

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2017-02080
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Google, Inc., now known as Google LLC (“Petitioner”), filed a Petition requesting *inter partes* review of claims 3–23 (the “challenged claims”) of U.S. Patent No. 8,724,622 B2 (Ex. 1001, “the ’622 patent”) on five asserted grounds. Paper 2 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With authorization from the Board, Petitioner additionally filed a Reply to Patent Owner’s Preliminary Response. Paper 9. After considering the information presented in the Petition, the Preliminary Response, and the Reply, we determined that Petitioner had not established a reasonable likelihood of prevailing as to any of the challenged claims of the ’622 patent, and we, accordingly, denied institution of *inter partes* review. Paper 10 (“Decision” or “Dec.”); see 35 U.S.C. § 314(a) (providing that an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition”). Petitioner requests rehearing of our Decision, contending that “evidence in the Petition . . . was misapprehended or overlooked” and that “[p]roper consideration of th[at] evidence . . . compels a conclusion that Grounds 1–5 . . . provide a reasonable likelihood of Petitioner prevailing against each of claims 3–23.” Paper 11 (“Req. Reh’g”), 1.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “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.”

37 C.F.R. § 42.71(d).

For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

ANALYSIS

Claim 3 is the only independent claim among the asserted claims and recites, in part, “a messaging system communicating with a plurality of instant voice message client systems . . . wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and *wherein the instant voice message includes an object field including a digitized audio file.*” Ex. 1001, 24:15–27 (emphasis added). Petitioner alleges that claims 3–8, 11, 13, and 18–21 are anticipated by Zydney¹ and that claims 3–23 also are unpatentable as obvious over the combined teachings of Zydney and certain other references (Pet. 6, 11–68), relying in each of the asserted grounds on Zydney as teaching the recited “object field including a digitized audio field” (*id.* at 17–19, 38).

In particular, according to Petitioner, Zydney discloses a system in which “digitized audio files in the form of ‘voice messages’ (also referred to as ‘voice data’) are distributed in ‘voice containers’ that include . . . digitized voice messages and ‘voice data properties components’ that indicate parameters for the voice message’s distribution.” *Id.* at 18. “The ‘voice container’ in Zydney corresponds to the claimed instant voice message,” Petitioner contends, “and the ‘digitized voice message’ embedded in

¹ Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (Ex. 1005, “Zydney”)

Zydney’s voice container corresponds to the claimed digitized audio file.” *Id.* Petitioner further contends “Zydney teaches an arrangement of fields . . . for the ‘voice data properties components’ of a voice container” and “teaches elsewhere that the voice container includes a ‘body,’ which is in addition to the voice data properties components shown in Figure 3 [of Zydney], and which holds the digitized voice message itself.” *Id.* at 19. According to Petitioner, “[t]he ‘body’ of the voice container corresponds to the claimed ‘object field’ in an instant voice message to carry a digitized audio file,” where, under the broadest reasonable interpretation, “the recited ‘object field’ is a field of a data packet that includes a digitized audio file.” *Id.* at 18–19 (citing Ex. 1003 ¶ 60; Ex. 1005, 34:4–7 (“Each message will have . . . [a] body of the message”), 23:1–2 (“the voice container [has] voice data and voice data properties components”), FIG. 7 (1.1.5) (recorded voice message compressed and stored “in a voice ‘container’”)). Petitioner further contends a person of ordinary skill in the art “would have appreciated that providing the digitized voice message in an object field (e.g., body) of the voice container would allow the recipient software agent to locate and extract the digitized voice message from other data stored in the voice container.” *Id.* at 19 (citing Ex. 1003 ¶ 62).

In our Decision, we found that there was insufficient evidence on the record to support Petitioner’s contention that Zydney’s disclosure of a message “body” expressly discloses the recited object field and, further, that Petitioner did not establish a reasonable likelihood of showing that the claimed object field is inherently anticipated by Zydney. Dec. 17. We explained, in particular, that “[a]lthough Zydney discloses that its voice container includes ‘voice data,’ . . . Petitioner has not shown that voice data

necessarily would be included in an ‘object field.’” *Id.* We, accordingly, determined that Petitioner did not demonstrate a reasonable likelihood of showing that the object field limitation of claim 3 is disclosed by Zydney.

