UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Google, LLC,
Petitioner

v.

UNILOC 2017 LLC,
Patent Owner

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Case IPR2017-01685
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 July 14, 2019, (Paper 24) and pursuant to 37 CFR § 42.71(d), Patent Owner hereby respectfully requests a rehearing and reconsideration by the Patent Trial and Appeal Board ("Board") of its Final Decision. 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). An unequivocal disclaimer invokes prosecution history estoppel, which "requires that patent claims be interpreted in light of the proceedings before the Patent and

Trademark Office (PTO)." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 723 (2002).

II.   ARGUMENT

1. The Board erred in when it failed to find explicit claim language precluding a user from identifying and selecting call participants.

Claim 1 expressly requires "generating a conference call request responsively to a <u>single request</u>" by the user. *See* Ex. 1001, 25 (12:8-19) (emphasis added); PO Resp. 12-16. Patent Owner respectfully submits that the Board misconstrued the plain meaning of Claim 1 when it "fail[ed] to discern any explicit claim language that precludes the user's determination as to availability or the selection of call participants as part of or as a prelude to [the] recited 'single request.'" *See* Paper 24 at 11.   Claim 1 states, in relevant part:

> generating a conference call request responsively to a single request by the conference call requester, said conference call request <u>identifying each of the potential targets</u> for said conference call request;
>
> transmitting said conference call request from said network access device to said conference call server; and
>
> automatically establishing a conference call connection to said conference call requester, said conference call connection initiated by said conference call server, said conference call connection further being connected to <u>each of the potential targets</u>.

Ex. 1001, 11:58–12:17 (emphasis added).

Claim 1 plainly states that the "potential targets" are *identified* by the "conference call request," not the "single request" to which the "conference call request" is responsive. *Id.* 12:8-10 ("said conference call request identifying each of the potential targets"). Petitioner and the Board argue that perhaps the user identifies the "potential targets" as a "prelude" to making the recited "single request." But a "prelude" or "preliminary selection" of potential targets by the user before making the "single request" would be, under plain and ordinary construction, an additional request. *See* PO Resp. 13. Petitioner's erroneous construction is not helped by calling this additional request a "prelude." *See id.* It is similarly unavailing to describe selecting targets as "part of" a single request, as a request divided into multiple "parts" is not a single request.

Claim 1 likewise plainly states that the connection to the "potential targets" is automatically established by "said conference call server" in response to the "conference call request," not the "single request" to which the "conference call request" is responsive. Ex. 1001, 12:8-17.

The prosecution history confirms the plain and ordinary meaning of "single request." In distinguishing Haims, the applicant argued "Haims neither teaches nor even suggests" the automatic conference call methodology

described by Claim 1:

> 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*.

Ex. 1018, 124-25 (emphasis added).

In Final Written Decision, the Board noted that during prosecution the applicant amended the "presenting," "generating," and "establishing" limitations "and emphasized *all* those limitations in arguing against rejection." Paper 25 at 18 (emphasis added). The Board erred, however, by (1) suggesting the "establishing" limitation was the sole "subject of the sentence" distinguishing[1] Haims and (2) concluding the applicant directed its prosecution argument distinguishing Haims not at the "generating" limitation but to a different limitation. *See id* at 18-19.

Contrary to the Board's conclusion (and as recognized by the Board elsewhere), the applicant distinguished Claim 1 over Haims "due to the

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[1] Patent Owner does not argue the negative limitation prohibiting the user from identifying and selecting potential targets is absent from the explicit language of Claim 1 and is only found in prosecution history disclaimer. Rather, the plain language of Claim 1 makes it clear that the user makes only a "single request," not multiple requests consisting of selecting targets and submitting a request. The prosecution history confirms this plain reading of Claim 1. Alternatively, the prosecution history is an unambiguous, clear, and unmistakable disclaimer of the embodiment urged by Petitioner.

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