

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,

Petitioner

v.

VL COLLECTIVE IP LLC,

Patent Owner

IPR2022-01086
U.S. Patent 8,605,794

**PATENT OWNER'S REQUEST FOR REHEARING OF
FINAL WRITTEN DECISION**

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I. INTRODUCTION

Patent Owner, VL Collective IP LLC, (“Patent Owner”) requests rehearing of the Final Written Decision dated December 18, 2023 (Paper 37) (“Decision”). Under 37 C.F.R. § 42.71(d), a request for rehearing “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.” Rehearing here is warranted because the Board’s Decision (i) impermissibly relied on anticipation and obviousness theories that were raised for the first time in Reply and were based on new portions of Sonohara, (ii) incorrectly found that Sonohara meets the “content-related . . . data segments” claim limitations, and (iii) overlooked a claim construction argument that was uncontested and would preclude Petitioner’s mapping of Sonohara to all petitioned claims. These errors, which affect each Ground for which the Board found claims invalid, compel rehearing and a reversal of the Board’s findings of invalidity.

II. ARGUMENT

A. The Board Erred By Permitting Petitioner To Address A Claim Limitation For The First Time In Reply

In its Reply, Petitioner for the first time asserted that certain portions of Sonohara meet the “syntactical meaning” claim requirement. Reply, 19-23. Because Petitioner’s Reply arguments and evidence for this claim limitation were new and not responsive, they were improper and should have been given no weight. The

Board erred by considering these novel theories and evidence, contrary to the APA requirement that patent owners get fair notice and an opportunity to respond. *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001 (Fed. Cir. 2023).

“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). “A reply may only respond to arguments raised in the corresponding opposition or patent owner response.” *Id.* (quoting 37 C.F.R. § 42.23(b)). “Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute. While the Board’s requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.” *Id.*

The Federal Circuit recently reiterated the standard for assessing the permissible scope of an IPR petitioner’s reply. “First, the arguments and evidence in the reply must not be part of a *new* theory of unpatentability. Second, the arguments and evidence in the reply must be *responsive* to the patent owner’s contentions or the Board’s institution decision.” *Corephotonics*, 84 F.4th at 1008 (emphasis original). “The ‘newness’ restriction prohibits the petitioner from raising, in reply,

‘an entirely new theory of prima facie obviousness absent from the petition,’ *even if the new theory is responsive to the patent owner's response* or the Board’s institution decision.” *Id.* (quoting *Wasica Finance GmbH v. Continental Automotive Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017)) (emphasis added). It stands to reason that petitioners likewise cannot raise new anticipation theories in reply. *See id.*

“The ‘responsiveness’ restriction limits the petitioner’s reply to addressing issues presented in the patent owner responses or the Board's institution decision.” *Id.* “Determining whether a reply is improperly non-responsive generally requires a comparison between the patent owner’s and the Board’s responses to the petition, on the one hand, and the petitioner’s reply, on the other.” *Id.*

The term “content-related . . . data segments” is expressly defined in the specification as “data segments [that] have a syntactical meaning within the respective data file.” EX1001, 4:9-22. Petitioner and its expert acknowledge that this term is defined in the specification and agree with Patent Owner about its definition. Reply, 6; EX1016, ¶¶28-29; Decision, 16-18. Yet the Petition *did not address* the definitional requirement that data segments have a “syntactical meaning” within a data file. Response, 48-49. The Board’s Decision acknowledges all this: “[W]e agree with Patent Owner that the Petition does not specifically address the definitional requirement of ‘content-related’ as having syntactical meaning[.]” Decision, 39.

The Board's correct finding that the Petition did not address the "syntactical meaning" claim limitation necessarily means that the limitation was addressed for the first time in Petitioner's Reply. And in fact, in Petitioner's Reply, it is first alleged that the "syntactical meaning" claim limitation is met by Sonohara's disclosure of header and track identification numbers for unit times of audio and image data. Reply, 18-22.

