

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,¹
Patent Owner.

IPR2018-00884
Patent 8,539,552 B1

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

¹ At the time the Petition was filed, Uniloc Luxembourg S.A. was the patent owner.

I. INTRODUCTION

On September 18, 2019, the Board issued a Final Written Decision in this proceeding. Paper 20 (“Decision” or “Final Dec.”). In the Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1–17 and 23–25 of U.S. Patent No. 8,539,552 B1 (Ex. 1001, “the ’552 patent”) were unpatentable. *Id.* at 52.

On October 17, 2019, Patent Owner, Uniloc 2017 LLC, timely filed a Request for Reconsideration of our Decision under 37 C.F.R. § 42.71(d). Paper 21 (“Request” or “Req. Reh’g”). For the reasons discussed below, we deny Patent Owner’s Request for Rehearing because Patent Owner fails to show we misapprehended or overlooked a matter in reaching the Decision.

II. LEGAL STANDARD

A request for rehearing “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). The burden of showing a decision should be modified on a request for rehearing lies with the party challenging the decision. *Id.*

III. ANALYSIS

Patent Owner argues that we erred in our interpretation of “intercepting.” Req. Reh’g 2–6. Patent Owner presents two arguments, which we address below in turn. Initially, we note that although Patent Owner argues that we erred in our interpretation of “intercepting,” Patent Owner does not explain how this alleged error impacts our determination in the Decision that claims 1–17 and 23–25 of the ’552 patent are unpatentable.

Instead, Patent Owner merely notes that our reviewing court has remanded decisions “due to conclusions based upon erroneous claim constructions.” *Id.* at 6. By failing to explain how the asserted misinterpretation of “intercepting” impacts our determination of unpatentability, Patent Owner has failed to meet its burden of showing that our Decision determining claims 1–17 and 23–25 to be unpatentable should be modified. *See* 37 C.F.R. § 42.71(d); *see also* Final Dec. 13 (“Moreover, Patent Owner fails to explain how the asserted distinction between receiving and intercepting differentiates the ’552 patent from Kalmanek. For example, it appears that Kalmanek’s network edge devices would ‘receive’ the messages and its gate controllers would ‘intercept’ the messages using Patent Owner’s interpretations.”).

A. The ’552 Patent and Its Prosecution History

First, Patent Owner argues that our interpretation is at odds with the disclosure and prosecution history of the ’552 patent. Req. Reh’g 2–5. Patent Owner argues that “the Board appears to have overlooked that the [June 24, 2011,] amendment [of claim 1] and accompanying remarks expressly distinguish ‘intercepting’ (as recited in the claims that issued) from merely ‘receiving’ between endpoints.” *Id.* at 3. According to Patent Owner, the amendment confirms that “intercepting” means something different than “receiving” and we “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.” *Id.* at 3–4. Patent Owner argues that we overlooked the applicants’ comments regarding the amendment and misapprehended the

Interview Summary. *Id.* at 4–5. Finally, Patent Owner argues that “the ’552 patent expressly distinguish[es] between the act of *receiving* a signaling message within a communication path between a sender device [sic] and, instead, *intercepting* in the specific manner set forth in the challenged claims that issued.” *Id.* at 5.

As we explained in the Decision, the amendment of claim 1 was suggested by the Examiner to express more clearly the applicants’ intention to convey that the network entity is not the intended end recipient device. Final Dec. 11–12. As we explained, our interpretation that “a network entity intercepting a signaling message associated with a call between a sender device of the message and an intended recipient device of the message” means that the network entity receives the message and the network entity is not the intended end recipient device is supported by the prosecution history:

[T]his interpretation is consistent with the prosecution history of the application resulting in the ’552 patent, which reveals that the patent examiner suggested using the word *intercepting* in the claims to further clarify the applicants’ intention to convey that “the independent claims involve a network entity *receiving* and filtering messages that are *sent between two end users*.” Ex. 1002, 364–65 (first emphasis added); *see also id.* at 367–68 (distinguishing an intermediate entity intercepting a communication between two end user devices, as claimed, from a prior art reference in which the *intended end recipient device* (a service verification apparatus) receives and makes determinations regarding the signaling message).

Id. Thus, rather than ignoring the amendment “as if it had never happened” (Req. Reh’g 3), we explained our interpretation that the Examiner suggested using “intercepting” to more clearly convey that the recited network entity is not one of the intended end user devices between which the signaling message is sent. Although Patent Owner argues that the Decision “d[oes]

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” (Req. Reh’g 4 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 740, (2002))), Patent Owner does not identify the alleged “disclaimer of the territory,” and thus fails to specifically identify how we allegedly erred. *See* 37 C.F.R. § 42.71(d).

Nor are we apprised that we misapprehended or overlooked any matter by Patent Owner’s assertions regarding the applicants’ comments about the amendment. *See* Req. Reh’g 4. Patent Owner characterizes the comments as “distinguish[ing] ‘intercepting’ in this context from the disclosure in a cited reference² directed to merely *receiving* a message at a network entity.” *Id.* This characterization is incomplete, as the reference describes a “service request [that] is sent from the service-used apparatus *directly to the service-provider apparatus*, not to some other apparatus.” Ex. 1002, 368 (emphasis added). As we explained in the Decision, the applicants “distinguish[ed] an intermediate entity intercepting a communication between two end user devices, as claimed, from a prior art reference in which the *intended end recipient device* (a service verification apparatus) receives and makes determinations regarding the signaling message.” Final Dec. 12 (citing Ex. 1002, 367–68).

