

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., and WHATSAPP, INC., LG ELECTRONICS, INC.,
and HUAWEI DEVICE CO., LTD.,¹
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01428
Patent 8,995,433 B2

Before, JENNIFER S. BISK, MIRIAM L. QUINN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

¹ LG Electronics, Inc. and Huawei Device Co., Ltd., filed a Petition and Motion for Joinder in IPR2017-02088, which we granted, and therefore, they have been joined to IPR2017-01428.

I. INTRODUCTION

On November 30, 2018, the Board issued a consolidated Final Written Decision in this proceeding and in IPR2017-01427. Paper 40 (“Final Dec.”). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1–12, 14–17, 25, and 26 are unpatentable. *Id.* at 97; *but see id.* at 4 (identifying the challenged claims in IPR2017-01428 as claims 9–12, 14–17, 25, and 26 of the ’433 patent). On December 30, 2018, Patent Owner filed a Request for Rehearing. Paper 41 (Req. Reh’g). Patent Owner argues that we engaged in *sua sponte* claim construction and analysis in construing the term “attaches,” recited in claim 9, and in determining that the prior art teaches the limitation under the Board’s construction. Req. Reh’g 3–5. Patent Owner requests that we reconsider the Final Written Decision in view of Patent Owner’s argument that the Board did not rely on arguments presented and did not invite any briefing on the meaning of “attaches.” *Id.* at 4–5.

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 Patent Owner to show we misapprehended or overlooked the matters it requests that we review.

II. ANALYSIS

Patent Owner acknowledges that it had an opportunity to brief the claim construction of “instant voice message,” as that claim term is recited in claim 9 of the ’433 patent. Req. Reh’g 4. Patent Owner faults us, however, for determining the scope of the phrase “attaches one or more files

to the instant voice message” (recited in claim 9). Patent Owner’s arguments do not show that we misapprehended or overlooked the issues raised in the Request for Rehearing.

First, the Decision on Institution in this proceeding noted that the issue of claim scope was raised in connection with Patent Owner’s arguments of attaching one or more files to an “instant voice message.” Paper 8, 11–12. Similarly, in our Final Written Decision we noted that simply construing “instant voice message,” without more, does not resolve the dispute of the parties because Patent Owner raised arguments distinguishing the prior art on the basis of “attaching” a file to the data content itself. Final Dec. 18. The Board construes terms that resolve the dispute of the parties, and “attaches” was one of those terms. *Id.*; *see Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

Patent Owner, therefore, had notice of the issues needed to be resolved based on its own arguments distinguishing the prior art. More significantly, the Petition gave Patent Owner notice of Petitioner’s interpretation of the term “attach” as “associate,” and Patent Owner included argument regarding “attachments” in its Supplemental Brief on claim construction, which we considered. *See* Final Dec. 20–21 (citing PO Supplemental Br. 5, Paper 36 in IPR2017-01427); *see also, e.g.*, Paper 39 in IPR2017-01428 (arguing that files must be attached to the content that is transferred or to an audio file, but not to the data structure). Thus, Patent Owner had an opportunity to refine its position on “attachment” in its Patent

Owner Response, to respond to Petitioner's assertions that "attach" means "associate," and to expand on its position in its Supplemental Brief on claim construction, in which Patent Owner continued its arguments that the prior art did not disclose the required "attachment." To be sure, and we acknowledge, Patent Owner focused much of its arguments on the term "instant voice message." However, once we resolved the scope of that term, the dispute as to the "attaches" limitation was not resolved, especially in light of Patent Owner's arguments attempting to distinguish the prior art based on that limitation.

Second, we are not persuaded by Patent Owner's argument that other Decisions on Institution of the Board in related patents agreed with Patent Owner's narrow characterization of the "attaches" limitation. Req. Reh'g 2–3. Those Decisions on Institution are not binding or relevant to this proceeding. In the Decision on Institution *here*, the Board did not agree with Patent Owner's characterization of the "attaches" limitation; nor did the Board agree with Patent Owner's view on the scope of "instant voice message." Paper 8, 11–12. In any event, even if we had agreed with Patent Owner in the past on other similarly worded claims in related patents, the Board "is not bound by any findings made in its Institution Decision." *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016). After reviewing the fully developed record here, the panel addressed the scope of the "attaches" limitation, including the nuances of the term "instant voice message," and disagreed with Patent Owner's view of the "attaches" limitation. Final Dec. 18 ("This determination, however, does not resolve all the disputes surrounding the term because Patent Owner also argues that attaching files to an 'instant voice message' must be limited to attachments

to the data content itself.”); 74 (stating that Petitioner describes “attachment” as “associating” in referring to Zydney’s Figure 6, and in connection with Figures 16 and 17).

Third, regarding Patent Owner’s argument that we *sua sponte* engaged in an analysis where Petitioner did not present the arguments considered, we do not agree that we have not followed the holding in *In re Magnum Oil Tools Int’l*, 829 F.3d 1364 (Fed. Cir. 2016). Req. Reh’g 4. We relied on Petitioner’s assertion that “attachment” means “associating,” and, accordingly, we, in rendering the Final Written Decision, did not consider argument that was not presented.

Finally, Patent Owner’s request for rehearing fails to show that we misapprehended or overlooked any of Patent Owner’s evidence or arguments or that our construction for the term “attaches” is incorrect in any way and requires reconsideration and correction. In sum, we do not agree with Patent Owner’s contention that our construction of the “attaches” limitation is improper or that Patent Owner did not have an opportunity to brief the issue in light of the developed record.

III. ORDER

Patent Owner’s Request for Rehearing is *denied*.

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