

IPR2022-00033
Patent No. 10,423,658

Patent Owner's Request for Rehearing

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

MEMORYWEB, LLC
Patent Owner

Patent No. 10,423,658

Inter Partes Review No. IPR2022-00033

PATENT OWNER'S REQUEST FOR REHEARING

LISTING OF EXHIBITS

Exhibit No.	Description
2001	WITHDRAWN
2002	Hyunmo Kang et al., <i>Capture, Annotated, Browse, Find, Share: Novel Interfaces for Personal Photo Management</i> , International Journal of Human-Computer Interaction, 23(3), 315-37 (2007) (“Kang”)
2003	Jaffe et al., <i>Generating Summaries and Visualization for Large Collections of Geo-Referenced Photographs</i> , Proceedings of the 8th ACM SIGMM International Workshop on Multimedia Information Retrieval, MIR 2006, October 26-27, 2006 (“Jaffe”)
2004	RESERVED
2005	RESERVED
2006	Feb. 8, 2022 eBay Order Confirmation for “Apple Aperture 3 Upgrade for Mac Brand New Photography”
2007	Apple Inc. Aperture Software License Agreement
2008	Declaration of John Leone, <i>Cisco Systems, Inc. v. Centripetal Networks, Inc.</i> , IPR2018-01436, EX1005 (July 20, 2018)
2009	Aperture 3 User Manual, http://documentation.apple.com/aperture/usermanual (Archive.org: July 26, 2010)
2010	Aperture 3 User Manual, http://documentation.apple.com/aperture/usermanual (Archive.org: Feb. 17, 2010)
2011	RESERVED
2012	RESERVED

Exhibit No.	Description
2013	Apple, Inc., www.apple.com , (Archive.org: Mar. 12, 2010)
2014	Devin Coldewey, <i>Review: Aperture 3</i> , CrunchGear (https://techcrunch.com/2010/03/19/review-aperture-3/) (last accessed Feb. 2, 2022)
2015	Hilary Greenbaum, <i>Who Made Google's Map Pin?</i> , The New York Times, (Apr. 18, 2011)
2016	Google Developers, <i>Customizing a Google Map: Custom Markers</i> (last accessed Feb. 17, 2022)
2017	KML4Earth, Google Earth/Maps Public Icons, http://kml4earth.appspot.com:80/icons.html (Archive.org May 27, 2012)
2018	Declaration of Angelo J. Christopher
2019	RESERVED
2020	RESERVED
2021	Apple, Inc., "Apple Human Interface Guidelines" (Aug. 20, 2009)
2022	Wilbert O. Galitz, "The Essential Guide to User Interface Design: An Introduction to GUI Design Principles and Techniques," Wiley Publishing, Inc. (3 rd Ed.) (2007)
2023	Transcript of Deposition of Dr. Loren Terveen (Vol. I)
2024	Transcript of Deposition of Dr. Loren Terveen (Vol. II)
2025	Declaration of Rajeev Surati, Ph.D
2026	Transcript of Deposition of Matthew Birdsell
2027	Affidavit of Nathaniel E Frank-White

Exhibit No.	Description
2028	Cambridge English Dictionary, definition of “responsive”
2029	Webster's Third New International Dictionary, definition of “responsive”
2030	RESERVED
2031	RESERVED
2032	eBay Receipt (August 15, 2022)
2033	Jennifer Tidwell, <i>Designing Interfaces</i> , O'Reilly (1 st Ed. 2005)

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<i>Homeland Housewares, LLC v. Whirlpool Corp.</i> , 865 F.3d 1372 (Fed. Cir. 2017)	15
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<i>In re Nuvasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	11
<i>Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.</i> , 868 F.3d 1013 (Fed. Cir. 2017)	15
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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner respectfully requests rehearing of the Board's Final Written Decision ("Decision" or "FWD," Paper 39). As set forth herein, the Decision misapprehended or overlooked, among other things, Patent Owner's deadline for filing evidence objections, arguments and evidence relating to claims 3-4, 8, and 11, and the claim construction arguments.

II. STANDARDS FOR REHEARING

"A party dissatisfied with a decision may file a request for rehearing" identifying "all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." 37 C.F.R. § 42.71(d). The request is reviewed under an abuse of discretion standard. 37 C.F.R. § 42.71(c).

