

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.¹

Patent Owner

IPR2018-00884

PATENT 8,539,552

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

¹ The owner of this patent is Uniloc 2017 LLC.

In response to the Final Written Decision entered September 18, 2019, (Paper 20, hereinafter “Decision”) and pursuant to 37§ 42.71(d), Uniloc 2007 LLC (“Uniloc” or “Patent Owner”) hereby respectfully requests a rehearing and reconsideration by the Patent Trial and Appeal Board (“Board”) of its Final Written Decision (“FWD”) finding claims 1–17 and 23–25 of U.S. Patent No. 8,539,552 (“the ’552 patent) to be unpatentable. 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).

Claim construction is a question of law. *Markman v. Westview Instruments*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370 (1996). In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2142–46 (2016).

II. ARGUMENT

The Board misapprehended or overlooked certain intrinsic and extrinsic evidence in interpreting “a network entity ‘intercepting’ a signaling message to mean

the signaling message is received by a network entity located between the endpoints of the call.” FWD 14.

The Board stated its construction comports with the prosecution history of the ’552 patent (*id.*), yet the Board appears to have overlooked that the amendment and accompanying remarks expressly distinguish “intercepting” (as recited in the claims that issued) from merely “receiving” between endpoints. Claim 1 as originally filed recited “*receiving* signaling messages within a communication path between a sender device and an intended recipient device” *See* EX1002 p. 43 (as numbered by exhibit) (emphasis added). In the amendment dated June 24, 2011, original claim 1 was amended to require, instead, *intercepting* a message that is associated with a call between two end users. *See* EX1002 p. 357, 365.

The amendment itself confirms that “intercepting” in the context of the claim language that issued cannot reasonably be interpreted as being coextensive in scope with the original requirement of “receiving signaling messages within a communication path between a sender device and an intended recipient device.” By adopting the original claim language, word for word, as the construction for the “intercepting” limitation that issued, the Board effectively rendered the amendment a nullity—i.e., as if it had never happened. This is contrary to controlling authority.

In *Festo*,² for example, the Supreme Court explained that a patent applicant’s “decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim.” On remand from the Supreme Court’s decision, the *en banc* Federal Circuit construed the Supreme Court’s formulation of prosecution history estoppel as providing a

² *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740, (2002) (“*Festo*”).

rebuttable presumption of an absolute-bar rule. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359, 1367 (Fed. Cir. 2003); *accord*, *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1363 (Fed. Cir. 2005), and *Ajinomoto Co. v. Int'l Trade Comm'n*, 932 F.3d 1342, 1352–53 (Fed. Cir. 2019).

Here, the Board did not appear to apply the presumption that the applicant's decision to narrow claim 1 by amendment gave rise to a general disclaimer of the territory between the original claim and the amended claim. On the contrary, the Board appeared to incorrectly place the burden on Patent Owner to prove that the amendment effected claim scope. *See* FWD 14.

The Board also appears to have overlooked that, during prosecution, the applicant not only amended the claims, but also explained what was changed and why. For example, in the remarks accompanying the amendment introducing the “intercepting” term, the Applicant expressly distinguished “intercepting” in this context from the disclosure in a cited reference directed to merely *receiving* a message at a network entity. EX 1002 p. 367. The remarks by the applicant also confirm that the “intercepting” limitation is plainly distinguishable from a device sending a message directly to a network entity, such that the network entity is an intended recipient of that message. *Id.* at 367–368.

The Board also appears to have overlooked or misapprehended the “Interview Summary” provided in applicant's remarks dated June 24, 2011. *See id.* at 364–365. The applicant's “Interview Summary” confirms that certain proposed amendments were first discussed which still recited the original “receiving” term. *Id.* (referring to the “proposed amendments” as still including the word “receiving”). The examiner then proposed a *different* amendment that that, instead, used *intercepting* in place of *receiving*. *Id.* (referring to *further clarification* beyond what the applicant had originally proposed). Clearly, the examiner did not consider the words *intercepting* and *receiving* to be interchangeable and coextensive in scope. On the contrary,

according to the examiner, the proposed amendment directed to “intercepting” would overcome the art of record, though the original claim language directed to “receiving” would not. *Id.*

The Board appears to have also overlooked or misapprehended evidence in the ’552 patent expressly distinguishing between the act of *receiving* a signaling message within a communication path between a sender device and, instead, *intercepting* in the specific manner set forth in the challenged claims that issued. For example, the ’522 describes an example embodiment with reference to Figure 1. The description teaches elements 112 and 108 of Figure 1 both *receive* call set-up messages and pass them onward, but only 112 (the call control server) is identified as intercepting such messages in this embodiment. *See* Paper 14 at 4–5 (citing ’552 patent, 3:54–66). The intercepting of call control server 112 at least includes seizing a message, which is not sent directly to from a client 104 to the server 112, and obstructing the message from progress while authentication processes are performed. *Id.*; *see also* ’552 patent, 3:54–4:5. In contrast, border element 108 simply receives a message sent directly to it by a client 104 and then passively routes the message onward—i.e., no intercepting. *Id.* As another example, Patent Owner had observed that the ’552 patent expressly distinguishes the claimed invention from “just transport of the services”—i.e., from merely receiving a message and passing it onward. Paper 14 (citing Ex. 1001 at 1:41–44).

The Board also appears to have overlooked or unduly discounted extrinsic evidence of record in the form of dictionary definitions. The Oxford Dictionary defined “intercept” to mean “obstruct (someone or something) so as to prevent them from continuing to a destination.” EX2001 at ¶10 (quoting and reproducing <https://en.oxforddictionaries.com/definition/intercept>). The same dictionary definition offers a self-explanatory and well-recognized difference between intercepting and receiving in the context of the sport of football. *See id.* (further

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