

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioners

v.

UNILOC LUXEMBOURG S.A.  
Patent Owner

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Case IPR2017-00058  
Patent 7,804,948 B2

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

In response to the Final Written Decision entered April 6, 2018, (Paper 17, hereinafter “Decision”) and pursuant to 37 CFR § 42.71(d), Uniloc Luxembourg S.A. (“Patent Owner”) hereby respectfully requests a rehearing and reconsideration by the Patent Trial and Appeal Board (“Board”) of its Final Decision finding unpatentable Claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66. 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 the fact that the relied upon obviousness combination includes a selection process that was unambiguously disclaimed during prosecution.<sup>1</sup> More specifically, the relied upon *Hamberg* references uses the exact same selection process employed by the *Haim* reference applied during prosecution. During prosecution of the application that issued as the '948 Patent, Applicant successfully distinguished the *Haims* reference, at least in part, with the following remarks (which the Office ultimately found to be persuasive) concerning such selection:

Haims neither teaches nor even suggests such a methodology. Rather, Haims proposes that a user determine whether attendees are available and select ones for invitation. See, e.g., pars. [0110] and [0111]. In contrast, Claim 1 calls for the system to automatically establish a conference call with a plurality of users who are then participating in a common IM session with the requester responsively to a single requester request.

EX1002 at 80-81 (emphasis added). Thus, the intrinsic evidence unambiguously confirms, consistent with the explicit claim language, that there is a patentable

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<sup>1</sup> This disclaimed selection process arose in Claim 1's "generating a conference call request responsively to a single request by the conference call requester, said conference call request identifying each of the potential targets for said conference call request" and likewise in Claim 23's "generating a conference call request by said conference call requester in a single step, said conference call request identifying each of the potential targets" and Claim 51's "generating a conference call request by the call requester responsively to a single requester indication."

distinction between “a single request by the conference call requester” and, instead, requiring the requester to select which attendees to invite to join a conference call.

Nothing in the prosecution history suggests that the distinction successfully raised by the Applicant depends on *how* the user must select the attendees. Applicant made no mention of the particular *way* in which multiple attendee selection occurs because that was not the point of distinction over *Haims*. Rather, the patentable distinction successfully raised during prosecution is simply that *Haims* required the conference call requester to *select* the attendees for invitation (i.e., regardless how the selection occurs). Accordingly, to determine whether the distinction successfully raised during prosecution applies equally here, the operative question is not *how* the user in a cited reference must select the conference call attendees, but rather *whether* the user must make such a *selection*.

Just like *Haim*, the relied-up *Hamberg* requires a selection in its CALL ALIAS processing (typing the word “CALL” followed by certain alias names and then pressing enter). It is undisputed that *Hamberg* teaches the purpose for its CALL ALIAS message is to enable a user to selectively define whom to include/exclude in a conference call. Because this selection process was disclaimed during prosecution, *Hamberg* teaches away from the claims.

In attempts to side-step *Hamberg*'s contrary teachings, Petitioner parsed the *Hamberg* and *Lamb* references to select certain teachings while disregarding others. This is impermissible. “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.” *Bausch & Lomb, Inc. v. Barnes-Hind / Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986)). Petitioner argued that one may simply take a button interface with regards to the *Lamb* (without regard to a lack of teaching as to the details concerning what happens when one clicks that button) and combine it with *Hamberg* processing, ignoring the fact that *Hamberg* uses a selection process to initiate such processing.

Moreover, any proposal that an artisan could program in a manner that is contrary to teachings further violates controlling authority. As held by the Federal Circuit, to render an invention obvious, an artisan would have to immediately envision the claimed combination. *See Microsoft Corp v. Biscotti, Inc.* Nos. 2016-2080, 2016-2082, 2016-2083, (Fed. Cir. Dec. 28, 2017) (Before Newman, O’Malley, and Reyna, J.) (Opinion for the court, O’Malley, J.) (Dissenting opinion, Newman, J.).<sup>2</sup> Here, even after reading the Petition, an artisan still does not know what the alleged combination looks like.

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<sup>2</sup> <https://www.cafc.uscourts.gov/cases/2016-2080-Opinion-12-27-2017-1.PDF>

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