III. REQUESTED RELIEF

Patent Owner respectfully requests rehearing because the Decision: (1) misapprehended the deadline for Patent Owner's objections to evidence, which led it to err in denying Patent Owner's Motion to Exclude; (2) misapprehended and overlooked arguments and evidence relating to claims 3 and 4; (3) misapprehended or overlooked relevant claim language in claims 8 and 11; and (4) misapprehended the Response in finding that Patent Owner was "late" in offering its proposed claim constructions.

IV. ARGUMENT

A. The Board Should Rehear its Denial of Patent Owner's Motion to Exclude

The Board should rehear its denial of Patent Owner's Motion to Exclude (Paper 34; Paper 38) because the Decision misapprehended Patent Owner's deadline for filing objections to Exhibit 1005. The Board should also rehear findings relating to Exhibit 1005's purported authenticity because the Decision misapprehended and overlooked evidence and argument in the Motion to Exclude.

1. The Decision Misapprehended the Deadline for Evidence Objections

The Decision denied Patent Owner's Motion to Exclude without addressing its merits because "[t]he deadline to file objections to Exhibit 1005 was May 30, 2022" and "Patent Owner's objections to Exhibit 1005 were untimely filed" on June 6, 2022. FWD, 84. That is incorrect.

The Decision misapprehended or overlooked the requirements of 37 C.F.R. § 42.64(b)(1), which provides that evidence objections "must be filed within **ten business days** of the institution of the trial." 37 C.F.R. § 42.64(b)(1) (emphasis added). A "business day" is a "a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia." 37 C.F.R. § 42.2. In this case, June 6, 2022 was ten business days after the May 20, 2022 Institution Decision. Paper 12. The Decision also overlooked the fact that May 30, 2022—the last Monday in May

2022—was a Federal holiday. 5 U.S.C. § 6103(a); *see also Bowtech, Inc. v. Mcp Ip, LLC*, IPR2019-00379, Paper 18 at 2 n.2 (PTAB July 24, 2019) (noting that Federal holidays are excluded when calculating the deadline for evidence objections).

The Decision erroneously calculated the deadline for Patent Owner's evidence objections as falling on a Federal holiday based on calendar days instead of business days. Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner's objections were timely filed within 10 business days of the May 20, 2022 Institution Decision. Paper 14. Indeed, Petitioner never argued that Patent Owner's objections were untimely. *See* Paper 35. Accordingly, the Board should grant rehearing to address the merits of Patent Owner's Motion to Exclude. And if the Board grants Patent Owner's Motion to Exclude on rehearing (which it should), it should vacate the Decision's unpatentability findings as they are predicated on Exhibit 1005. *See* FWD, 9.¹

2. The Decision Misapprehended and Overlooked Testimony Regarding the Purported Authenticity of Ex. 1005

Although the Decision erroneously declined to address Patent Owner's Motion to Exclude, it made at least one finding relevant to Exhibit 1005's purported authenticity. Specifically, the Decision states that "Mr. Birdsell and Dr. Terveen

¹ At a minimum, granting rehearing to address the arguments and evidence in Patent Owner's Motion to Exclude will better position the record for appellate review.

individually compared Ex. 1005 to the HTML file set and found no discrepancies.” FWD, 46 (citing Ex. 2026, 41:14-16; Ex. 2023, 61:13-17). As set forth below and in Patent Owner's Motion to Exclude, the Decision misapprehended Mr. Birdsell and Dr. Terveen's testimony and overlooked admissions demonstrating that they did not compare the entirety of Ex. 1005 to the HTML file set.

