

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2017-02202
Patent 8,239,852 B2

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

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–8 and 16–18 (the “challenged claims”) of U.S. Patent No. 8,239,852 B2 (Ex. 1101, “the ’852 patent”) on four asserted grounds under 35 U.S.C. § 103(a). Paper 1 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). After considering the information presented in the Petition and the Preliminary Response, we determined that Petitioner had not established a reasonable likelihood of prevailing in its assertions with respect to any of the challenged claims, and we, accordingly, denied institution of *inter partes* review. Paper 8 (“Decision” or “Dec.”); *see* 35 U.S.C. § 314(a) (providing that an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition”). We found, in particular, that Petitioner had not established sufficiently that the Richardson¹ and Demeyer² references relied upon in each asserted ground would have taught or suggested “perform[ing] physical device recognition . . . to determine machine parameters including account information for a user of [a] client device and features of software that the user of the client device is entitled to use,” as recited in each of the challenged independent claims (i.e., claims 1 and 18). Dec. 15–19.

Petitioner requests rehearing, contending that the Decision was based on a misinterpretation of both the claim language and Petitioner’s

¹ U.S. Patent Application Publication No. 2008/0320607 A1 (Ex. 1104).

² U.S. Patent Application Publication No. 2005/0076334 A1 (Ex. 1105).

arguments. Paper 9 (“Request” or “Req. Reh’g”), 1. For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

ANALYSIS

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “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 C.F.R. § 42.71(d).

In its Request, Petitioner alleges several errors in the Decision. First, Petitioner contends, “the Board implicitly construed the claim limitation ‘performs physical device recognition . . . to determine machine parameters’” in the Decision “in a way that excludes two types of data explicitly recited by the ’852 Patent’s claims and described in the specification” and “contradicts the language of the claims themselves.” Req. Reh’g 1, 4. Specifically, Petitioner argues, “the ’852 Patent’s claims explicitly state that the term ‘machine parameters’ includes both ‘account information for a user of a client device’ and ‘features of software that the user of the client device is entitled to use.’” *Id.* at 1 (citing Ex. 1101, claims 1, 18). But, according to Petitioner, although “[t]he Board acknowledged that the prior art presented in the Petition discloses acquiring ‘account information’ and ‘features of software,’” “the Board, nonetheless[] found that this [sic] data . . . do not qualify as ‘machines parameters’” under an alleged implicit construction “requiring this data to be ‘present in’ some other, undefined machine parameter.” *Id.* (citing Dec. 18); *also id.* at 4.

According to Petitioner, “the claim language makes clear that ‘account information . . .’ and ‘features of software . . .’ are themselves ‘machine parameters’ and need not be ‘present in’ some other parameter,” and “by excluding Demeyer’s ‘account information . . .’ and ‘features of software . . .’ from the scope of ‘machine parameters,’ the Board’s implicit construction of this limitation conflicts with the explicit claim language that such data are two types of ‘machine parameters.’” *Id.* at 5.

Further, Petitioner argues, “[t]his incorrect claim construction also led the Board to construe ‘physical device recognition’ in a manner contrary to its description in the ’852 Patent specification.” *Id.* at 1–2. In particular, according to Petitioner, “[t]he ’852 Patent’s specification expressly teaches that the ‘machine parameters’ that may be determined via ‘physical device recognition’ include ‘user account information’ and ‘features of the software/hardware the user is entitled to use.’” *Id.* at 5–6 (citing Ex. 1101, 5:51–55). Petitioner further contends that the Decision fails to explain either why “‘account information’ and ‘software features’ . . . taught by Demeyer do not qualify as “machine parameters”” or why “Richardson’s disclosure of acquiring IP address and geo-location code information does constitute ‘physical device recognition’ of ‘machine parameters’” in view of the ’852 patent’s identification or gathering of, allegedly, the “same” data or information. *Id.* at 6 & n.1. Petitioner concludes, “[b]ecause the Board’s interpretation of the claim language excludes the examples recited in the claims and described in the specification, it is legally erroneous,” and “the denial of institution . . . should be reversed.” *Id.* at 1–2, 7.

Moreover, Petitioner contends, “[t]he Board’s decision is also unsupported by the evidence of record,” because “[t]he Board’s implicit

construction appears to require each ‘machine parameter’ to uniquely identify a computer.” *Id.* at 2; *also id.* at 8–10. According to Petitioner, “the ’852 Patent recognizes that each ‘machine parameter’ need not be unique and that the alleged invention is to use a combination of parameters to uniquely identify a machine.” *Id.* at 9 (citing Ex. 1101, 7:1–7; Ex. 1103 ¶¶ 31, 51–52). Further, Petitioner contends, “Patent Owner similarly described the ’852 Patent’s ‘unique device identifier’ as ‘derived from multiple machine parameters readable on the client device,’” and “Patent Owner did not argue that each ‘machine parameter’ must be capable of uniquely identifying a computer system.” *Id.* at 9 n.2 (citing Prelim. Resp. 11–12).

Still further, Petitioner contends, “the combined teachings of Richardson and Demeyer disclose the ‘performs physical device recognition . . . to determine machine parameters’ claim limitation” under the broadest reasonable construction, and, “thus, under a legally correct construction of the ‘machine parameters’ claim limitation, the cited prior art renders the challenged claims obvious.” *Id.* at 11. In support of this contention, Petitioner alleges that “[t]he Board correctly found that Demeyer discloses acquiring ‘account information for a user of a client device’ and ‘features of software that the user of the client device is entitled to use’ as part of its software authorization process”; that “Richardson discloses generating a ‘unique device identifier’ from various ‘machine parameters,’ including hardware-, software-, and user-related data”; that “Richardson further discloses determining such data using a software program, which is the same mechanism disclosed by the ’852 Patent for its ‘physical device recognition’ of ‘machine parameters’”; and that “the Petition presents

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.