

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01683
Patent 8,571,194 B2

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

SMITH, *Administrative Patent Judge.*

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On January 24, 2019, Patent Owner Uniloc 2017 LLC filed a Request for Rehearing (Paper 25, “Req.”) of our Final Written Decision (“FWD”) dated January 14, 2019, which held that claims 1–16 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, “the ’194 patent”) are unpatentable.

Patent Owner argues that the Decision misapprehended applicant’s purported disclaimer made during prosecution, of requiring prior registration with a conference call server. Req. 3–6 (citing PO Resp. 7–8; Ex. 1018, 113–114). Patent Owner contends that the Decision did not consider that the registration process of Liversidge (Ex. 1004) is the same as the registration process of Hamberg (Ex. 1013) (cited by the Examiner during prosecution). Req. 6–10. Patent Owner contends that the Decision provides almost no reasoning, analysis, or evidence as to why the VTE server of Liversidge could not be considered a conference call server, and that Petitioner raised this issue as an untimely argument in its Reply. Req. 10.

For the reasons set forth below, Patent Owner’s Request for Rehearing is denied.

II. STANDARD OF REVIEW

Section 37 C.F.R. § 42.71(d) states the following:

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, or a reply.

III. DISCUSSION

Patent Owner contends that the Decision overlooked Patent Owner's contention that, during prosecution, applicant disclaimed requiring prior registration. Req. 3–6. According to Patent Owner, applicant explained to the Examiner that the claim “displays an option for the first party to automatically initiate voice communication . . . without requiring prior registration with a conference call server by potential members.” Req. 5 (quoting Ex. 1018, 114) (emphasis in original). However, during subsequent prosecution, the Examiner rejected the claims, and applicant responded with an amendment and remarks. See FWD 9–10 (citing Ex. 1018, 70, 82). We found that the prosecution history shows that the Examiner rejected the claims because they recited “without requiring prior registration,” applicant deleted “prior” from the claims in order to overcome the rejection, and, as a result, the claims do not include the language asserted by Patent Owner. FWD 10. Patent Owner has not shown that applicant made a clear and unmistakable disclaimer of any subject matter beyond that already reflected in the claims, which we considered in evaluating Petitioner's challenges. *Id.* We are not persuaded that we overlooked the prosecution history.

With respect to Patent Owner's argument that we did not consider that “both the *Liversidge* and *Hamberg* references had the same registration” (Req. 6–9), we find this argument unpersuasive. In our Decision, we determined that Hamberg requires registration with the conference call server. FWD 8. In contrast to Hamberg, we found that the registration of Liversidge is with a presence server, which is not a conference call server. FWD 29–30. We also found that Liversidge, unlike Hamberg, does not require registration, because Liversidge teaches inviting a person who is not

registered as a member of a team to join an IM session, then converting the IM session into a voice session, where the voice session includes the person who is not registered. FWD 23–26, 28–29. We also found the convert session function of Liversidge does not require a separate or additional registration before establishing voice communication. FWD 26–27. We are not persuaded that we overlooked the registration of Hamberg, nor that we overlooked the registration of Liversidge.

Patent Owner contends Petitioner’s argument that the VTE server is not a conference call server is untimely, because Petitioner raised this argument in the Reply. Req. 10. We disagree. Petitioner’s Reply responds to Patent Owner’s argument that the VTE server is a conference call server. *See* PO Resp. 30–32. Patent Owner “is the party that first raised this issue,” and Petitioner “simply countered, as it was entitled to do.” *Idemitsu Kosan Co., LTD. v. SFC Co. LTD.*, 870 F.3d 1376, 1381 (Fed. Cir. 2017). Patent Owner has not persuasively explained why Petitioner’s Reply to Patent Owner’s argument was beyond the scope of a proper reply.

Patent Owner contends that the Decision provides almost no reasoning, analysis, or evidence as to why the VTE server of Liversidge could not be considered a conference call server. Req. 10. To the contrary, we found that Liversidge discloses that the call server facilitates interaction between the VTE server, the presence server, and the public switched telephone network. FWD 22 (citing Ex. 1004 ¶ 68). Our analysis explains that because Liversidge’s call server controls the public switched telephone network to place call connections to telephones and initiate voice communication, the call server is a conference call server. FWD 22–23 (citing Ex. 1004 ¶ 68, Fig. 2). Contrary to Patent Owner’s contention, the

Decision points to evidence and provides analysis to support our finding that Liversidge's call server, rather than the VTE server, teaches the conference call server as claimed.

We also provided three distinct analyses of Patent Owner's premise that the VTE server of Liversidge is a conference call server. First, we found that "[e]ven if we were to accept Patent Owner's premise that the VTE server, not the call server, is the conference call server" (FWD 23), Liversidge teaches inviting a person who is not registered as a team member to join the IM session, then converting the IM session into a voice session, where the resulting voice session includes the person who is not registered. *See* FWD 23–26, 28–29. Second, we found that the convert session function of Liversidge does not require team members to reenter any registration information, which teaches "current participants of an IM session are not required to complete an additional or separate registration before establishing voice communication." FWD 26–27. Third, we found that registration does not occur with the VTE server, because "paragraph 100 of Liversidge discloses that the presence server, not the VTE server, registers a team member in the status table." FWD 29–30. We did not overlook this contention.

IV. CONCLUSION

For the foregoing reasons, Patent Owner did not show that the Board misapprehend or overlooked any arguments or evidence presented by Patent Owner in determining that claims 1–16 of the '194 patent are unpatentable.

V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is denied.

IPR2017-01683
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