

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC,
Petitioner,

v.

MV3 PARTNERS LLC,
Patent Owner.

IPR2019-00474
Patent 8,863,223 B2

Before JEAN R. HOMERE, JUSTIN T. ARBES, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing
of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Unified Patents, Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–6, 8, 10–21, 23–38, 40, 42–53, and 55–61 (“the challenged claims”) of U.S. Patent No. 8,863,223 B2 (Ex. 1001, “the ’223 patent”). Paper 2 (“Pet.”). We instituted an *inter partes* review pursuant to 35 U.S.C. § 314, as to the challenged claims of the ’223 patent. Paper 9.

An oral hearing was held on May 26, 2020. A transcript of the hearing has been entered into the record. Paper 49 (“Tr.”).

We entered a Final Written Decision pursuant to 35 U.S.C. § 318(a). Paper 50 (“Final Dec.”). Therein, we determined that Petitioner had not demonstrated by a preponderance of the evidence that challenged claims 1–6, 8, 10–21, 23–38, 40, 42–53, and 55–61 of the ’223 patent are unpatentable. Final Dec. 28.

Pursuant to 37 C.F.R. § 42.71(d), Petitioner requests rehearing of our Final Written Decision. Paper 51 (“Pet. Reh’g Req.”). Petitioner asserts that the Final Written Decision should be modified and we should determine that claims 1–6, 8, 10–21, 23–38, 40, 42–53, and 55–61 of the ’223 patent have been proven to be unpatentable. Pet. Reh’g Req. 14. We have considered Petitioner’s Request and, for the reasons that follow, we maintain our conclusion that Petitioner has not demonstrated by a preponderance of the evidence that claims 1–6, 8, 10–21, 23–38, 40, 42–53, and 55–61 of the ’223 patent are unpatentable. Therefore, Petitioner’s Request for Rehearing is *denied*.

¹ Petitioner has changed its name from Unified Patents Inc. to Unified Patents, LLC. Paper 31.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* With this in mind, we address the arguments presented by Petitioner.

III. ANALYSIS

Petitioner's Request for Rehearing contains two principal arguments. First, Petitioner argues that the Board implicitly construed the "determining" limitation of the challenged claims and misapprehended that its implicit claim construction was "undisputed" and supported by the '223 patent's only disclosed embodiment. Pet. Reh'g Req. 1. Further, Petitioner argues that the Board allegedly relied upon this incorrect premise as the sole basis to find that Wang does not teach the "determining" limitation, and thereby erroneously concluded that the challenged claims have not be proven to be unpatentable. *Id.* at 1–2. Second, Petitioner argues that the Board misapprehended the proffered evidence for Petitioner's alternative argument regarding parental controls in concluding that the argument was insufficiently supported by the declaration of Patent Owner's expert. *Id.* at 2. We address these arguments in turn.

a. The Board Properly Evaluated the "Determining" Limitation, and Did not Overlook the Specification of the '223 Patent

Petitioner argues that the Board misapprehended the "determining" limitation by rendering an implicit construction requiring that "the [set-top

box (STB) separately determine whether the user is permitted to provide to the external display device a specific media content received at the mobile device.” Pet. Reh’g Req. 3 (emphasis omitted). Further, Petitioner argues that the Board allegedly mistakenly stated that this implicit construction was “undisputed.” *Id.* Additionally, Petitioner argues that the Board overlooked the Specification’s only embodiment with regard to the “determining” limitation, *id.*, and that the Board relied upon this mistaken premise as the sole basis to find that Petitioner had not shown that the proposed modification of Wang does not teach the claimed “determining” limitation, despite finding that Wang teaches the “authenticating” limitation.² *Id.* at 3–4.

In particular, Petitioner argues that the Board performed no analysis of the stated Specification’s single embodiment, which is contrary to its implicit claim construction. *Id.* at 5. According to Petitioner, the Specification provides no written description for a separate determination of whether a user is permitted to provide content to an external device. *Id.* Instead, Petitioner argues, the Specification merely discloses “authenticating a user so that the user can receive media service,” and “[u]pon receiving content from the networks, the mobile phone 20 transfers the information to the docking station 22, which up-scales the content and displays the content

² Illustrative claim 1 recites a mobile set top box comprising a processor coupled to electronic storage with instructions that, when executed, cause the processor to execute an upconversion process comprising “authenticating the validity of a user associated with the mobile computing device” and “determining, based on the validity of the user, that the received first media content is permitted to be provided to the display device.” Ex. 1001, 8:49–51. We refer to these as the “determining” and “authenticating” limitations. Claims 30 and 32 include the same limitations. *Id.* at 11:1–3, 12:1–3.

on the television 14.” *Id.* (citing Ex. 1001, 3:11–13, 5:40–43, 6:11–12) (emphasis omitted).

Further, Petitioner submits that because Patent Owner was unable to show that the Specification supports the “determining” limitation, Patent Owner did not have possession of the claimed limitation; therefore, the claim limitation cannot be properly construed to incorporate such new matter. *Id.* at 6–10. Furthermore, Petitioner reiterates that Wang’s disclosure of determining whether to provide received media content to an external display, subsequent to the successful authentication of received media content, satisfies the “determining” limitation, consistent with the Specification’s single embodiment with regards to the “determining” limitation. *Id.* at 8–9.