The cited portion of Mr. Birdsell's deposition testimony does not support the Board's finding that he compared Exhibit 1005—which contains over 1,120 pages—to the HTML file set. FWD, 46 (citing Ex. 2026, 41:14-16). Rather, Mr. Birdsell testified that he merely “*spot-checked* [Ex. 1005] against the files that were on the disk and in the app” and could not “speak to the chain of custody” of the DVD he used. Ex. 2026, 41:11-25 (emphasis added). Likewise, Dr. Terveen testified that he “did not check all 1122 pages” and only “spot-checked” unidentified portions of Ex. 1005 against a DVD. Ex. 2023, 61:9-17; *see also id.*, 62:9-12. Neither Mr. Birdsell nor Dr. Terveen could identify who created Ex. 1005. Paper 34, 3-4; Paper 38, 2-3; Ex. 2026, 20:5-6; Ex. 2023, 57:10-59:10. Just as one who only “spot-checks” a deck of cards cannot know that the deck has the correct 52 cards, Dr. Terveen and Mr. Birdsell could not have known whether Exhibit 1005 is a complete and accurate copy of the HTML files. Paper 38, 2-3.

The Decision also states that “each page of Ex. 1005 has the file path for each file located in the bottom left hand corner and the file path is consistent with the file

path given above for the help files.” FWD, 46. But there is no evidence that anyone performed such a comparison, and even if someone did and found that the listed file paths were consistent with the HTML file set, that does not mean that the content of Ex. 1005 is consistent with the HTML file set. It was not Patent Owner's burden to identify discrepancies between Exhibit 1005 and the A3UM HTML file set as suggested in the Decision (FWD, 46), it was Petitioner's burden to demonstrate that Ex. 1005 is what Petitioner claims it is. FED. R. EVID. 901; *Inductev Inc. v. Witricity Corp.*, No. IPR2021-01166, Paper 35 at 53 (PTAB Dec. 20, 2022).

B. The Board Should Rehear its Unpatentability Findings for Dependent Claims 3-4

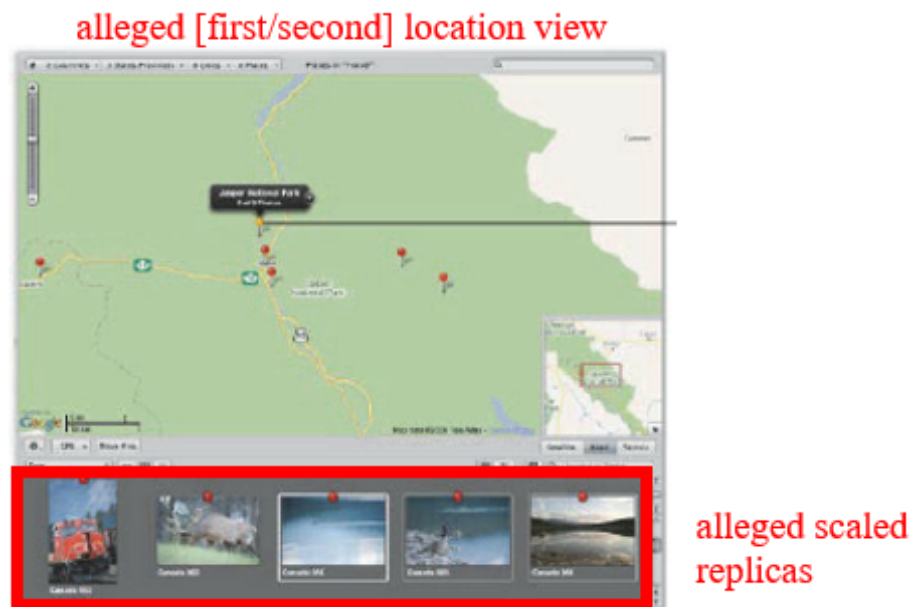
Claims 3 and 4 depend from claim 1 and recite, *inter alia*, “responsive to a click or tap of a first one of the displayed scaled replicas in the [first/second] location view, displaying [1] a first digital photograph . . . in the [first/second] location view and [2] a [first/second] map image.” Stated another way, claims 3 and 4 require that two things are displayed responsive to a click tap of a scaled replica: (1) a first digital photograph and (2) a [first/second] map image.

As set forth below, the Decision misapprehended or overlooked several matters that warrant rehearing. First, the Decision misapprehended Patent Owner's arguments regarding the Petition's failure to address the claim requirement of “displaying a first digital photograph . . . in the [first/second] location view.” Second,

the Decision misapprehended the Petition's proposed modification to A3UM and overlooked Patent Owner's argument that the Reply improperly introduced a new obviousness theory. Third, the Decision overlooked evidence of non-obviousness.

