

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01801
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge*.

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

I. INTRODUCTION

On January 31, 2019, the Board issued a Final Written Decision in this proceeding. Paper 31 (“Final Dec.”). In that Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1–5, 7–12, 14–17, 25, and 26 of the ’433 patent are unpatentable. *Id.* at 90. On March 4, 2019, Patent Owner filed a Request for Rehearing. Paper 32 (Req. Reh’g). Patent Owner argues one point. Patent Owner takes issue with our findings concerning the recited “instant voice message,” and more particularly with respect to the “attaches” limitation that is recited in claim 9.

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 Patent Owner to show we misapprehended or overlooked the matters it requests that we review. We are not persuaded that Patent Owner has shown that we misapprehended or overlooked the matters raised in the Request for Rehearing. We address each of Patent Owner’s arguments in turn.

II. ANALYSIS

Claim 9 recites “wherein the instant voice messaging application attaches one or more files to the instant voice message.” We determined that the term “instant voice message” refers to a voice message that is transmitted in real time and received accordingly, when the recipient is available. Final Dec. 12. Also, we construed the term “attaches . . . to the instant voice message” to mean indicating that another file (or files) is associated with the “instant voice message.” *Id.* at 16.

For claim 9, we found that although Griffin did not *explicitly* describe attaching a file to a *speech* chat message, Griffin’s explanation of Figure 4 teaches or suggests to a person of ordinary skill in the art that a speech chat message would also have the attachment capability. *Id.* at 68. We agreed with Petitioner’s contention and evidence that Griffin expressly disclosed attaching a file to a *text* message. *Id.* at 67–68. Therefore, our statement that Griffin did not *explicitly* describe the attachment was intended simply to highlight that Griffin expressly disclosed attachment to a *text* message but was not as explicit in disclosing the same with regard to the *speech* chat message. Patent Owner characterizes this as a “concession” that Griffin does not teach the limitation. Req. Reh’g 3–4. This is not a fair characterization of the Final Written Decision, which states that despite the lack of explicit wording, a person of ordinary skill in the art, would *understand*, given Griffin’s other disclosures, that Griffin teaches the limitation. This understanding is evidenced by the descriptions of Figure 4 and Dr. Haas’s testimony in this regard. Final Dec. 67–68 (citing Ex. 1005, Fig. 4, items 401, 407, 6:38–44, 12:63–67; Haas Decl. ¶¶ 191).

Patent Owner argues that Griffin does not disclose attaching one or more files to “data content.” Req. Reh’g 4. According to Patent Owner, Griffin distinguishes between message 400 and message content 406, and Griffin does not teach attachments 407 are attached to the message content 406 itself. *Id.* We are not persuaded by Patent Owner’s argument. First, we could not have misapprehended or overlooked Patent Owner’s argument regarding Griffin’s “attachment” because Patent Owner did not make any arguments in this proceeding concerning Griffin’s attachment 407. We noted in our Final Written Decision that Patent Owner did not address any of

the disclosures that Petitioner relied on to argue that Griffin teaches the attachment of a file to a *speech* chat message. *See* Final Dec. 69 (addressing that Patent Owner’s arguments concerning this limitation focused on the *explicit* disclosure of attaching to a *text* message, not a *speech* chat message, and that Patent Owner’s further arguments did not address the further evidence and arguments Petitioner proffered that Griffin *teaches* the “attaches” limitation).

Second, we do not agree with Patent Owner’s characterization of Griffin. According to Patent Owner, Griffin does not teach that attachment 407 is “attached” to the “message content.” Griffin, however, explains that the payload of the message “may” contain attachments, such as icons and ring-tones, implying that the attachments need not be included in the outbound chat message itself. Ex. 1005, 6:50–52. What is important here is that Griffin associates the attachment with the *speech chat message* that is embodied by message 400. When Griffin includes the attachment in the payload of the message, such an attachment is associated not only with the message 400 (by virtue of the attachment being part of message 400), but also is associated also with the audio file, in the data content of the message.¹ We have noted Mr. Easttom’s testimony that in a conventional method, as long the system is aware that the “two are meant to be together,” a document is “attached” to an audio file. Ex. 1040, 139:10–19. And we

¹ We noted in our Final Written Decision that the parties focused their argument on the scope of “attaching” rather than the structure or content of the “instant voice message,” which is an issue in other related proceedings, but not germane to the arguments the parties presented for the ’723 patent. Final Dec. 15 n.3.

further credited Dr. Haas’s testimony that the speech chat message would include the fields necessary to indicate that files are attached, much like Griffin discloses for the text message. Final Dec. 68–69 (citing Haas Decl. ¶ 191). Therefore, Patent Owner’s arguments are not persuasive and do not show error in our determination that Griffin alone teaches the “attaches” limitation. Arguments by Patent Owner regarding Zydney’s voice container are not persuasive, because we did not rely on the voice container of Zydney for this limitation.

Patent Owner further argues that the Board erred in construing the “attaches” limitation. Req. Reh’g. 5–6. In particular, Patent Owner contends that we construed the term when neither party expressly set forth a construction for the term. *Id.* Patent Owner also complains that it “was not provided due process ability to respond to the Board’s construction and point out why it is incorrect.” *Id.* at 5–6.

We are not persuaded by Patent Owner’s arguments that we misapprehended the parties’ arguments regarding the scope of the term or that it was not proper for us to construe the term. We expressly construed the term in this proceeding consistent with the claim language requiring the attachment to an audio file and the Specification’s description of embodiments in which an instant voice message is in the form of audio file. Final Dec. 13–16. We considered, and rejected as incorrect, Patent Owner’s argument that attaching a file to an “audio file,” rather than to an instant voice message, required more than an association. *Id.* at 15–16. Our analysis thus highlighted the challenge presented by this and the related cases in which the claims sometimes required an attachment of a file to the instant voice message and sometimes required an attachment of a file to the

audio file. Based on the foregoing, we stand by our decision to construe “attachment” based on the parties’ arguments during trial and at oral argument. Patent Owner has been given ample opportunity to address the term “instant voice message” and the related “attachment” limitation as this is an issue that spans multiple related matters and was extensively discussed at oral argument. *See* Tr. 75:20–87:3.

Patent Owner now raises an argument that “associating” and “attaching” have “distinct and separate meanings” because a claim in a related patent recites these terms individually. Req. Reh’g 5. But this is not persuasive because Patent Owner does not provide any support for the contention that a person of ordinary skill in the art understands “attaching” as being narrower than or different from associating the two recited files. Further, the Specification does not show any embodiment of how “associating” is performed and how the “associating” is technically any different from the description of linking a file to the instant voice message.

In conclusion, we are not persuaded that Patent Owner has shown that we misapprehended or overlooked the matters raised on rehearing and we see no reason to disturb our Final Written Decision in this proceeding.

III. ORDER

Patent Owner’s Request for Rehearing is *denied*.

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