UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,
Patent Owner,

Patent No. 8,213,970
Filing Date: November 26, 2008
Issue Date: July 3, 2012

Inventor: Malcolm K. Beyer, Jr.
Title: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

AGIS SOFTWARE DEVELOPMENT LLC'S REQUEST FOR REHEARING

Case No. IPR2018-01079

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TABLE OF CONTENTS

Page(s)

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I. INTRODUCTION

On November 20, 2018, the Board issued a decision instituting *inter partes* review ("IPR") of claims 1 and 3-9 (the "Challenged Claims") of U.S. Patent No. 8,213,970 (Ex. 1001, "the '970 Patent"). Paper 9 at 2. The Board determined that Petitioner satisfied the threshold for institution as to claim 1 only. Paper 9 at 36-37. For the reasons presented herein and pursuant to 37 C.F.R. § 42.71, Patent Owner respectfully requests reconsideration and denial of the petition in its entirety.

II. LEGAL STANDARD FOR REHEARING

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

> A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. 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.

When rehearing a decision on institution, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable

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judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. KUBALA DOES NOT DISCLOSE CLAIM LIMITATION 1.5

On August 23, 2018, Patent Owner filed a preliminary response (Paper 6, "POPR") arguing that Petitioner failed to meet its burden to show that Kubala discloses "said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient," as required in claim limitation 1.5. POPR at 36, 38. Patent Owner identified several overlooked reasons for this deficiency. Among the reasons, Patent Owner argued expressly that Petitioner made no attempt to combine the teachings of Kubala and the "other prior art solutions," such as "read receipts," because there is no reason or motivation to do so. POPR at 37. Patent Owner respectfully requests reconsideration of these overlooked and/or misapprehended arguments.

A. The Board Overlooked Petitioner's Failure to Allege Obviousness for Claim Limitation 1.5

Petitioner does not allege any obviousness combination to disclose "said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient

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PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient." Pet. at 30; POPR at 36-37. Rather than specify a particular element or embodiment of Kubala, Petitioner submits a two-sentence explanation based on "other prior art solutions" which bear no association to Kubala's mandatory flag 216. Pet. at 30. Petitioner does not provide any obviousness analysis to show the differences between Kubala's embodiments and the "other prior art solutions" nor does Petitioner explain how a person of ordinary skill in the art would have understood the teachings, to the extent such teachings exist, and would have modified those teachings to arrive at the claim limitation 1.5 and the claimed invention as a whole. In its findings of fact, the Board credited the Petition but relied only on an unrelated opinion from the Williams Declaration. Pet. at 31 (citing Ex. 1003 at 103). Accordingly, the Board misapprehended the Petition and associated evidence and found an obviousness combination where none existed. Moreover, the Board's conclusion that it discerned no "incompatibility" in using both flags and read receipts was not based on any evidence in either the Petition or supporting declaration. Paper 9 at 31.

As Patent Owner stated in its POPR, Petitioner failed to present any obviousness analysis to support a combination based on Kubala and the "other

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