By addressing the "syntactical meaning" claim limitation for the first time in Reply, Petitioner was necessarily setting forth new anticipation and obviousness arguments. Petitioner thus violated the "newness" restriction. *Corephotonics*, 84 F.4th at 1008. Upon finding that a material claim limitation of all petitioned claims was not analyzed in the Petition for the Sonohara-based grounds, the Board should have concluded that Petitioner's reply exceeded the permissible scope, disregarded the new theories, and determined that all Sonohara-based grounds necessarily fail to invalidate any petitioned claims. That the Board did not was clear error. *Wasica*, 853 F.3d at 1286-87 (holding that petitioner's reliance on a different portion of a reference than what was relied on in the petition "amount[ed] to an entirely new theory of *prima facie* obviousness" and so was properly disregarded by the Board); *Microsoft Corp. v. IPA Techs. Inc.*, 2022 WL 989403, at *6 (Fed. Cir. 2022) ("The Board did not abuse its discretion in concluding that Microsoft's complete failure to address [claim limitations in dependent claims] was a failure to meet the particularity

requirements for what must be in the petition and cannot be left to be filled in on reply.”); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331 (Fed. Cir. 2019) (“We conclude that the Board did not abuse its discretion in holding HPC to its word and disregarding its new [obviousness] theory first raised in reply.”); *Intelligent Bio-systems*, 821 F.3d at 1369 (affirming Board’s decision to disregard new obviousness theory first raised in Reply); *Apple Inc. v. MPH Techs. Oy*, 2022 WL 4103286, at *6-8 (Fed. Cir. 2022) (upholding the validity of claims because “petitioner did not address all of a claim’s limitations in its petition”).

The Board cites *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018) in support of its analysis. But *Ericsson* involved very different circumstances. Unlike here, the allegedly novel theory was disclosed in the petition. *Id.* at 1380. Moreover, the reply’s elaboration on the previously-disclosed theory was further justified by the Board adopting a new claim construction after the institution decision. *Id.* That did not occur here, as all parties and their experts have always agreed that “syntactical meaning” is part of the express lexicography of the claim term “content-related . . . data segments.” There thus was no change in claim construction at any stage of the proceeding. It was apparent and foreseeable that Petitioner would need to analyze the “syntactical meaning” claim limitation, but the Petition failed to do so. Patent Trials and Appeal Board Consolidated Trial Practice Guide November 2019, 73 (“Petitioner may not submit new evidence or argument

in reply that it could have presented earlier, e.g., to make out a prima facie case of unpatentability”).

In view of the above, there was no reason for the Board to analyze the “responsiveness” requirement. But the Board erred here, too. Indeed, the Board’s analysis appears to contradict itself. On the one hand, the Board reviewed the record and determined that the “syntactical meaning” limitation was not addressed in the Petition. Decision, 39. Yet in the very next paragraph the Board determines that the Petitioner did “not alter its theory” and its Reply is “responsive” rather than a “new argument.” *Id.*, 40.

The Board cannot have it both ways. As a matter of logic, because Petitioner did not address the “syntactical meaning” limitation in its Petition, Petitioner’s analysis of the limitation in its Reply is necessarily a new argument based on new evidence. Petitioner’s Reply argument can thus only be said to be “responsive” to Patent Owner’s Response in the sense that the Response pointed out that the Petition completely failed to address the limitation and Petitioner then responded by presenting a theory for the first time. But if that were sufficient to make Petitioner’s Reply argument “responsive” rather than “new,” then a Reply would never contain a new argument. That is not the law. *Microsoft*, 2022 WL 989403, at *6.

Because Petitioner’s only theories for how the “syntactical meaning” claim limitation is met by Sonohara were improperly disclosed for the first time in Reply,

these untimely anticipation and obviousness theories should be excluded under controlling Federal Circuit law and the decision to invalidate claims should be reversed.

B. The Board Misapprehended Or Overlooked The Many Deficiencies In Petitioner’s Mapping Of Sonohara To The “Content-Related . . . Data Segments” Claim Limitations

In its Decision, the Board appears to have applied the following construction for “content-related . . . data segments”: “segments of content data that have a syntactical meaning within the respective data file.” Decision, 18, n.5 (emphasis changed to underline). The Board states that it adopts the above construction *without* the underlined language, but then in a footnote states that “it is not necessary to decide if the preamble is limiting, and therefore the data segments may or may not be within a respective data file.” Patent Owner understands this to mean that the Board assumes the data segments must be within a respective data file in its analysis (i.e., the underlined language is included) but does not definitively take a position on whether the proper construction includes the language or not.

