separately-generated audio file. FWD (Paper 31) at 27 (citing Pet. 65−66); Haas Decl. ¶¶ 191−192. Setting aside the insufficiency of record evidence supporting such a modification, the proposed modification does

not render obvious the claimed "instant voice message" as construed by the Board (i.e., "*data content* including a representation of an audio message," which the Board further clarified as referring to user's speech in some digitized form). Zydney cannot cure the conceded deficiency of Griffin because it is undisputed that Zydney, at best, only attaches to a *voice container*, which Zydney expressly distinguishes as distinct and separately generated from anything resembling data content in the form of digitized speech.

The Board also erred in suggesting these deficiencies of both Griffin and Zydney are somehow cured by applying a new construction (not advanced in the Petition) that substitutes the term "attaches" with, instead, the word "associated." Neither the Petition nor Patent Owner's Response identified the term "attaches" as one that requires construction. Moreover, Patent Owner was not provided due process ability to respond to the Board's substitution of the word "attaches" with "associated" and point out why such a construction 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* in a related patent (*e.g.*, claim 2 of the '273 patent, which depends from and requires all limitations of claim 1) 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).

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