1. Factual Background

In connection with claim 1, the Petition identified the A3UM screenshot reproduced below as the alleged "[first/second] location view." Pet., 47-50.



Ex. 1005, 437 (annotated)

The Petition identified the "thumbnails of digital files matching the location in the Browser pane," annotated in red above, as allegedly corresponding to the claimed "scaled replica of each of the digital photographs and videos in the [first/second] set of digital photographs and videos." Pet., 48-49.

In connection with claims 3 and 4, the Petition identified A3UM's "small Map Pane" in the "Metadata Inspector" as the alleged "[first/second] map image"

required in claims 3 and 4. Pet., 76-77. The Petition argued that “it would have been obvious to modify A3UM such that selecting a photo in the Browser, in addition to displaying that photo in the Viewer, would display A3UM’s Map Pane at the bottom of the Inspector pane.” *Id.*, 78.

2. The Decision Misapprehended Patent Owner’s Arguments Regarding the Petition’s Failure to Address All Limitations

The Petition argued that A3UM discloses or renders obvious displaying the “[first/second] map image” in claims 3 and 4 but failed to address where A3UM purportedly discloses “displaying a first digital photograph . . . in the [first/second] location view.” POR, 80 (citing Pet., 75-78); POSR, 24-25. The claim term “first digital photograph” does not appear *anywhere* in the Petition aside from in a reproduction of claims 3 and 4. Pet., 75.

The Decision acknowledged Patent Owner’s argument that “the Petition fails to address all of the limitations of claims 3 and 4,” but did “not agree that Petitioner’s alternative obviousness theory fails to address all of the limitations.” FWD, 82 (citing POR, 80). In particular, the Decision pointed to Petitioner’s alternative obviousness theory in which “selecting a photo in the Browser, in addition to displaying that photo in the Viewer, would display A3UM’s Map Pane at the bottom of the Inspector pane.” FWD, 83 (citing Pet., 83). The Decision misapprehended Patent Owner’s argument: Patent Owner did not argue that the Petition failed to

address the “[first/second] map image” requirement; it argued that the Petition failed to address the “displaying a first digital photograph . . . in the [first/second] location view” requirement of claims 3 and 4. POR, 80; POSR, 24-25.

Consistent with the Petition's failure to do so, the Decision does not identify whether or how A3UM purportedly meets the requirement of “displaying a first digital photograph . . . in the [first/second] location view” responsive to a click or tap of a scaled replica in the [first/second] location view. FWD, 75-84.

3. The Decision Misapprehended the Obviousness Argument in the Petition and Overlooked Petitioner's Improper Reply Argument

The Decision also misapprehended Petitioner's obviousness theory for the same limitation. The Petition did *not* propose modifying A3UM so that a click or tap of a thumbnail in the Browser would cause a digital photograph to be displayed. POR, 79-82; POSR, 24-27. That argument appeared for the first time in Petitioner's Reply. POSR, 25-27.

Dr. Terveen testified in his declaration that “[s]electing a thumbnail in the Browser then prompts the display of the original digital image in the Viewer, which replaces the Places map view.” Ex. 1003, ¶ 194; POR, 80-81; POSR, 26. But Dr. Terveen admitted during cross-examination that selecting a thumbnail in the Browser does *not* replace the Places map view. Ex. 2023, 152:10-154:22; Ex. 2024, 323:7-324:16; POR, 80-82; POSR, 25-26. Petitioner did not dispute that Dr.

Terveen's declaration was wrong; it merely cast aside Dr. Terveen's error as "irrelevant." FWD, 81; Reply, 32. But Dr. Terveen's error *is* relevant because it demonstrates that he based his opinion on the erroneous premise that A3UM already *discloses* selecting a thumbnail in the Browser replaces the Places map view.

The Petition's proposed modification to A3UM only related to the "[first/second] map image" limitation – not the "displaying a first digital photograph . . . in the [first/second] location view" limitation. Pet., 78-80. Dr. Terveen made clear that "the A3UM technique of selecting the thumbnail in the Browser to prompt display of the full image *would be retained*" in Petitioner's proposed modification. Ex. 1003, ¶ 195 (emphasis added); POSR, 26. In other words, Dr. Terveen presupposed that selecting a thumbnail in the Browser replaces the Places map and that this functionality "*would be retained*" in the proposed modification; not that this functionality would be added in the modification. *Id.* The Decision misapprehended or overlooked Dr. Terveen's testimony unambiguously demonstrating that Petitioner did *not* propose modifying A3UM so that selecting an image in the Browser would replace the Places map in the initial Petition. POSR, 26.