Patent Owner takes this view because if the Board were instead applying a construction of “content-related . . . data segments” without the “within the respective data file” language, that would be clear error two times over. No party advocated that construction, meaning it was never vetted during the proceeding and so the first time it was ever proposed was in the Decision. There is no argument or

evidence supporting such a construction. Moreover, it is contrary to the express definition in the '794 patent, which both parties, both experts, the Board, and Judge Hall have all recognized is controlling and must be applied. Response, 14-21; Decision, 16-18. If the Board did indeed hold that content-related data segments “may or may not be within a respective data file,” that is clear error procedurally and substantively and the Board should instead apply the definitional construction that everyone agrees is appropriate.

Based on the inventors’ clear lexicography, the “content-related first data segments” must have a “syntactical meaning *within*” the “first data file,” and the “content-related second data segments” must have a “syntactical meaning *within*” the “second data file.” EX1001, 4:9-22, claims 1, 9 (emphasis added). The syntactical meaning must thus be associated with a particular set of data segments and a particular data file. Petitioner’s mapping of Sonohara to these claim terms falls short because the alleged “syntactical meaning” is not “within” the alleged *first and second* data files, as the inventors’ lexicography requires, but is instead within a different, *single* data file. It was clear error for the Board to find otherwise.

Petitioner’s mapping of Sonohara to the definitional construction of “content-related . . . data segments” is unambiguous. Petitioner relies on the source **image file 11** and **sound file 12** as the first and second data files; Petitioner relies on the unit times in the single **data file 1** as the segments of content data; and, for the first and

only time in its Reply, Petitioner relies on the header and track information for the unit times as the “syntactical meaning.” Pet., 37-42; Reply, 18-22.

This mapping fails because the alleged syntactical meaning for the alleged data segments is not “within” the two source files (**image file 11** and **sound file 12**). Nor are the alleged data segments “within” the two source files. Instead, the data segments and their syntactical meanings are all “within” the single **data file 1**.

The source files in Sonohara do not have data segments. EX1003, 3:45-4:20, 5:40-6:41, Figs. 4, 6. The unit times are only created upon reading out 1-second increments from the source files and storing them within the single **data file 1**. *Id.* The header and track information is likewise not part of the source data files. *Id.*; *see also id.*, 4:21-5:6, 6:42-67, Figs. 1, 6-9. They are instead created after the unit times are created, and are stored in the single **data file 1**, so that they may be used to identify and refer to the unit times. *Id.* The header and track information have no relation to the source data files. Rather, they contain information that is specifically about the unit times and their organization within the **data file 1**. The header and track information is not stored in nor descriptive of the source data files. *Id.* Patent Owner previously explained all this. Response, 11-13, 47-53. Petitioner does not dispute Patent Owner’s description of these aspects of Sonohara. Reply, 18-22; Decision, 38-41.

Because the alleged data segments and their alleged syntactical meaning only exist as part of the single **data file 1** and not the distinct source data files, the definitional claim requirement that the “segments of content data [] have a syntactical meaning *within the respective data file*” is not met by Sonohara. Petitioner tries to conceal this failing of Sonohara by improperly mixing and matching between the disclosures of Sonohara related to the two, distinct source data files (**image file 11** and **sound file 12**) and the single **data file 1**. Reply, 18-22; Response, 47-53.

The Board does not grapple with any of the failings of Sonohara in its Decision. The Board instead asserts in a conclusory manner that Petitioner “infer[s] syntactical meaning in the originating files from this process.” Decision, 41.¹ But in Sonohara’s description of creating the single **data file 1**, the alleged data segments and syntactical meaning exist only “within” the data file 1; they are not “within” (nor even descriptive of) the source data files. The only aspect of the source data files that is in the single data file is the underlying audio and image data, and even that is modified. Response, 52-53.

