

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00056
Patent 6,467,088 B1

Before, SALLY C. MEDLEY, MIRIAM L. QUINN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION
ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On April 29, 2019, the Board issued a Decision on Institution in this proceeding. Paper 7 (“Dec.”). In that Decision, we denied the Petition because we determined that Petitioner had not shown a reasonable likelihood of prevailing with respect to claims 1–21 (“challenged claims”) of the ’088 patent. *Id.* at 21. On May 31, 2019, Petitioner filed a Request for Rehearing. Paper 8 (Req. Reh’g). Petitioner argues two points. First Petitioner argues that the Board “equates the word ‘appropriate,’ as used in Cole,¹ with the word ‘acceptable,’ as used in the ’088 patent.” Req. Reh’g 3–10. Second, Petitioner argues that the Board misapprehended and overlooked where Pitzel² would be modified in view of Cole. *Id.* at 10–15.

According to 37 C.F.R. § 42.71(d), “[t]he burden of showing a decision should be modified lies with the party challenging the decision,” and the “request must specifically identify all matters the party believes the Board misapprehended or overlooked.” The burden here, therefore, lies with Petitioner to show we misapprehended or overlooked the matters it requests that we review.

II. ANALYSIS

Having reviewed the Request for Rehearing and the Decision on Institution, we find that Petitioner’s arguments highlight, as described below, Petitioner’s disagreement with the Board’s analysis of its contentions. That is different than pointing out an argument that we overlooked or an issue raised in which we misapprehended Petitioner’s

¹ U.S. Patent No. 5,752,042 (Ex. 1002, “Cole”).

² U.S. Patent No. 7,062,765 B1 (Ex. 1005, “Pitzel”).

position. Thus, none of Petitioner’s arguments is persuasive. We are not persuaded that Petitioner has shown that we misapprehended or overlooked the matters raised in the Request for Rehearing. We address Petitioner’s arguments in turn.

A. COLE’S ALLEGED CONFIGURATIONS

In our Decision on Institution, we stated that Cole describes selected code updates as “potentially appropriate for client 14.” Dec. 11. Based on this and further descriptions of Cole’s code selection process we determined that “neither the client nor the server anticipates that the selected code updates at this point are actually a ‘known acceptable configuration for the electronic device.’” *Id.* “The indecisive language ‘potentially’ is not the required decisive language of ‘known’—a difference that Petitioner does not explain persuasively, if at all.” *Id.* at 11–12.

Petitioner now focuses not on the “potentially” language we addressed in our Decision at page 11, but on the word “appropriate”—stating that the Board erred “in equating the words ‘acceptable’ and ‘appropriate’ . . . on page 11 of the Decision.” Req. Reh’g 6. Petitioner goes on to reiterate the arguments and characterizations of Cole as presented in the Petition and from our Decision on Institution. *Id.* at 6–9. None of these arguments and characterizations show error. Rather, they show a disagreement with the Board’s analysis of Cole and our view that the Petition did not explain persuasively the contention that something Cole describes as “potentially appropriate” would have been a “known” acceptable configuration, which is a configuration previously determined to be acceptable. *See* Dec. 8. Petitioner’s arguments do not point to error in our Decision, which did not

focus on “acceptable” configurations, but on whether the alleged acceptable configuration was “known.” Instead, we determined that based on Cole’s description of an update as “potentially” appropriate, Petitioner did not show that the configurations were “known.”

Petitioner next argues that our further analysis of Cole, as requiring an additional recognition step to identify updates that would *actually* be appropriate for the client, as supporting Petitioner’s contention. Req. Reh’g 9–10 (stating that the additional determinations of Cole are not precluded by the ’088 patent). According to Petitioner, our analysis gave the impression that the claims require some “guarantee” that the software update “will be installed.” *Id.* at 9. These arguments are not fair representations of our Decision. Again, we focused on the “known” term of the claim language. The additional recognition step in Cole is a fact confirming that Cole does not teach “known” acceptable configurations when determining whether an update is “potentially appropriate.” Petitioner on rehearing merely asks us to draw an opposite inference from the fact: that Cole’s “potentially appropriate” updates are “known” because Cole has determined beforehand that the updates would be “consistent with the basic system information of the client.” *Id.* at 7. This argument shows mere disagreement with the inference drawn from Cole’s description and our determination that the Petition lacked persuasive argument in this regard.

Petitioner now asserts that the lack of explanation should not have resulted in denial of the Petition because Cole’s additional recognition step is “irrelevant to whether Cole discloses the limitation of the claim.” *Id.* at 10 (emphasis omitted). We do not agree. We looked to the *whole* of Cole to ascertain how Cole selects updates using two distinct steps. Petitioner relied

on the first step alone, in which Cole’s selections are described as “potentially” appropriate, with little to no discussion of how those are “known” in light of the second step. Petitioner’s argument that it was proper to ignore the second step in our analysis is unpersuasive and does not show error. *See Bausch & Lomb, Inc. v. Barnes-Hind / Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986) (“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”).

B. PITZEL’S MODIFICATION IN VIEW OF COLE

In our Decision on Institution, we determined that Petitioner did not show that Pitzel alone teaches the comparison with “a list of known acceptable configurations for the electronic device.” Dec. 19. We also addressed the asserted combination of Pitzel and Cole. *Id.* at 19–20. We stated that the Petition was not clear about the combination of teachings of Pitzel and Cole, particularly with respect to what extent Cole was relied upon for the “list of known acceptable configurations,” which we found Pitzel did not teach. *Id.* We determined, nevertheless, that modifying Pitzel would not result in the claimed comparison, because “Pitzel does not compare the client condition and the requested (or missing) component with any other piece of information or list.” *Id.* at 20. We further found Petitioner’s assertions lacking in the event the Petition also relied on Cole as teaching storing Pitzel’s client conditions and components in a database table. *Id.* Our determination assessed what we could glean from the Petition as Petitioner’s contentions, but went further to determine that the Petition

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