The Decision's summary of the parties' briefing cited Patent Owner's argument that Petitioner's Reply raised a new obviousness theory. FWD, 82 (quoting POSR, 26). But that is all the Decision did. Nowhere did the Decision address the merits of Patent Owner's argument. FWD, 82-84. Despite Patent Owner's argument,

the Decision makes no finding as to where the Petition argued that it would have been obvious to modify A3UM so that selecting an image in the Browser replaces the Places map. *Id.* That is because the Petition made no such argument. POSR, 26.

While Patent Owner presented evidence that Petitioner's new modification would ***not*** have been obvious (*infra*, § IV.B.4), that does not mean that the Petition proposed such a modification. Patent Owner's Sur-Reply explicitly qualified this evidence as being responsive to a new theory. POSR, 26 ("even if Petitioner's new argument is considered . . ."). For example, Dr. Surati testified:

While I understand they have not done so, to the extent Petitioner or Dr. Terveen were to assert that it would be obvious to modify A3UM such that selecting an image in the Browser would cause a full-size image to be displayed and replace the map in the Places view, I disagree.

Ex. 2025, ¶ 213 (emphasis added). Patent Owner addressed this issue in anticipation of Petitioner potentially mischaracterizing the Petition in view of Dr. Terveen's admissions contradicting his declaration testimony. *Compare* Ex. 1003, ¶¶ 194-195 with EX2023, 152:10-154:22; EX2024, 323:7-324:16.

4. The Decision Overlooked Evidence Refuting Petitioner's New Obviousness Theory

Even if the Petition proposed modifying A3UM so that selecting a thumbnail in the Browser would replace the Places map (which it did not), the Decision

overlooked evidence that a POSITA would not make that modification to A3UM. POSR, 26-27. As explained by Dr. Surati, in A3UM's Places view, there is a functional relationship between the Places map and the Browser where (1) selecting a pin on the map highlights the corresponding image in the Browser and (2) selecting an image in the Browser highlights the corresponding pin. POSR, 26-27; Ex. 2025, ¶¶ 213-216. Modifying A3UM so that selecting a thumbnail in the Browser replaces the Places map would destroy that functional relationship. *Id.* For example, the user would not be able to select a different pin on the map and investigate associated images because the map would have been replaced. *Id.*

The Decision cited this evidence in its summary of the parties' respective arguments but overlooked the evidence in its substantive analysis. FWD, 82-84. The Federal Circuit has instructed that "it is not adequate to summarize and reject arguments without explaining why the PTAB accepts the prevailing argument." *In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016); *see also Aqua Prod., Inc. v. Matal*, 872 F.3d 1290, 1325 (Fed. Cir. 2017) (agencies "must take account of all the evidence of record, including that which detracts from the conclusion the agency ultimately reaches"). The Board should grant rehearing to address this evidence that it overlooked or misapprehended.

C. The Board Should Rehear its Unpatentability Findings for Dependent Claims 8 and 11

Claims 7 and 10 recite, *inter alia*, “responsive to a click or tap of the [first/second] person selectable thumbnail image, displaying a [first/second] person view.” Patent Owner demonstrated that the phrase “responsive to” requires a cause-effect relationship, and the Decision did not find otherwise. POR, 19-24; POSR, 9-11. Claims 8 and 11 depend from claims 7 and 10, respectively, and recite “wherein the displaying the [first/second] person view further includes displaying a [first/second]-person-location selectable element.”

The Decision acknowledged Patent Owner's argument that the alleged [first/second]-person-location selectable element in A3UM is not displayed *responsive to* a click or tap of the [first/second] person selectable thumbnail image under either party's proposed construction for the phrase “responsive to.” FWD, 70, 72; POR, 72-73; POSR, 23-24. But the Decision found Patent Owner's “responsive to” argument irrelevant because “all claims 8 and 11 require is ‘that *the person view* further *includes* displaying the specified element—it does not require independently displaying those elements.’” FWD, 74 (quoting Reply, 30).

