

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., FACEBOOK, INC., and WHATSAPP, INC.,¹
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-00222
Patent 8,243,723 B2

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

QUINN, *Administrative Patent Judge*.

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

¹ Facebook, Inc. and WhatsApp, Inc. filed a petition and motion for joinder in IPR2017-01635, which we granted, and, thus, these entities are joined, as Petitioner, to this proceeding. Paper 12.

I. INTRODUCTION

On May 23, 2018, the Board issued the Final Written Decision in this proceeding. Paper 29 (“Final Dec.”). On June 22, 2018, Petitioner filed a Request for Rehearing. Paper 30 (Req. Reh’g.). Petitioner makes two arguments: (1) that the Board misapprehended Malik in connection with the determination that Petitioner did not show claim 3 is unpatentable; and (2) that the Board misapprehended the scope of claim 3. *Id.*

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

Petitioner’s arguments hinge on a claim construction issue pertaining to claim 3, which is reproduced below.

3. The method for instant voice messaging over a packet switch network according to claim 1, further comprising the step of:
 - controlling a method of generating the instant voice message based upon the connectivity status of said one or more recipient.

Ex. 1001, 24:21–26.

In our Final Written Decision, we determined that neither Vuori nor Malik teaches the controlling step recited in claim 3 as argued by Petitioner. Final Dec. 38–40. Petitioner disagrees with that determination. Req. Reh’g. 2–5. Petitioner argues that Malik first detects if a recipient is not available

and second “controls . . . the method for how the voice message is generated based on that detection.” *Id.* at 4 (citing Ex. 1019, Fig. 4). According to Petitioner, pages 23–24 of the Petition include this argument that we allegedly misapprehended or overlooked.

We have reviewed the Petition again in light of Petitioner’s arguments. And we disagree that we overlooked or misapprehended the argument or that we misapprehended Malik’s disclosures. The Petition cites the Forys Declaration (Ex. 1003) at paragraphs 157–160, and relies on Malik’s disclosures at paragraphs 8, 32, and 33, for the limitation at issue. We reviewed and specifically pointed out why none of the cited passages of Malik and the Forys Declaration persuade us that Malik discloses the limitation. Final Dec. 39–40. In short, we determined that Malik’s recording of the voice message (recited “generating”), described in paragraph 33, occurs once the sender is authorized to send a voice message. *Id.* at 39. We found no particular control of the method of Malik’s recording based upon connectivity status because the sender will record the voice message regardless of whether the recipient is available or not. *Id.* at 39–40 (citing Ex. 1019 ¶¶ 8, 32–35). We are not persuaded that these findings were incorrect. Thus, we view Petitioner’s challenge of the Board’s decision as a mere disagreement with our reading of Malik, which differs from Petitioner’s characterization of the reference.

Second, Petitioner focuses on the further explanation of our reasoning that faults Petitioner’s evidence of how Malik controls the generating of the voice message. *Id.* at 40. In short, we determined that Petitioner failed to show evidence that Malik’s recording in any way depends on connectivity status because Malik’s description of the recording is always in the same

mode—recording mode. *Id.* The only control exercised in Malik is determining whether the already recorded message is delivered immediately (if the recipient is available) or at a later time (when the recipient is detected to be online). Petitioner’s Request for Rehearing characterizes our explanation as misapprehending the claim scope of claim 3. Req. Reh’g. 5. We do not agree with Petitioner that we misapprehended the scope of claim 3. Claim 3 plainly requires “controlling a method of generating . . . based upon the connectivity status of . . . [the] recipient.” We found that Malik performs the method of generating the voice message in the same manner (same method) regardless of the connectivity status. Thus, our finding that Malik performs only the recording mode shows that there is no control of the recording of the voice message or the recited “generating the instant voice message.”

Accordingly, we are not persuaded that we misapprehended or overlooked the matters Petitioner raises in the Request for Rehearing.

III. ORDER

Petitioner’s Request for Rehearing is *denied*.

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