

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,  
Petitioner,

v.

VL COLLECTIVE IP LLC,  
Patent Owner.

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IPR2022-01086  
Patent 8,605,794 B2

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Before KARL D. EASTHOM, JEFFREY S. SMITH, and  
DAVID C. McKONE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION  
Denying Request for Rehearing  
*37 C.F.R. 42.71*

## I. INTRODUCTION

On January 17, 2024, Patent Owner filed a Request for Rehearing (Paper 39, “Req.”) of our Final Written Decision (Paper 37, “Dec.”), which held that claims 1, 3, 5, 9, 12, 13, and 15 of U.S. Patent No. 8,605,794 B2 (Ex. 1001, the “’794 patent”) are unpatentable, and that claims 20 and 21 are not unpatentable. Patent Owner contends that (a) we impermissibly relied on anticipation and obviousness theories that were raised for the first time in Reply and were based on new portions of Sonohara, (b) we incorrectly found that Sonohara meets the “content-related . . . data segments” claim limitations, and (c) we overlooked a claim construction argument that was uncontested and would preclude Petitioner’s mapping of Sonohara to all petitioned claims. Req. 1.

For the reasons that follow, Patent Owner’s request for rehearing is denied.

## II. ANALYSIS

### *A. Legal Standard*

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. 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, a reply, or a sur-reply.

A rehearing request is not an opportunity for the requesting party to present new arguments or merely to express disagreement with the Decision and reargue its case, which is all Patent Owner has done in this instance.

*B. Alleged Theories Impermissibly Raised in the Reply*

Claim 1 recites “sequentially outputting, by a device for synchronizing content-related data, the content-related first data segments and the content-related second data segments.” Claim 9 recites a similar limitation. Patent Owner, in its Response, contended that the specification defines the claim term “content-related” to mean that first and second data segments have a syntactical meaning within the respective data file. PO Resp. 14–21. Petitioner, in its Reply, showed that Sonohara discloses “content-related” data segments as claimed under Patent Owner’s proposed construction. Reply 19–23; Dec. 39–41.

Patent Owner contends that we impermissibly relied on anticipation and obviousness theories that were raised for the first time in Reply and were based on new portions of Sonohara. Req. 1. Patent Owner contends that “[b]y addressing the ‘syntactical meaning’ claim limitation for the first time in Reply, Petitioner was necessarily setting forth new anticipation and obviousness arguments.” Req. 4. According to Patent Owner, “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.” *Id.* at 5. Patent Owner contends that Petitioner’s theories for how the claim term “syntactical meaning” is met by Sonohara was improperly argued for the first time in Reply and should be excluded. *Id.* at 6–7.

We disagree with Patent Owner’s contention that there was no change in claim construction at any stage because “all parties and their experts have always agreed” that the claim term “content-related” was defined by the specification. Rather, Petitioner, relying on the testimony of Dr. Freedman,

argued that Patent Owner’s proposed construction “(a) improperly imports limitations from the specification that are not required by the claims, and (b) renders other portions of claim 1 superfluous.” Reply 3 (citing Ex. 1016, Freedman Suppl. Decl. ¶ 22). We did “agree with Petitioner that it would be imprudent to adopt Patent Owner’s additional gloss” by stating that “Applicant for the ’794 patent . . . chose to limit its definition of ‘content-related’ in terms of the broader phrase ‘syntactical meaning’ rather than through narrower reference to presentation order,” and that “claims 1 and 9 already specify ‘sequentially outputting the first and second data segments according to their chronological sequence,’ which supports Petitioner’s observation that requiring an additional sequential order to ‘content-related . . . data segments’ renders other portions of claim 1 superfluous.” Dec. 17-18. Thus, contrary to Patent Owner’s contention, Petitioner and Dr. Freedman did not always agree with Patent Owner that “content-related” was defined by the specification.

