

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 IPR2017-01802  
Patent 7,535,890 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

All claims challenged in IPR2017-01802 recite limitations directed to the *server* (1) “receiving the . . . instant voice message” and either (2) “delivering the instant voice message” or (3) “temporarily storing the instant voice message *if a selected recipient is unavailable* and delivering the stored instant voice message to the selected recipient *once the selected recipient becomes available.*” The Board appears to have misapprehended relevant argument and evidence directed to why Petitioner’s proposed combination of Griffin and Zydney would render Griffin inoperable for its intended purpose. *See, e.g., In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (holding that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification); *See In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“a reference teaches away from a combination when using it in that combination would produce an inoperative result.”).

Patent Owner argued in its Response that Petitioner’s proposed combination of “Zydney in the system described by Griffin would frustrate the purpose of Griffin of a server-based messaging paradigm in which technical feasibility of communicating a message to a recipient terminal is determined at the server complex 204 rather than at the mobile terminal 100 and in which only the messages vetted by the server complex 204 as feasible are subsequently communicated by the server complex 204.” Response (Paper 12) at 23 (citing Easttom Decl. ¶ 31).

Dr. Easttom describes Griffin as disclosing that “[it] is the server complex 204 that performs this determination [of whether the targeted recipient terminals are technically able to receive the particular type of message] by consulting its presence records 700 to establish ‘whether [each] recipient is ready to receive the particular type of message.’” Easttom Decl. ¶ 31 (quoting Griffin at 5:12–14 and 6:56–66) (underlining original).

Dr. Easttom further testified that Griffin teaches its system is expressly designed such that JaneT should not be considered available for instant voice message, regardless whether her device is online or offline, because she is designated as a “TextOnly” buddy. Easttom Decl. ¶ 34. Therein lies a fundamental and fatal problem with Petitioner’s proposed combination. Modifying Griffin to incorporate Zydney’s alleged concept of device available/unavailability in terms of

online/offline connectivity status would result in JaneT being considered *available* for instant voice messaging because her device is online when, as a matter of technical capability, her device cannot receive such messages. This would result in the server erroneously attempting to deliver a message that cannot be delivered.

The Final Written Decision states that Petitioner “does not argue that Zydney’s availability teachings would replace Griffin’s status 204.” FWD (Paper 31) at 32. However, as alleged support for this understanding of the Petition, the Board provides a quotation from the Petition that confirms the opposite of the Board’s understanding: “the combination of Griffin and Zydney would result ‘in Griffin’s status 702 indicating the availability of a terminal 100 for receiving messages *based on whether terminal 100 is currently connected to server 204.*” *Id.* (quoting Pet. 26). Thus, the quotation from the Petition confirms the (incompatible) availability teaching in Zydney would impermissibly replace Griffin’s explicit disclosure that a server determines whether a recipient terminal is designated text-only and thus technically incapable of receiving speech chat messages, regardless whether it is online or offline.

The Final Written Decision also points to the Institution Decision observation that “none of Petitioner’s contentions rely on ‘text-only’ buddy features.” FWD (Paper 31) at 32 (citation omitted). This misses the point. The problem with the proposed combination is not that Petitioner allegedly relies on “text-only” buddy features. Rather, it is that the proposed combination would render Griffin unsatisfactory for *its* intended purpose and would produce in

operative result by fundamentally changing how Griffin determines availability and responds accordingly.

### III. CONCLUSION

In view of the foregoing, Patent Owner respectfully requests that the Board grant a rehearing and reconsider its Final Written Decision.

Date: March 4, 2019

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