Regarding the disclosure of the ’552 patent, Patent Owner argues that “[t]he intercepting of call control server 112 at least includes seizing a message, which is not sent directly . . . from a client 104 to the server 112,

² US 2003/0177363 (“Yokota”).

and obstructing the message from progress while authentication processes are performed.” Req. Reh’g 5 (citing Paper 14, 4–5 (PO Sur-Reply)). Although Patent Owner cites to its Sur-Reply, we see no argument there regarding “seizing” and “obstruction.” As this was not an argument on which Patent Owner previously relied, it was not an argument that we could have misapprehended or overlooked.

Furthermore, we explained in the Decision that the ’552 patent uses “intercepting” and “receiving” interchangeably. *See* Final Dec. 11. As we stated,

[T]he ’552 patent . . . uses [“intercepting”] interchangeably with “receiving.” *See, e.g.*, Ex. 1001 8:56–58 (“Initially, signaling and call control messages are *received or intercepted* by the policy enforcement point.” (emphasis added)); *see also id.* at 7:32–42 (explaining that the “policy enforcement point . . . is . . . *in the communications path* of substantially each and every call control and signaling message between any end-user client and any call control and signaling entity of the network 202 (including, possibly, another client device).”). We note further that the ’552 patent repeatedly states that the network entity *receives* the setup messages, further indicating interchangeability of the terms. *See, e.g.*, Ex. 1001, Abstract (“The network policy enforcement point *receives* messages, associates the message with a known service, makes a determination as to whether a beneficiary of the service is authorized to invoke the service, and then filters the messages based on the determination.” (emphasis added)), 9:28–30 (“The interface 402 [of network policy enforcement point 400] *receives* signaling messages between two network end devices and passes the messages to the processor 404.” (emphasis added)).

Id.

B. Dictionary Definitions

Second, Patent Owner argues that our interpretation of “intercepting” is at odds with certain dictionary definitions. Req. Reh’g 5–6. Patent Owner notes that its declarant cited multiple definitions of *intercept*, and argues that “[t]hese definitions of record speak for themselves in undercutting the interpretation that *intercepting* means nothing more than *receiving* between endpoints.” *Id.* Patent Owner’s arguments fail to apprise us that we misapprehended or overlooked any matter for several reasons.

Notably, Patent Owner does not cite to its Response or Sur-Reply, nor do we identify any instance where Patent Owner previously presented these arguments. As these arguments were not previously made, they are not arguments that we could have misapprehended or overlooked.

Additionally, we explained in the Decision that the testimony of Patent Owner’s declarant is entitled to little weight:

Dr. Easttom’s declaration testimony interpreting “receiving” fails to consider the full disclosure and prosecution history of the ’552 patent, as explained above, and, thus is not entitled to substantial weight. *See, e.g.* Ex. 2001 ¶¶ 8–9; *see also* PO Resp. 6 (citing same). Additionally, Patent Owner hindered or prevented Petitioner from cross-examining Dr. Easttom, further undermining the weight given to Dr. Easttom’s testimony. *See, e.g.*, Pet. Reply 2–6; Exs. 1011–24.

Final Dec. 12 n.9.

Notwithstanding this fact, we considered the testimony of Patent Owner’s declarant regarding the dictionary definitions noted by Patent Owner in its Request and explained why the testimony was not persuasive of patentability:

[W]e noted in the Institution Decision that Patent Owner’s declarant opined that “[a]ll the definitions I found, both in

standard dictionaries and in engineering and telecommunications dictionaries[,] all define intercepting as someone other than the intended recipient *getting* the message.” Inst. Dec. 8 (emphasis added, alterations in original) (citing Ex. 2001 ¶ 15). We fail to see, and Patent Owner fails to explain, a distinction between a network entity, positioned intermediate the sender device and the intended end recipient device, “receiving” the message and “getting” the message, as both parties’ interpretations indicate that the message is read by an entity other than the intended end recipient device of the message.

Final Dec. 12–13 (footnote omitted). Patent Owner’s Request similarly fails to identify any such distinction.

C. Patent Owner’s Proposed Construction

We noted in the Decision that “Patent Owner argues that ‘intercepted’ means ‘the communicat[ion]s *pass[] through* (and are read) by the policy enforcement point.’” Final Dec. 10 (alterations in original) (citing PO Resp. 5). This is precisely how we interpreted the term: “a network entity ‘intercepting’ a signaling message . . . mean[s] the signaling message is received by a network entity located between the endpoints of the call.” *Id.* at 14. Both interpretations indicate that the message is read by an entity other than the intended end recipient device of the message.

IV. CONCLUSION

For the reasons discussed above, we deny Patent Owner’s Request for Rehearing because we determine that Patent Owner has not met its burden to show that in the Final Written Decision, the panel misapprehended or overlooked any matter.

Outcome of Decision on Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)	Denied	Granted
1–4, 6–10, 12–20, 22, 23	103(a)	Kalmanek	1–4, 6–10, 12–20, 22, 23	
5, 11	103(a)	Kalmanek, Shaffer	5, 11	
21, 24, 25	103(a)	Kalmanek, Strathmeyer	21, 24, 25	
17	103(a)	Kalmanek, Gleichauf	17	
Overall Outcome			1–25	

Final Outcome of Final Written Decision after Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–4, 6–10, 12–20, 22, 23	103(a)	Kalmanek	1–4, 6–10, 12–17, 23	18–20, 22
5, 11	103(a)	Kalmanek, Shaffer	5, 11	
21, 24, 25	103(a)	Kalmanek, Strathmeyer	24, 25	21
17	103(a)	Kalmanek, Gleichauf	17	
Overall Outcome			1–17, 23–25	18–22

V. ORDER

It is ORDERED that Patent Owner’s Request for Rehearing is *denied*.

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