Petitioner’s initial proposed construction in the Petition, “that no claim term requires construction beyond their plain and ordinary meaning” (Pet. 9), Petitioner’s disagreement with Patent Owner’s new proposed construction of “content-related” (Reply 3–6), and Petitioner’s arguments explaining why its identification of Sonohara’s originating files meets “content-related” even under Patent Owner’s new construction (Reply 19–23), were reasonable. The Federal Circuit has held that “where a patent owner in an IPR first proposes a claim construction in a patent owner response, a petitioner must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction, at least where it relies on the same embodiments for each invalidity ground as were relied on in the petition.” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th

1374, 1384 (Fed. Cir. 2023). Here, Patent Owner proposed a new claim construction of “content-related” in the Patent Owner Response. PO Resp. 14–21. Petitioner was entitled to address this new construction in its Reply by relying on the same embodiment for each invalidity ground as it relied on in the Petition.

Contrary to Patent Owner’s contention, Petitioner did not rely on new embodiments of Sonohara in addressing Patent Owner’s new construction. We highlight that Sonohara discloses only one embodiment of its invention. Ex. 1003, 3:30–31, 3:48–53 (“An embodiment of the invention will now be described with reference to the accompanying drawings.”), 5:39–40 (“The operation of the structure according to the embodiment will be explained.”). Petitioner, in its Reply, argued and presented evidence of anticipation and obviousness under Patent Owner’s new construction by relying on the same embodiment of Sonohara for each invalidity ground as was relied on in the Petition. *See* Pet. 36–51. As we stated in our Decision, “we find Petitioner’s elaboration in its Reply to be properly responsive to Patent Owner’s argument.” Dec. 40 (citing *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1380 (Fed. Cir. 2018) (“[T]he Board has discretion to determine whether a petition for *inter partes* review identified the specific evidence relied on in a reply and when a reply contention crosses the line from the responsive to the new.”)).

Petitioner has not shown that we impermissibly relied on anticipation and obviousness theories that were raised in the Reply.

### *C. Alleged Misapprehension of the Claims and the Teachings of Sonohara*

Patent Owner contends that we erred in construing the term “content-related . . . data segments” as meaning “segments of content data that have a

syntactical meaning” rather than “segments of content data that have a syntactical meaning within the respective data file.” Req. 7 (citing Dec. 18 n.5). Patent Owner contends that no party advanced our construction and that our construction is contrary to the definition found in the specification, “which both parties, both experts, the Board, and Judge Hall have all recognized is controlling and must be applied.” Req. 8.

We explained in our Decision that we did not resolve the issue of whether “within the respective data file” is entitled to patentable weight, because resolving this issue requires resolving the issue of whether the preamble has patentable weight, which we did not do because, as we stated in our Decision, “it is not necessary to decide if the preamble is limiting.” Dec. 18 n5. As we stated, “[w]e need not resolve this dispute because we reach the same ultimate conclusion . . . even if we apply Patent Owner’s proposed construction,” which we did. Dec. 14.

Contrary to Patent Owner’s contention, Petitioner and Dr. Freedman have shown that claims 1, 3, 5, 9, 12, 13, and 15 are unpatentable under Patent Owner’s proposed construction. *See* Dec. 38–42. Specifically, Petitioner and Dr. Freedman explained that the content-related data segments of the originating image and audio files of Sonohara have syntactical meaning within the originating files because the files have an order of data according to a chronological sequence, and that this syntactical meaning is imparted by the data and track identifiers to the file containing the image data segments and sound data segments, so that the segments are synchronized and output according to their chronological sequence. *Id.*

As we stated in our Decision, Petitioner’s “inference [of syntactical meaning within the originating files] is supported by Dr. Freedman’s testimony, which we credit.” Dec. 41. We highlight that Petitioner, relying

on the testimony of Dr. Freedman, contended that the data identifying numbers of the image data portion and the sound data portion of the image track and the sound track of Sonohara are assigned based on how the image or sound data is ordered in the original image track or sound track, and a person of ordinary skill would have recognized that the order of an image track or sound track for a motion picture would be chronological. Pet. 42–46 (citing Ex. 1005 ¶¶ 133–140). Dr. Freedman testified that his

analysis of the term ‘content-related’ . . . data segments in my original Declaration is the same if the term ‘content-related . . . data segments’ is construed to segments of content data that have a syntactical meaning within the respective data file, because that is how I understood this term when I prepared my original Declaration (EX1005). For example, as I explained with respect to *Sonohara*, it was known for image and sound data portions to be synchronized based on the use of identification numbers for synchronizing those image and sound data portions according to a chronological sequence. EX 1005, ¶¶134–137.

