

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02080
Patent No. 8,724,622

PETITIONER'S REQUEST FOR REHEARING

Petitioner hereby requests rehearing under 37 CFR § 42.71(d) in response to the non-institution decision (“Decision”) in proceeding IPR2017-02080.

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

In the Decision, the Board found that the Petition failed to demonstrate a reasonable likelihood that claims 3-23 of U.S. Patent 8,724,622 (“the ’622 patent”) would be found unpatentable based on Grounds 1-5 of the Petition.

Petitioner requests that the Board reconsider its Decision in light of evidence in the Petition that was misapprehended or overlooked, including Petitioner’s cited evidence of what type of data element constitutes an express disclosure falling within the scope of the “object field” claim element recited in independent claim 3. Proper consideration of the evidence on this issue compels a conclusion that Grounds 1-5 (anticipation based on Zydney or obviousness based on Zydney in view of Enete, Stern, Coussement, or RFC2131) provide a reasonable likelihood of Petitioner prevailing against each of claims 3-23 of the ’622 patent. Therefore, based upon the full record, the Board should institute *inter partes* review of claims 3-23 based on Grounds 1-5 of the Petition.

II. LEGAL STANDARDS

A request for rehearing “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.” 37 CFR §

42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 CFR § 42.71(c). “An abuse of discretion is found if the decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016); *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1334 (Fed. Cir. 2010).

III. BASIS FOR RELIEF REQUESTED

A. The Decision Misapprehends or Overlooks Petitioner’s Evidence About The Scope Of The Term “Object Field”

Rehearing is appropriate because the Decision misapprehended or overlooked Petitioner’s cited evidence showing what is encompassed within the scope of the term “object field,” as recited in independent claim 3. In particular, the Petition explained that:

Claim 3 requires that the recited ‘instant voice message’ have an ‘object field’ that includes a ‘digitized audio file.’ **Thus, under BRI, the recited ‘object field’ is a field of a data packet that includes a digitized audio file.**

Petition, 18 (emphasis added). The Petition also cites Dr. Min to show that:

Based on the teachings of the ’622 patent, ... the claimed ‘object field’ encompasses a data packet that includes a digitized audio file.

GOOGLE1003, ¶60. Dr. Min’s testimony is based on analysis of how the term “object field” is actually used in the ’622 patent. *See id.* As such, the cited evidence in the record established that a prior art disclosure of “a data packet that includes a digitized audio file” is an express disclosure of a conventional element falling within the scope of the “object field” recited in independent claim 3. *Id.*; Petition, 18.

Critically, the Decision misapprehended or overlooked this evidence. Indeed, the Decision fails to address Petitioner’s explanation of elements falling within the scope of the “object field” limitation, and also fails to explain why Petitioner’s cited evidence pertaining to this fact was not considered by the Board. The Decision *never once* acknowledges Petitioner’s reliance on Dr. Min’s straightforward explanation (quoted above), nor does it cite any evidence—whether from the ’622 patent, Dr. Min, Patent Owner’s declarant Mr. Easttom, or elsewhere—refuting Petitioner’s express argument of what type of data element constitutes a disclosure falling within the scope of “object field” under the broadest reasonable interpretation standard.

The Decision’s failure to address Petitioner’s analysis and evidence on this issue is contrary to Federal Circuit precedent, which requires the Board to consider the parties’ positions and all material evidence in support of the same. *See Owens Corning v. Fast Felt Corp.*, 873 F.3d 896, 898 (Fed. Cir. 2017) (reversing PTAB

decision because “once the key claim term is given its broadest reasonable interpretation,” the record conclusively establishes unpatentability); *see also Nestle USA, Inc. v. Steuben Foods, Inc.*, 686 Fed. Appx. 917 (Fed. Cir. 2017); *EMC Corp. v. Clouding Corp.*, 686 Fed. Appx. 857 (Fed. Cir. 2017); *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341 (Fed. Cir. 2016). By failing to address Petitioner’s express argument and by failing to give proper weight to the testimony evidence regarding what type of data element constitutes an express disclosure falling within the scope of the recited “object field,” the Decision misapprehended or overlooked critical portions of the Petition in contravention of law and the Office’s own rules.¹

B. The Decision’s Implicit Construction Of “Object Field” Is Improper Under BRI And Contrary To The Federal Circuit’s Recent Vacatur Of A PTAB Decision In *Google LLC v. Network-1 Techs., Inc.*

In concluding that the Petition presents insufficient evidence that the “body” of Zydney’s voice container constitutes an “object field,” the Board implicitly

¹ Even if Patent Owner provided evidence to create a material dispute with respect to Dr. Min’s testimony here (which it did not), the Decision failed to apply 37 C.F.R. § 42.108(c) requiring the Board to consider all testimony evidence “in the light most favorable to the petitioner” for purposes of deciding whether to institute an *inter partes* review.

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