In its Request for Rehearing, Petitioner contends “[r]ehearing is appropriate because the Decision misapprehended or overlooked Petitioner’s cited evidence showing what is encompassed within the scope of the term ‘object field,’” pointing particularly to the Petition’s reliance on testimony of Petitioner’s declarant, Paul S. Min, Ph.D., that “[b]ased on the teachings of the ’622 patent, . . . the claimed ‘object field’ encompasses a data packet that includes a digitized audio file.” Req. Reh’g 2–3 (citing Ex. 1003 ¶ 60). Petitioner contends the Decision “fails to address Petitioner’s explanation of elements falling within the scope of the ‘object field’ limitation, and also fails to explain why Petitioner’s cited evidence pertaining to this fact was not considered” and “does [not] cite any evidence . . . refuting Petitioner’s express argument of what type of data element constitutes a disclosure falling within the scope of ‘object field’ under the broadest reasonable interpretation standard.” *Id.* at 3. Petitioner further contends that “[i]n concluding that the Petition presents insufficient evidence that the ‘body’ of Zydney’s voice container constitutes an ‘object field,’ the Board implicitly construed the outermost boundaries of the scope of the ‘object field’ element in a manner far narrower than what the intrinsic evidence warrants,” and “[i]n so doing, the Board misapprehended or overlooked Petitioner’s evidence and the ‘broadest reasonable interpretation’ . . . standard that applies in this proceeding.” *Id.* at 4–5; *see id.* at 5–8.

We have considered Petitioner’s contentions but are not persuaded of any error in our Decision. Our Decision was premised not on a rejection of

Petitioner’s proposed formulation of the broadest reasonable interpretation of the “object field” limitation recited in claim 3, but instead on Petitioner’s failure to persuade us that Zydneý’s “body” maps to the recited object field. A prior art reference cannot anticipate “unless [it] discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Moreover, “[a]nticipation requires that a single reference ‘describe the claimed invention *with sufficient precision and detail* to establish that the subject matter existed in the prior art.’” *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1284 (Fed. Cir. 2017) (alteration in original) (quoting *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002)). “For this reason, it has long been understood that ambiguous references do not, as a matter of law, anticipate a claim.” *Id.* But the disclosure of Zydneý relied upon by Petitioner for the object field limitation of claim 3 is, at best, ambiguous.

Indeed, we find the term “body” recited only twice in Zydneý, first, as one of a list of elements that may be “encode[d]” by a “unique identifier,” and second, as an element of a message that may be withheld from transmission to a server during a peer-to-peer embodiment described by Zydneý:²

² As noted in our Decision, Petitioner also asserted in the Petition that “Zydneý teaches elsewhere that the voice container includes a ‘body,’ which is in addition to the voice data properties components shown in Figure 3 [of Zydneý].” Pet. 19 (quoted at Dec. 15–16). Petitioner, however, did not provide any citation for that assertion, and we are unable to locate such teaching “elsewhere” in Zydneý.

*Each message will have a unique identifier that will encode the sending software agents identifier, the destination software agents and non-registered users, the codec used, date and time of the message, the forwarding rules and permissions, **body of the message**, and whether the message was received, played, or deleted without listening. Since a message may go from one peer to another without the messaging server being involved a message will be sent to the server with all of the pertinent information about the message but not the **body**.*

Ex. 1005, 34:4–10 (emphases added). Neither of those two recitations of the term “body” provides “sufficient precision and detail to establish” the object field’s existence in *Zydney* (cf. *Wasica Fin.*, 853 F.3d at 1284), even if construed according to Petitioner’s proposal to “encompass[] a data packet that includes a digitized audio file” (Req. Reh’g 2–3).

We have considered Petitioner’s remaining arguments presented in the Request for Rehearing and likewise conclude that they are unpersuasive of error.

In conclusion, we determine that the Petitioner’s Request for Rehearing does not demonstrate that the Board misapprehended or overlooked any matters raised in the Petition by declining to institute review of the challenged claims.

ORDER

Accordingly, it is

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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