

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS INC.,
Petitioner,

v.

UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2017-00058
Patent 7,804,948 B2

Before KARL D. EASTHOM, KEN B. BARRETT, and
JEFFREY S. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner, Uniloc Luxembourg S.A., filed a Request for Rehearing (Paper 18, “Req. Reh’g”) of our Final Written Decision (“FWD”) dated April 6, 2018, which held that claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66 of US Patent No. 7,804,948 B2 (Ex. 1001, “the ’948 patent”) are unpatentable.

In its Request, Patent Owner argues that the FWD misapprehends the significance of the prosecution history when considering the teachings of Haims. Req. Reh’g 3–5 (citing Ex. 1002, 80–81).

For the reasons set forth below, Patent Owner’s Request for Rehearing is denied.

II. STANDARD OF REVIEW

Section 37 C.F.R. § 42.71(d) states the following:

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.

III. DISCUSSION

Patent Owner, citing to the prosecution history of the ’948 patent (Ex. 1002), contends that the FWD misapprehended that Patent Owner unambiguously disclaimed a selection process disclosed by Haims during prosecution, and that Hamberg (Ex. 1005) uses the exact same selection process disclosed by Haims. Req. Reh’g 3. Patent Owner’s challenge does not meet the standard set forth for a Request for Rehearing, which requires a party to “identify . . . the place where each matter was previously addressed

in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). As Patent Owner did not address this issue in a motion, an opposition, or a reply, the Board could not have misapprehended Patent Owner’s argument.

Even if we consider Patent Owner’s contention that Patent Owner disclaimed the selection process disclosed by Haims, we find this contention unpersuasive. “[T]he PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner.” *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 978 (Fed. Cir. 2014). Assuming *arguendo* that the doctrine of prosecution history disclaimer applies to this *inter partes* review, the purported disavowal of claim scope must be unambiguous, clear, and unmistakable to one of ordinary skill in the art. *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007) (citations omitted). On the record before us, we conclude that the prosecution history does not evidence such an unambiguous, clear, and unmistakable disavowal.

We read the cited portion of the prosecution history as presenting arguments to the Examiner to distinguish the claim from Haims based on the claim’s recited limitations. At most, the applicant’s arguments in the prosecution history merely shed light on the claim limitations that applicant thought were not taught by Haims. We determine that one of ordinary skill in the art would not have understand the applicant to have made a clear and unmistakable disavowal of any subject matter beyond that already reflected in the language of the claim, which we considered in evaluating Petitioner’s challenges. In light of this, we are not persuaded that we misapprehended or overlooked the significance of the prosecution history.

As Patent Owner recognizes, Petitioner relies on a combination of Hamberg and Lamb. *See* Reh’g Req. 3–4.¹ Therefore, Patent Owner’s allegation that Haims teaches the same selection process as Hamberg, even if true, improperly shifts focus from the combination of Hamberg and Lamb.

Patent Owner alleges Petitioner does not provide proper motivation to combine Hamberg and Lamb. Reh’g Req. 3–4 (arguing “Petitioner parsed” and “Petitioner argued”). These allegations fail to address what the FWD overlooks or misapprehends. In any event, the FWD addresses motivation and the combination. *See, e.g.*, FWD 23–34.

Contrary to Patent Owner’s related arguments (*id.* at 2), Hamberg does not teach away from the claims. The FWD also address this argument. FWD 27–30. Patent Owner’s rehearing request fails to allege what the FWD overlooks with respect to teaching away.

IV. CONCLUSION

For the foregoing reasons, Patent Owner did not show that the Board misapprehended or overlooked any arguments or evidence presented by Patent Owner in determining that claims 1, 3–6, 8–11, and 13–15 of US Patent No. 7,804,948 B2 (Ex. 1001, “the ’948 patent”) are unpatentable.

V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is denied.

¹ We refer to pages starting after the header page. The Rehearing Request improperly numbers the first page “2” and all the other pages “1.”

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