Ex. 1016 ¶ 33. In his original Declaration, Dr. Freedman explained that the image and sound data are output synchronously “with reference to the track identifying number and the data identifying number.” Ex. 1005 ¶ 134.

Dr. Freedman explained that the data identifying numbers are imparted “to the image data and the sound data for every unit time” in order to represent **“an order of data within the image track and the sound track.”** *Id.* ¶ 135 (quoting Ex. 1003, 1:59–65). Dr. Freedman testified that a person of ordinary skill in the art “would have recognized *Sonohara* to operate *sequentially* such that segments are output *according to their chronological sequence*,” and that “*Sonohara* therefore discloses that the data identifying numbers of the image data and sound data segments, and thus the output of those segments, is . . . *sequential . . . according to their chronological sequence*.” *Id.* ¶ 137. Thus, Petitioner’s and Dr. Freedman’s analysis of the

claims as anticipated by or obvious over Sonohara addressed Patent Owner's proposed construction of "content-related . . . data segments."

Patent Owner contends that "Petitioner relies on the header and track information" of Sonohara "for the unit times as the 'syntactical meaning,'" but "[t]his 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)" as required by Patent Owner's proposed construction.

Req. 9. According to Patent Owner, the "header and track information have no relation to the source files. Rather, they contain information that is specifically about the unit times and their organization within the **data file 1.**" *Id.* Patent Owner contends that 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." *Id.* at 10. According to Patent Owner, we asserted in a conclusory manner that Petitioner "infer[s] syntactical meaning in the originating files from this process" and that the "Decision also credits Petitioner's expert, but his declaration adds nothing, as it is nearly identical to the language in the Reply." *Id.* at 10 n.1. Patent Owner contends that 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." *Id.* at 11.

In our Decision, we found that Petitioner infers syntactical meaning of the image and sound segments in file 1 from the originating image file 11 and sound file 12. Dec. 41 (citing Reply 19–23; Ex. 1016 ¶¶ 52–55). Petitioner, relying on testimony of Dr. Freedman, contended that Patent Owner was incorrect "because Petitioner showed that the file 1 containing image data segments and audio data segments in Figure 1 originated from



the distinct image file 11 and sound file 12, as shown in Figure 4.” Reply 19 (citing Pet. 40–41; Ex. 1005 ¶¶ 130–131; Ex. 1016 ¶ 52). Petitioner, relying on testimony of Dr. Freedman, contended that image file 11 has the same syntax as image track 22 of file 1, and that sound file 12 has the same syntax as sound track 23 of file 1, because Sonohara’s segments of image data and segments of sound data of file 1 originate from image file 11 and sound file 12, and file 1 includes syntax information including header information with track and data identifiers to synchronize and output the image and sound files in chronological order. Reply 15–24.

Dr. Freedman testified that Sonohara discloses that the image data segments are of a first data file, and the sound data segments are of a second data file, because the image data and sound data originate from image file 11 and sound file 12. Ex. 1005 ¶¶ 130–131. Dr. Freedman testified that Sonohara creates the content-related image segments from image file 11 and creates the content-related sound segments from sound file 12. Ex. 1016 ¶¶ 51–52. Dr. Freedman testified that “*Sonohara* discloses that the track identifying means 2 in Figure 1 ‘impart[s] to the image data and the sound data **for every time unit**, track identifying numbers for identifying either the image track or the sound track.’” Ex. 1016 ¶ 54. Dr. Freedman testified that “each portion of data for a unit time corresponds to a *segment* as recited.” *Id.* Dr. Freedman testified that “*Sonohara* discloses that the image and sound data segments in the file 1 are synchronized and output sequentially based on the track and identifying numbers in the file 1, as shown in Figures 1 and 7.” *Id.* Dr. Freedman testified that “the single data file 1 is created from the image and sound portions of the ‘image file 11’ and ‘sound file 12,’ as shown in Figures 3–4, and the single data file includes syntax information including header information with track and data identifiers

identifying the unit time and relationship between the image and audio portions of the file 1 based on that unit time.” *Id.* ¶ 55; *see* Reply 19–23.

