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Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BITDEFENDER INC.,
Petitioner,

v.

UNILOC USA, INC.,
Patent Owner.

Case IPR2017-01315
Patent 6,510,466 B1

Before MIRIAM L. QUINN, ROBERT J. WEINSCHENK, and JESSICA C. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

BitDefender Inc. ("Petitioner") seeks rehearing (Paper 9, "Request" or "Req. Reh'g") of our determination in the Decision on Institution (Paper 7, "Decision" or "Dec.") not to institute an *inter partes* review of claims 15–17, 22–24, 30, and 35–37 of U.S. Patent No. 6,510,466 B1 (Ex. 1001, the "'466 patent"). We have considered Petitioner's Request, but for reasons that follow, we decline to modify our Decision.

II. LEGAL STANDARD

37 C.F.R § 42.71(d) provides: "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." In addition, "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c).

III. DISCUSSION

Petitioner contends our Decision "misapprehended the relationship between the holding in *In re Katz* and the 'means for installing' limitations of claims 15 and 16." Req. Reh'g 1. Petitioner further contends in identifying corresponding structure for the "means for installing" limitations, our Decision overlooked that the '466 patent distinguishes between installing and distributing. *Id.* Thus, Petitioner contends that "means for installing" falls within the *Katz* exception, and if it does not, the '466 patent

specification contains no structure corresponding to that limitation." *Id.* at 1–2. For reasons that follow, we decline to modify our Decision.

In the Petition, Petitioner argued that "means for installing" fell within the exception in *Katz*, such that a general purpose computer by itself could be the corresponding structure for that limitation. Pet. 19–20, 31. We fully considered this argument in our Decision and determined that Petitioner had not adequately shown "installing a plurality of application programs at the server," as recited in the '466 patent claims, falls within the *Katz* exception. *See* Dec. 10–11.

As we noted in our Decision (Dec. 11), the Federal Circuit has characterized the exception in *Katz* as a "narrow" one, in which "a microprocessor can serve as structure for a computer-implemented function only where the claimed function is 'coextensive' with a microprocessor itself" (i.e., where the claimed function is a "basic function[] of a microprocessor"). *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 621–22 (Fed. Cir. 2015). In its Request, Petitioner contends that contrary to a statement in our Decision (Dec. 11), it provided "evidence and factually-supported explanation for the argument that 'installing a plurality of application programs' in the context of the '466 patent is a basic function of a microprocessor." Req. Reh'g 6. In particular, Petitioner contends "[t]he Petition pointed out that the '466 Examiner interpreted installing as storing, and storing is a basic function squarely within the *In re Katz* exception." *Id.; see also id.* at 11 (stating that "storing is a basic function that comes squarely within the *In re Katz* exception" and arguing that the functions in other cases cited in our Decision were "complex"). Petitioner further contends it "pointed to specification passages that distinguish

installing from registering/configuring, and at least some of the cited passages also expressly distinguish installing from distributing." *Id.* at 6.

We did not overlook any arguments in the Petition. Specifically, the Petition cited two office actions as showing "[i]nstalling was interpreted during the prosecution of the '466 patent, under the BRI standard, as storing, an interpretation that was not contested by the patent applicant." Pet. 18 (citing Ex. 1002 (File History) Office Action mailed 08/13/2001 at 2, Office Action mailed 2/22/2002 at 2). In each of those office actions, the Examiner mapped a reference's teachings to the claim language in an obviousness rejection and applied "installing (storing)" as part of that rejection. Ex. 1002 (File History) Office Action mailed Aug. 13, 2001, at 2; Office Action mailed Feb. 22, 2002, at 2. In these Office Actions, the Examiner did not engage in detailed claim construction analysis of "installing" or determine that such "installing" was a basic function of a microprocessor. Thus citing to these Office Actions in the Petition did not provide evidence or factually-supported explanation to support Petitioner's argument that "installing" in the context of the '466 patent claims is a basic function of a microprocessor.[1]

[1] We note that in discussing prior systems, the '466 patent suggests that installing encompasses more than mere storing of data: "To the extent software distribution capabilities from a central location are provided, such as with the TME 10TM system, they typically require *various steps in the installation process* to occur at different locations rather than allowing *the entire process* to be controlled from a single point for an entire managed network environment." Ex. 1001, 3:31–36 (emphasis added). As shown in the quotation above, the '466 patent contemplates that installation is a process requiring multiple steps.

We further observe that although Petitioner contends in its Petition installing does not include configuring (registering), it did not contend that installing does not include distributing. *See* Pet. 18. We are not persuaded that we overlooked any argument or evidence showing that the recited "installing a plurality of application programs at the server" is a basic function of a microprocessor. Accordingly, we determine we did not abuse our discretion in declining to adopt Petitioner's proposed corresponding structure.

The remainder of Petitioner's arguments on rehearing are devoted to contending the corresponding structure we identified in our Decision from among those proposed by the Patent Owner is incorrect. Req. Reh'g 6–11. We need not address these arguments because even if correct, they would not change the outcome of our Decision as to these claims. In particular, if Petitioner is correct that none of Patent Owner's proposed corresponding structure is clearly linked to the claimed function, then we would be left with no corresponding structure identified by either party. In the absence of corresponding structure, we are not free to treat the "means for installing" limitations as if they were purely functional limitations. *See IPCom GmbH & Co. v. HTC Corp.*, 861 F.3d 1362, 1371 (Fed. Cir. 2017), as corrected (Aug. 21, 2017). Thus, even if Petitioner is correct that none of Patent Owner's proposed corresponding structure is proper, we would still deny institution of claims 15–17, 22–24, 30, and 35–37.

IV.CONCLUSION

Having considered Petitioner's Request, Petitioner has not persuaded us, for the reasons discussed, that our Decision should be modified.

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