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Paper 9
Entered: November 1, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC. and SQUARE ENIX, INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01291
Patent 6,728,766 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and JESSICA C. KAISER, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
Partial Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Ubisoft, Inc. and Square Enix, Inc. ("Petitioner")[1] filed a Petition to institute *inter partes* review of claims 1, 3, 7, 9, 13, and 15 of U.S. Patent No. 6,728,766 B2 ("the '766 patent") pursuant to 35 U.S.C. § 311–319. Paper 1 ("Pet."). Uniloc USA, Inc. and Uniloc Luxembourg S.A., ("Patent Owner" or "Uniloc")[2] timely filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We have authority under 35 U.S.C. § 314.

For the reasons that follow, we institute *inter partes* review regarding claims 1 and 3 of the '766 patent.

I. BACKGROUND

A. RELATED MATTERS

Petitioner identifies the '766 patent as the subject matter of the district court cases pending in the U.S. District Court for the Eastern District of Texas (Case No. 2:16-cv-00397-RWS and Case No. 2:16-cv-00872-RWS). Pet. 32; Ex. 1006; Ex. 1007.

B. THE '766 PATENT (EX. 1001)

The '766 patent is titled "Methods, Systems and Computer Program Products for License Use Management on a Network." Ex. 1001, at [54]. The '766 patent relates in particular to application program management on

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[1] Petitioner identifies additional real parties-in-interest, such as Ubisoft Entertainment, S.A., Square Enix of America Holdings, Inc. and Square Enix Holdings Co., Ltd. Pet. 32.

[2] Although the Preliminary Response initially identifies only Uniloc Luxembourg S.A. as the patent owner (Prelim. Resp. 1), Patent Owner's Mandatory Notice identifies both Uniloc USA, Inc. and Uniloc Luxembourg S.A. as Patent Owner in this case. Paper 5, 1.

a computer network. *Id.* at 1:22–24. According to the '766 patent, control over software, such as application programs, is a challenge with respect to "maintaining proper licenses for existing software and deploying new or updated application programs across the network." *Id.* at 1:45–57. In particular, the '766 patent states that "[a] distributed network environment with a plurality of client stations and a plurality of different users accessing the applications from different clients increases the challenge associated with managing license use to [ensure] compliance with limitations established by software designers." *Id.* at 3:28–32. According to the '766 patent, management of license use for a network is provided as follows:

> License management policy information for a plurality of application programs is maintained at a license management server. Requests are received at the license management server for a license availability of a selected one of the plurality of application programs from a user at a client. The license management server determines the license availability for the selected one of the plurality of application programs for the user based on the maintained license management policy information and provides an unavailability indication to the client responsive to the selection if the license availability indicates that a license is not available for the user or an availability indication if the licensed availability indicates that a license is available for the user.

Id. at 5:39–52.

C. ILLUSTRATIVE CLAIM

Challenged claims 1, 7, and 13 of the '766 patent are independent. Illustrative claim 1 is reproduced below.

1. A method for management of license use for a

network comprising the steps of:

maintaining license management policy information for a plurality of application programs at a license management server, the license management policy information including at least one of a user identity based policy, an administrator policy override definition or a user policy override definition;

receiving at the license management server a request for a license availability of a selected one of the plurality of application programs from a user at a client;

determining the license availability for the selected one of the plurality of application programs for the user based on the maintained licenses management policy information;

providing an unavailability indication to the client responsive to the selection if the license availability indicates that a license is not available for the user or an availability indication if the licensed availability indicates that a license is available for the user.

Ex. 1001, 14:64–15:16.

D. Asserted Reference and Ground of Unpatentability

Petitioner asserts one ground of unpatentability based on the anticipation of claims 1, 3, 7, 9, 13, and 15 by U.S. Patent No. 5,758,069, issued to Olsen (Ex. 1002, "Olsen").

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142–46 (2016). Consistent with that standard, claim terms also are given their ordinary and

customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). There are, however, two exceptions to that rule: "1) when a patentee sets out a definition and acts as his own lexicographer," and "2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution." *See Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

Petitioner proposes constructions for terms drafted in means-plus-function format, recited in independent claim 7. Pet. 3–5. Patent Owner responds to Petitioner's constructions and challenges the structures that Petitioner identifies for each term recited in claim 7. Prelim. Resp. 5–11. Neither party addresses the terms recited in claim 13. As detailed below, we analyze the claim construction for only those terms needed to make the determination whether to institute *inter partes* review. In our analysis, we recognize that construing a means-plus-function limitation requires first defining the particular function of the limitation and then identifying the corresponding structure for that function in the specification. *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34 (Fed. Cir. 2004). Further, under 37 C.F.R. § 42.104(b)(3), "the petition must set forth . . . [h]ow the challenged claim is to be construed," including identifying "the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function," where the claim to be construed contains a "means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. § 112(f)."

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