As we stated in our Decision, we agree with Petitioner and Dr. Freedman, “that Sonohara discloses ‘content related . . . data segments’ in its originating image and audio files.” Dec. 41. As discussed above, the content-related data segments of the originating image and audio files of Sonohara have syntactical meaning within the originating files because the files have an order of data according to a chronological sequence, and that this syntactical meaning is imparted by the data and track identifiers to the file containing the image data segments and sound data segments so that the segments are synchronized and output according to their chronological sequence. We agree with Petitioner, that Sonohara discloses “content-related . . . data segments” even under Patent Owner’s proposed construction of “segments of content data that have a syntactical meaning within a respective data file.”

Patent Owner has not shown that we misapprehended the claims or the teachings of Sonohara.

#### *D. Alleged Overlook of Patent Owner’s Claim Construction*

Patent Owner contends that the “content-related . . . data segments” as claimed must come from two distinct data files at the time of synchronization under Patent Owner’s claim construction, otherwise the two data file requirement is superfluous. Req. 12 (citing PO Resp. 53–55). Patent Owner contends that the Board overlooked this construction and reached an incorrect result. *Id.* at 13.

We highlight that Patent Owner did not propose its alleged construction in the claim construction section of the Response, but in the

section analyzing whether Sonohara describes “synchronizing content-related first data segments of a first data file and content-related second data segments of a second data file” as claimed. Further, Patent Owner’s construction appears to suggest that what is being synchronized, which is image data and sound data, has weight, but that how the source of the data was created does not. PO Resp. 53–54. Specifically, Patent Owner in its Response contended that

if one were to record audio and video using a device that stores them in separate data files, and then perform the claimed synchronization, then one would infringe. *By contrast, if one were to happen to record audio and video using a device that stores them in the same data file, and then perform the claimed synchronization, then one would not infringe. Thus, whether the two data file limitations are met would hinge on happenstance rather than deliberate actions of would-be infringers. Indeed, because such an interpretation of the relationship between the “content-related . . . data segments” and the two distinct data files would render the two data files limitations essentially “void, meaningless, or superfluous,” it should be found to be excluded as a matter of claim construction.*

PO Resp. 54 (emphasis added). Thus, Patent Owner’s alleged construction in its Response seems to mean that the claim should be construed to encompass synchronizing audio and video data regardless of whether the data is from one file or two so that “whether the two data file limitations are met would [not] hinge on happenstance.”

To the extent that Patent Owner now contends that the claim requires synchronizing content-related data segments from two distinct data files at the time of synchronization, we disagree. The claim does not recite synchronizing data segments from two distinct data files at the time of synchronization. First, the body of the claim does not recite data files. Second, the preamble states “synchronizing content-related first data

segments of a first data file and content-related second data segments of a second data file.” We did not resolve the issue of whether the preamble is entitled to patentable weight. Dec. 14. However, we did state that “[f]or purposes of this Decision, we . . . treat the preambles of independent claims 1 and 9 as limiting.” Dec. 15. Thus, we did address Patent Owner’s proposed construction that the preamble is limiting, and found that the Petition and Dr. Freedman showed that Sonohara discloses the preamble.

Further, the Petition and Dr. Freedman addressed the preamble phrase “content-related first data segments of a first data file and content-related data segments of a second data file.” The Petition stated that “*Sonohara* also discloses that the *content-related first data segments are of a first data file and the content-related second data segments are of a second data file*. This is because, in *Sonohara*, the image data and sound data originate from an ‘image file 11’ and a ‘sound file 12’ as depicted in Figure 4.” Pet. 40. Dr. Freedman supported this contention with his testimony. Ex. 1005 ¶¶ 130–131. Thus, even considering the preamble as limiting, we agree with Petitioner and Dr. Freedman that Sonohara discloses that the content-related image and sound data segments are “of a first data file” and “of a second data file” because the image data segments and the sound data segments originate from image file 11 and sound file 12.

Patent Owner has not shown that we overlooked its claim construction argument.

### III. CONCLUSION

Patent Owner has not carried its burden of demonstrating that our Decision misapprehended or overlooked any matters. 37 C.F.R. § 42.71(d).

#### IV. ORDER

For the foregoing reasons, Patent Owner's Request for Rehearing is *denied*.

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