The Decision misapprehended or overlooked the surrounding claim language. Contrary to the Board's finding in the Decision, claims 8 and 11 do *not* say that the [first/second] person view “further includes displaying” the [first/second]-person-

location selectable element. FWD, 74. Instead, claim 8 recites “wherein *the displaying* the first person view *further includes displaying* a first-person-location selectable element.” The phrase “*the displaying* the first person view” finds antecedent basis from the step of “displaying a first person view” recited in claim 7. In turn, claim 7 requires the “displaying a first person view” be “responsive to a click or tap of the first person selectable thumbnail image.” Taken together, claim 8 clearly requires that “displaying a first-person-location selectable element” is part of the same transaction as “displaying a first person view,” which must be “responsive to a click or tap of the first person selectable thumbnail image.” In other words, the “displaying a first-person-location selectable element” in claim 8 must be “responsive to a click or tap of the first person selectable thumbnail image” because it is part of the “displaying a first person view” in claim 7. POSR, 23.

The Decision's reading of claims 8 and 10 overlooked or misapprehended the import of the phrase “the displaying,” which must have meaning because “[i]t is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.” *Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017). What is more, the Decision seemingly acknowledges that the phrase “responsive to” in claim 7 “pertains to” displaying (i) the name associated with the first person and (ii) a scaled replica of each of the digital photographs and videos in the third set of digital photographs.” FWD, 73-74. Just as

displaying the name and scaled replica is “responsive to” the click or tap, displaying the “[first/second]-person-location selectable element” is “responsive to” the click or tap. There is no reason to treat claim 8 differently than claim 7.

D. The Decision Misapprehended Patent Owner's Claim Construction Proposals

To the extent the Decision declined to adopt Patent Owner's constructions because it understood that Patent Owner was required to show “good cause” for proposing constructions at a “late stage in this proceeding,” the Decision misapprehended the Response. FWD, 12.

Patent Owner's Response noted that Petitioner applied its view of the claims' plain and ordinary meaning in the Petition. POR, 15 (citing Pet., 12). Patent Owner agreed “that the claims should be afforded their plain and ordinary meaning” but offered “a discussion of that meaning” in case the Board determined that claim construction was “necessary to resolve Petitioner's patentability challenges.” *Id.* The Response proposed claim constructions. POR, 15-27. Petitioner responded and offered counterproposals. Reply, 1-6. With the parties' disputes crystallized, Patent Owner's Sur-Reply reiterated its original proposed constructions. POSR, 8-13.

Patent Owner did not propose its claim constructions “late” in this proceeding – it proposed them in the Response. FWD, 12; POR, 15-27. The Response's reference to “plain and ordinary meaning” did not negate Patent Owner's proposed

constructions, which reflect what the plain and ordinary meaning *is*. POR, 15. Similarly, Patent Owner's qualification that claim construction might not be "necessary to resolve Petitioner's patentability challenges" was merely an acknowledgement that the Board would not need to construe any terms, for example, if it found that A3UM was not prior art or that a POSITA would not combine A3UM and Belitz. POR, 28-65; *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

When the parties raise a claim construction dispute, the Board "must resolve such disputes." *Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1375 (Fed. Cir. 2017). The Board construes terms to resolve disputes even where both parties agreed that no constructions were necessary. *See, e.g., Google LLC v. Ecofactor, Inc.*, IPR2021-00054, Paper 35 at 10 (PTAB Apr. 18, 2022). To say that Patent Owner's proposed constructions were "late" when Patent Owner explicitly proposed them in its Response, Petitioner responded in its Reply, and Patent Owner argued for the same constructions in its Sur-Reply reflects a misapprehension of the conduct of this proceeding and warrants rehearing.

V. CONCLUSION

For the reasons set forth herein, Patent Owner respectfully requests rehearing and a finding that claims 1-15 of the '658 patent are not unpatentable.

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Patent No. 10,423,658

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Respectfully submitted,

Dated: June 16, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Request for Rehearing was served on June 16, 2023, upon the following parties via electronic service:

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