A careful review of the record shows that neither Petitioner nor its expert contend otherwise. Petitioner states that “PO is wrong . . . because the **file 1** is created

¹ The Decision also credits Petitioner’s expert, but his declaration adds nothing, as it is nearly identical to the language in the Reply. EX1016, ¶¶52-55.

from the image and sound portions of the distinct **image file 11** and **sound file 12** . . . and the **file 1** includes syntax information including header and track information with track and data identifiers identifying the relationship between the image and audio portions of the **file 1**[.]” Reply, 22. Thus, Petitioner notes that the underlying image and sound data comes from the source files but otherwise agrees that the alleged syntactical information only exists within (and only describes) data in the single **data file 1**.²

The Board’s adoption of Petitioner’s imprecise and hole-ridden analysis constitutes a misapprehension of the requirements of the petitioned claims and of the gaps in Petitioner’s mapping of Sonohara to the “content-related . . . data segments” claim limitations. The Board also erred by not even addressing, let alone explaining or analyzing the deficiencies in Petitioner’s arguments that Patent Owner identified. The Board should reconsider and find that Sonohara neither anticipates nor renders obvious any petitioned claims because it does not describe “content-related . . . data segments,” as that term has been defined in the ’794 patent.

² Notably, in the ’794 patent, both the data segments and the syntactical meaning are “within” the two distinct data files. That is, the fragmentation description files, which both create the data segments and their syntactical meaning, are specific to the video data file **D1** and the audio data file **D2**. EX1001, 4:9-53 (“For every first and second data file D1, D2 there exists in each case a fragmentation description file . . . [which] specifies how content-related first data segments S1, S2 can be obtained from the respective first and second data file[s.]”). Unlike Sonohara, there is no third data file that contains both the audio and video data segments and has its own syntax.

C. The Board Overlooked Patent Owner’s Claim Construction Position That Requires Synchronizing Data Segments From Two Distinct Data Files

In its Response, Patent Owner argued that, as a matter of claim construction, the “content-related . . . data segments” must come from two distinct data files *at the time of synchronization*. Response, 53-55. That is, the fact that the underlying data was stored in distinct data files *in the past* was insufficient to meet the requirements of “synchronizing” and “sequentially outputting” the first and second content-related data segments. *Id.*; EX1001, claims 1, 9. Were it otherwise, the claim limitations that require synchronizing data segments from *two, separate* data files could be met by synchronizing data segments from a *single* data file (if there had been two data files in the past), making the two data file requirement effectively superfluous. *Id.* Abundant intrinsic evidence supports Patent Owner’s claim construction position. *See* Response, 26-27, 31-32, 53-55. Petitioner did not rebut (and so conceded) this claim construction issue. Sur-Reply, 23.

Petitioner’s only theory for how Sonohara meets the two distinct data file limitations is based on the data segments having previously been stored in separate data files—which is the precise claim interpretation that is excluded by Patent Owner’s construction. Response, 49-56; Pet. 37-42. Patent Owner’s construction and its validity argument based thereon are thus both uncontested.

The Decision, however, does not acknowledge Patent Owner's uncontested claim construction. The Board thus overlooked the issue, and by failing to consider it and adopt Patent Owner's construction, reached an incorrect result. The Board should adopt Patent Owner's construction and find that Sonohara does not meet the claim requirements of two separate data files and thus neither anticipates nor renders obvious any asserted claims.

III. CONCLUSION

For all the reasons above, the Board should find that neither Sonohara nor Abbott anticipate or render obvious any petitioned claims.

Dated: January 17, 2024

By: /Christine E. Lehman/
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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Patent Owner's Request for Rehearing of Final Written Decision complies with the type-volume limits of 37 C.F.R. § 42.24 and consists of no more than 15 pages, excluding the table of contents, table of authorities, certificate of service, and this certificate of compliance.

Dated: January 17, 2024

Respectfully submitted,

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S REQUEST FOR REHEARING OF FINAL WRITTEN DECISION** was served on January 17, 2024, via electronic mail, as agreed to by counsel, upon the following counsel for Patent Owner:

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