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[1],
Patent Owner.

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Case IPR2017-01685
Patent 7,804,948 B2

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Before KEN B. BARRETT, JEFFREY S. SMITH, and
MINN CHUNG, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

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[1] Patent Owner's Mandatory Notice filed on July 20, 2017, identified Uniloc Luxembourg S.A. as the Patent Owner. Paper 5. More recently, Patent Owner filed an Updated Mandatory Notice identifying Uniloc 2017 LLC as the Patent Owner. Paper 17.

I.   INTRODUCTION

Uniloc 2017 LLC ("Patent Owner") filed a Request for Rehearing (Paper 25, "Request" or "Req. Reh'g") of our determination in the Final Written Decision (Paper 25, "Decision" or "Dec.") that Petitioner had demonstrated by a preponderance of the evidence that claims 1–4, 6–8, 18, 21, and 22 of U.S. Patent No. 7,804,948 B2 (Ex. 1001, "the '948 patent") are unpatentable. Specifically, Patent Owner contends that we erred in our construction of independent claim 1. For the reasons provided below, Patent Owner's Request for Rehearing is *denied*.

II.   ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified. 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.*

In the Decision, we declined to adopt Patent Owner's proposed claim construction involving the inclusion of a negative limitation. We concluded that there was insufficient evidence "that the claim language or a prosecution history disclaimer requires a negative limitation that precludes the requester from determining attendee availability and manually selecting attendees for invitation to the conference call." Dec. 21. Patent Owner contends that we erred in failing to find this negative limitation in the explicit language of the claim or in a purported prosecution history disclaimer. Req. Reh'g 3, 8.

Patent Owner's contentions are directed to the "generating" step of claim 1, which recites:

> 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.

Ex. 1001, 12:7–10. As we noted in the Decision, this claim phrase involves two separate requests: 1) a "single request" by the conference call requester, and 2) a "conference call request" generated responsively to that single request. Dec. 10.

In its Response (Paper 13, "PO Resp."), Patent Owner argued that "the intrinsic evidence unambiguously confirms, consistent with *the explicit claim language*, that there is a patentable 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." PO Resp. 13, 14–15. In addressing this argument, we stated:

> While the claim language does contain a recitation of a "single request" by the user to generate a conference call request, we fail 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 that recited "single request." In other words, the language of claim 1 does not contain the negative limitation proposed by Patent Owner.

Dec. 11. Patent Owner argues in its Request for Rehearing that, because we were unable to discern a negative limitation explicitly set forth in the claim language, we "misconstrued the plain meaning of Claim 1." Req. Reh'g 3. After having considered Patent Owner's arguments in the Request, we still are unable to discern explicit claim language defining the negative limitation.

Patent Owner first argues that "[c]laim 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.*
at 4 (citing Ex. 1001, 12:8–10). Thus, Patent Owner appears to argue now
that the claim's recitation of the "conference call request identifying each of
the indicated potential targets" precludes an identifying action at any other
time performed by any other actor. *See id.* Patent Owner does not indicate
where this argument was made previously, and thus has not shown that we
misapprehended or overlooked this argument. *See id.* (citing the '948 patent
(Ex. 1001) rather than a brief). Further, Patent Owner does not explain
adequately why the open-ended claim (utilizing the transitional phrase
"comprising") excludes another step involving the act of identifying.

Patent Owner next argues that "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." *Id.* (citing PO
Resp. 13). It is not clear that Patent Owner previously made this argument
concerning the purported plain and ordinary language of "single request."
At most, Patent Owner's argument on the cited page of its Response appears
to be based on prosecution history disclaimer, not the plain language of the
claim. *See* PO Resp. 13 (citing, as support for the argument that certain
subject matter is outside the scope of the claim, Exhibit 1018, which is the
prosecution file history for the '948 patent). We could not have
misapprehended or overlooked a "plain and ordinary construction" argument
not made. Additionally, Patent Owner does not now elaborate on or provide
evidence to support the conclusory and implied argument that a "preliminary
selection . . . before making the single request" would be considered by a
person of ordinary skill in the art to be an additional request. Req. Reh'g 4
(internal quotation marks omitted).

Patent Owner next argues, again without any indication whether or where the argument was previously made, that "[c]laim 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." *Id.* at 4–5 (citing Ex. 1001 (the '948 patent), 12:8–17). Although the referenced claim recitation ties the establishment of the conference call connection to the conference call request, the recitation does not speak to the "single request" from which that conference call request is generated. Patent Owner does not explain adequately why the downstream "establish[ing]" act justifies the incorporation of a negative limitation into an earlier "single request."

Patent Owner next argues that "[t]he prosecution history confirms the plain and ordinary meaning of 'single request.'" *Id.* at 4. In this regard, Patent Owner contends that arguments made during prosecution serve as a disclaimer of claim scope such that the purported negative limitation must be present in the language of the claim. *See id.* at 7[2]. In the Decision, we considered and did not find persuasive Patent Owner's arguments regarding

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[2] As we indicated in the Decision, Patent Owner's argument appears to be internally inconsistent because, "if Patent Owner's proposed negative limitation is set forth explicitly in the claim language, as Patent Owner suggests, there would be no need for Patent Owner to argue that there is a reduction in scope due to a disclaimer." Dec. 11 (citing *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013) ("[W]hen the patentee unequivocally and unambiguously disavows a certain meaning to obtain a patent, the doctrine of prosecution history disclaimer narrows the meaning of the claim [relative to the full ordinary and customary meaning] consistent with the scope of the claim surrendered.")).

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