

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BITDEFENDER INC.,
Petitioner,

v.

UNILOC USA, INC.,
Patent Owner.

Case IPR2017-01315
Patent 6,510,466 B1

Before MIRIAM L. QUINN, ROBERT J. WEINSCHENK, and
JESSICA C. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

BitDefender Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1, 2, 7–9, 15–17, 22–24, 30, and 35–37 of U.S. Patent No. 6,510,466 B1, issued on January 21, 2003 (Ex. 1001, “the ’466 patent”). Paper 1 (“Pet.”). Uniloc USA, Inc. (“Patent Owner”)¹ filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Taking into account the arguments presented in Patent Owner’s Preliminary Response, we determined the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1, 2, and 7–9 of the ’466 patent, but not in challenging claims 15–17, 22–24, 30, and 35–37. Pursuant to § 314, we instituted this *inter partes* review on November 1, 2017, as to fewer than all of the claims challenged in the Petition. Paper 7 (“Dec. on Inst.”). On November 13, 2017, Petitioner requested rehearing as to the claims for which review was not instituted (Paper 9), and we denied Petitioner’s rehearing request (Paper 10, “Dec. on Reh’g”).

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 11, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 13, “Pet. Reply”). An oral hearing was held on August 7, 2018, and a transcript of the hearing is included in the record. Paper 22 (“Tr.”).

After all substantive briefing was complete, but before the oral hearing, the United States Supreme Court held that a decision to institute

¹ Patent Owner’s Updated Mandatory Notices state that the real parties-in-interest are the owner, Uniloc 2017 LLC, and its licensees, Uniloc USA, Inc. and Uniloc Licensing USA LLC. Paper 23, 1.

under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). In accordance with *SAS*, we issued an Order modifying our Decision on Institution to include review of all challenged claims and all grounds presented by Petitioner in its Petition. Paper 14. Patent Owner waived any further briefing on the newly-added claims. Paper 15, 2. Petitioner, however, requested authorization to file a supplemental brief to respond to the Decision on Institution as to the newly-added claims. *Id.* at 3. As discussed further below, the order authorizing that brief provided instructions as to the proper scope of Petitioner’s Institution Response Brief. *Id.* at 3–4. Petitioner filed its Institution Response Brief on June 4, 2018. Paper 17 (“Inst. Resp. Br.”).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1, 2, 7–9, 15–17, 22–24, 30, and 35–37 of the ’466 patent. For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, and 7–9 are unpatentable under § 103(a), but Petitioner has not demonstrated by a preponderance of the evidence that claims 15–17, 22–24, 30, and 35–37 are unpatentable under § 103(a).

II. BACKGROUND

A. *The ’466 Patent (Ex. 1001)*

The ’466 patent relates to management of application programs on a network including a server supporting client stations. Ex. 1001, at [57]. The ’466 patent states that user mobility and hardware portability are provided

by establishing a user desktop interface responsive to a user login request. *Id.* Responsive to a request from the user on the user desktop screen at the client, a selected application program is provided from the server to the client. *Id.*

Figure 1 of the '466 patent is reproduced below.

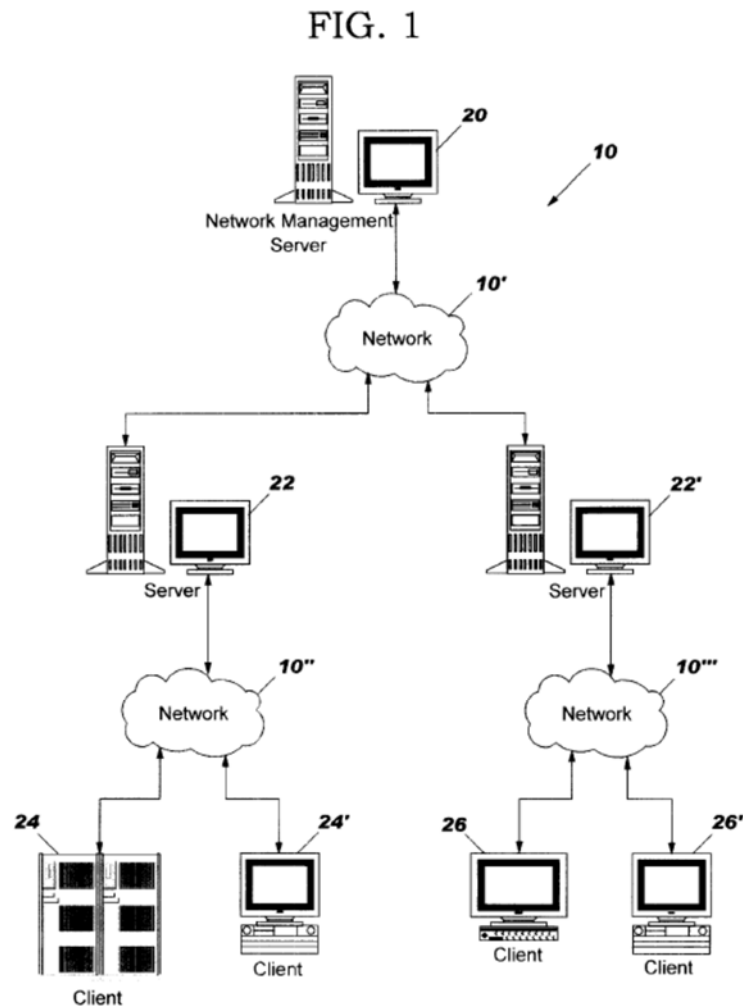


Figure 1 illustrates a computer network according to an embodiment of the invention. *Id.* at 6:57–60. In particular, network management server 20 is connected to on-demand servers 22 and 22' which are in turn connected to client stations 24 and 24' and 26 and 26' respectively. *Id.* at 6:60–7:6.

Figure 8 of the '466 patent is reproduced below.

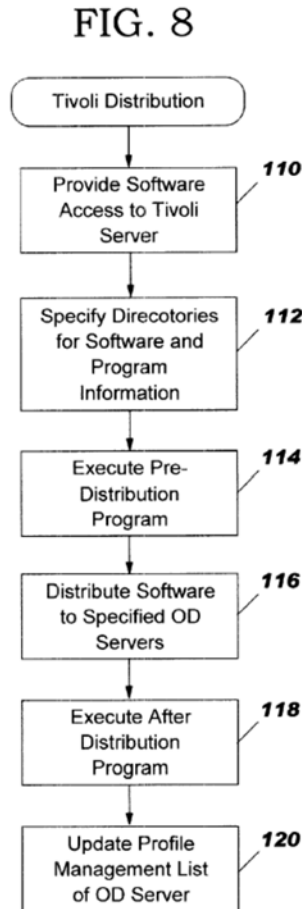


Figure 8 is a flowchart illustrating operations for application program distribution and execution in a network management server environment. *Id.* at 6:28–31. In particular, in block 110, an application program to be distributed is placed by a system administrator on a disk or storage device at a network management server such as a Tivoli server. *Id.* at 17:52–55. At block 112, the application program source and destination programs are specified, and a pre-distribution program is run (if specified) at block 114. *Id.* at 17:55–60. The application program is then distributed to the on-demand servers at block 116, and any specified after-distribution programs are executed at block 118. *Id.* at 17:60–18:7.

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