These arguments are not persuasive because they amount to no more than Petitioner expressing its disagreement with our Decision rather than establishing that we overlooked or misapprehended any of the parties’ arguments or evidence. A request for rehearing is not an opportunity to provide rebuttal arguments. 37 C.F.R. § 42.71(d). Rather, it is a medium to point out errors arising from the Board misapprehending or overlooking an issue previously raised in the parties’ papers. *Id.* First, we do not agree with Petitioner that our mere recitation of the “determining” claim limitation is tantamount to an implicit claim construction thereof. As set forth in the Decision, the claim recites the distinct and separate “determining” limitation in addition to the “authenticating” limitation. Final Dec. 16–17. Simply put, the plain claim language recites a STB including a processor performing an upconversion process comprising:

authenticating the validity of a user associated with the mobile computing device, [and]

determining, based on the validity of the user, that the received first media content is permitted to be provided to the display device.

Id. at 5–6.

What we found to be undisputed in the Decision is the plain language of the “determining” limitation, not a construction of the language in that limitation. As noted in the Decision, the claim language plainly requires that the STB separately determine whether the user is permitted to provide to the external display device a specific media content received at the mobile device. *Id.* at 16–17. This is consistent with Petitioner’s view expressed at the hearing. *See* Tr. 20:6–16 (Petitioner acknowledging that the claim recites the “authenticating” step and “a *separate* determining step” where “the determining step happens after the authenticating step” (emphasis added)). Although Petitioner disputes that the Specification adequately supports the “determining” limitation, it is not an issue necessitating review by our mere recitation of the claim language. Further, we are not at liberty to ignore the “determining” limitation, despite its alleged lack of written description, in assessing it during a prior art challenge. As set forth in the Decision, we fully addressed the language of the claims as challenged in the Petition. We are not persuaded that in doing so we misapprehended or overlooked any argument raised by Petitioner. In particular, we noted that Petitioner provided sufficient evidence to show that Wang teaches integrating the authentication feature into the STB to authenticate mobile users to access content. Final Dec. 16–17. However, we found such teaching to fall short of satisfying the separate and distinct “determining”

limitation, as required by the claim. *Id.* at 18. As explained in the Decision, Petitioner and its expert addressed the “authenticating” and “determining” limitations together, even though they are separate limitations of the claim. *Id.* (citing Pet. 39–41; Ex. 1003 ¶ 73). We were unpersuaded by Petitioner’s theory that the “determining” limitation “automatically” occurs by virtue of the authenticating step. *Id.* Furthermore, we noted the evidence of record was insufficient to show by a preponderance of the evidence that the proposed modification of Wang would have taught or suggested “any additional determination beyond authenticating the user.” *Id.* at 19.

b. The Board Properly Concluded That Petitioner’s Parental Controls Contention Was Wholly Unsupported by the Record

Second, Petitioner argues that the Board misapprehended Petitioner’s proffered evidence for an alternative argument that the “determining” limitation would have been obvious over Wang in light of the well-known use in the art of parental controls to separately determine whether received content is permitted to be displayed on an external device. Pet. Reh’g Req. 10–11. According to Petitioner, although the Board’s Decision cited to the declaration of Patent Owner’s expert, the Board failed to give sufficient weight to the testimony regarding how such a well-known implementation of parental controls would complement Wang’s teachings to satisfy the “determining” limitation even under the Board’s narrow claim construction. *Id.* at 12. In particular, Petitioner argues that the conclusion reached by the Board improperly imposed a “bodily incorporation” requirement for including such well-known knowledge into Wang, as opposed to assessing how the well-known use of parental controls in Wang’s STB would constitute a teaching of the separate “determination” limitation. *Id.* at 13.

These arguments are not persuasive because they amount to no more than Petitioner expressing its disagreement with our Decision rather than identifying any arguments or evidence we overlooked or misapprehended. In the Decision, we noted the following:

With respect to Petitioner’s arguments regarding modifying the functionality of Wang, Petitioner asserts that STBs were known to perform authentication prior to allowing media content to be displayed, as well as to implement parental controls to restrict access to content or to facilitate pay-per-view or video-on-demand programming. Pet. 40–41. However, Petitioner has not sufficiently explained any particular modification of Wang’s system (based on the teachings of Wang alone or any of the other cited references, Romano, Herrington, and Bennett) on the record before us to sufficiently account for the determining step. That is, the notion of using parental control to determine whether an authenticated user is permitted to transmit a particular content to an external display device is wholly unsupported by the record before us.

Final Dec. 19–20 (citing Ex. 2013 ¶¶ 16–19).

As explained above, we fully considered the complete record including expert declarations provided by Petitioner’s expert and Patent Owner’s expert. We fully addressed the language of the claims as challenged in the Petition, and addressed the same portions of the prior art presently being argued in the Request for Rehearing. We simply found, based upon our review of the complete record before us, that Petitioner’s alternative argument regarding parental controls was not persuasive by a preponderance of the evidence to show that the challenged claims are unpatentable. As a panel of the Board has explained, “[a] request for rehearing is not an opportunity merely to disagree with the panel’s

assessment of the arguments or weighing of the evidence, or to present new arguments or evidence,” and “mere disagreement with the Board’s analysis or conclusion is not a proper basis for rehearing.” *Sophos, Inc. v. Finjan, Inc.*, IPR2015-01022, Paper 9 at 3–4 (PTAB Jan. 28, 2016).

For the foregoing reasons, we are not persuaded that our Decision overlooked or misapprehended the parties’ arguments and evidence as discussed above.

ORDER

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

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