UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

IPR2018-00282
PATENT 7,092,671

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

In response to the Final Written Decision entered June 4, 2019 (Paper 30) and pursuant to 37 CFR § 42.71(d), Patent Owner hereby respectfully request a rehearing and reconsideration of the Board's Final Written Decision.

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

A. The Board appears to have overlooked or misunderstood argument and evidence responsive to Petitioner's incorrect claim construction

It is undisputed that independent claim 9 expressly distinguishes the following separate and distinct steps: "c) transferring the specific telephone number from the handheld computer system to the telephone using a wireless communication" (the "transferring" step) and "d) controlling the telephone using the handheld computer system to cause the telephone to dial the specific number" (the "controlling" step). Paper 33 at 12.[1] The Board appears to have overlooked or misunderstood, however, Patent Owner's explanation of why Petitioner's claim interpretation would render the "controlling" step superfluous. Indeed, the word "superfluous" does not appear in the Final Written Decision.

[1] The other challenged independent claims recite analogous claim language.

As detailed in Patent Owner's briefing, a plain reading of the claim language reveals that it is the claimed "*controlling*" that must "cause the telephone to dial the specific telephone number." Paper 11 at 4-10. To be clear, the separately-claimed "transferring" of the telephone number does *not* provide the claimed control by the handheld computer. To conclude otherwise would impermissibly attribute a causal relationship to the "transferring" step that the claim language expressly attributes to the separate and distinct "controlling" step. Such an interpretation would impermissibly render the "controlling" step superfluous. *Id*. at 6 (citing *Digital-Vending Services Int'l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012)).

The Board appears to have based its interpretation, in part, on the understanding that "the claim language does not reference 'commands' at all and does not preclude the same command from accomplishing the two distinct steps." Paper 30 at 10. The determinative issue here is not whether the claim language expressly references these two separate and distinct steps in the context of respective commands. Rather, Patent Owner's Response explained why the recitation of two separate and distinct "transferring" and "controlling" steps precludes reliance upon the mere transfer of a telephone number to provide the requisite *control* of the handheld computer that must "cause the telephone to dial the specific telephone number." Paper 11 at 4-10.

Keeping in mind that Petitioner has the burden of proof, Patent Owner could have simply relied on a plain reading of the claim language itself to rebut Petitioner's erroneous claim construction. Nevertheless, as further support of its position, Patent

Owner demonstrated how the remainder of the intrinsic evidence supported the construction that the recitation of two separate and distinct "transferring" and "controlling" steps precludes reliance upon the mere transfer of a telephone number to provide the requisite control that must "cause the telephone to dial the specific telephone number." *Id*.

The Board appears to have misunderstood the explanation for why cited intrinsic evidence supports Patent Owner's position and refutes the construction applied in the Petition. First, the Board acknowledges the teaching in the '671 patent that "[t]he wireless link 20 enables an application executing on PID 12 to access telephone 14, communicate the desired telephone number, and control telephone 14 to dial the number." Paper 30 at 10 (quoting Ex. 1001, 8:17-21). This passage confirms that merely communicating the desired telephone number does not itself provide the control to dial the number. Paper 11 at 6-7. Patent Owner further supported this interpretation with reference to another passage in the '671 patent specification (describing the negotiation of a control protocol). *Id*. (citing Ex. 1001, 9:7-21). This additional passage is not mentioned in the Final Written Decision.

Second, the Board acknowledges the "prosecution history passage asserting that 'the mere exchange of data as described in [a prior art reference] is separate and distinct from the claim limitation of one wireless station controlling another.'" Paper 30 at 10 (quoting Ex. 1002 at 243). This is not the only passage Patent Owner had cited from the prosecution history.

The Board opted to not address the addition statement in the prosecution history explaining how the '671 patent teaches that "the phone number to be dialed

is transferred before the receiving wireless telephone is controlled or instructed to dial the telephone number." Paper 11 at 9 (quoting Ex. 1002 at 243). The applicant further explained this requirement is made explicit by reciting the "data exchange and control elements as separate limitations" in the claims that ultimately issued. *Id*.

The Board also appears to have overlooked a cited passage from the prosecution history distinguishing certain art as teaching away from the claimed "controlling" step. Paper 11 at 8 (citing Ex. 1002 at 243-44). Specifically, the applicant successfully argued that the transmitting station in a cited reference cannot "unilaterally control a receiving wireless station" and "force" it to receive information and dial a telephone number accordingly. *Id*.

As explained in Patent Owner's Response, a holistic view of these example passages from the prosecution history confirm, consistent with the remainder of the intrinsic evidence, that there is a meaningful distinction between merely exchanging data (*e.g.*, a telephone number) and the separate and distinct "controlling" claim language. The Board appears to have overlooked or misunderstood the intrinsic evidence cited in the briefing and Patent Owner's positions addressing the same.

B. The Board appears to have overlooked or misunderstood argument and evidence responsive to the waived and erroneous application of Yun

In finding that Yun renders obvious the "transferring" and "controlling" steps, the Board bases its finding on an argument not raised in the petition. Borrowing from its analysis in related case IPR2018-00199, the Board credits an argument raised, instead, by Unified Patents concerning Yun's passing reference of a so-called "dial

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