UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UBISOFT, INC.,
Petitioner,

v.

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

_____

Case IPR2017-01828
Patent 6,489,974 B1

_____

Before SALLY C. MEDLEY, BARBARA A. BENOIT, and
JESSICA C. KAISER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Ubisoft, Inc. ("Petitioner")[1] filed a Petition for *inter partes* review of claims 1, 2, 4, 8, 12, 13, 15, and 19 of U.S. Patent No. 6,489,974 B1 (Ex. 1001, "the '974 patent"). Paper 2 ("Pet."). Uniloc USA, Inc. and Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response.[2] Paper 6 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "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." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented does not show there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1, 2, 4, 8, 12, 13, 15, and 19 of the '974 patent.

A. Related Matters

The parties state that the '974 patent is the subject of a court proceeding styled *Uniloc v. Ubisoft, Inc.*, Case No. 2:16-cv-00781 (E.D. Tex.). Pet. 53[3]; Paper 3, 2.

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[1] The Petition identifies Ubisoft, Inc. as a real party-in-interest, and Ubisoft Entertainment, S.A. as a "potential real party-in-interest." Pet. 51.

[2] Patent Owner identifies Uniloc Luxembourg S.A. and exclusive licensee Uniloc USA, Inc. as real parties-in-interest. Paper 3, 1.

[3] Petitioner did not number the pages of its Petition. For purposes of this Decision, page numbering of the Petition begins at the page with the section styled "I. INTRODUCTION."

B. The '974 Patent

The '974 patent is directed to a method and apparatus for notifying user input situations and execution terminations in asynchronously executing tasks in multitasking computer environments. Ex. 1001, 1:10–13. Notification of an executing object becoming idle is provided in a multitasking environment. *Id*. Abstract. As the object executes, the user can interface with a second object. *Id*. When the executing object becomes accessible, a buoy icon object is suddenly displayed. *Id*. at 4:38–41, Abstract. The buoy icon has the name of the object as well as a pointer line extending from the buoy icon to the accessible object. *Id*. Abstract, Fig. 2. Figure 2 is illustrative and reproduced below.
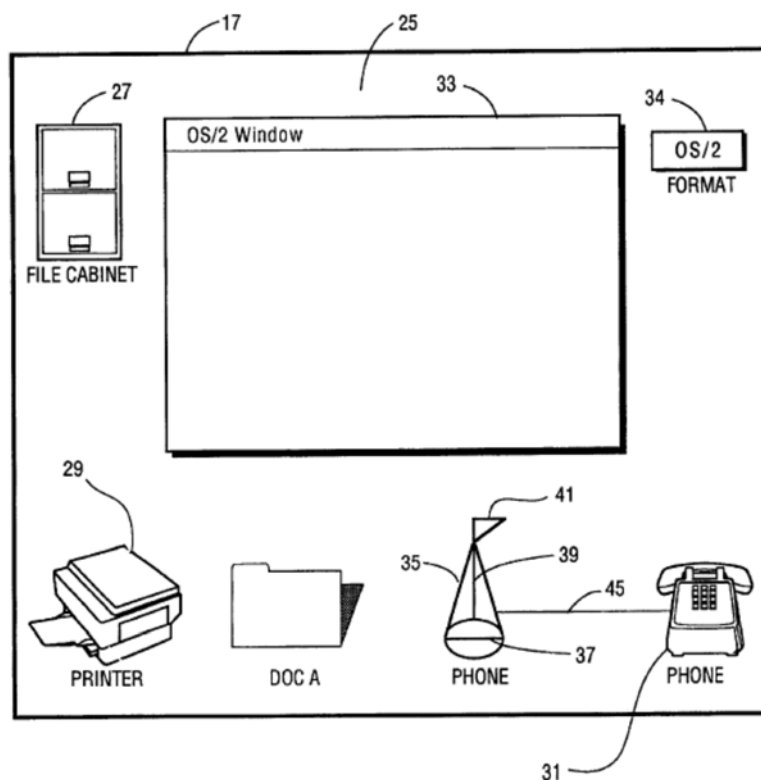

FIG 2

Figure 2 shows a desktop 25 on screen 17. *Id*. at 3:52–53. Desktop 25 includes plural icons representing plural objects. A focused object

presents a window 33 and is enabled to receive user inputs. *Id.* at 3:53–62.
A user can work within the focused object 33 while waiting for another
object, such as phone object 31, to execute (e.g., to send a fax). *Id.* at 4:4–
12. When the execution of the phone object 31 reaches a step where a user
input is required, a buoy icon 35 is displayed on the desktop to notify the
user that the specified object is available for user input. *Id.* at 4:13–28.

C. Illustrative Claims

Petitioner challenges claims 1, 2, 4, 8, 12, 13, 15, and 19 of the '974
patent. Claims 1 and 12 are independent claims and are reproduced below
with pertinent language italicized:

> 1. A method that is implemented on a multitasking computer
> that comprises first and second objects, said method providing
> notification of a status of said first object on said computer,
> comprising the steps of:
>
> a) providing a representation of said first object on a user
> interface of said computer, with the representation supporting
> user interaction with said first object on said user interface of
> said computer;
>
> b) executing said first object on said computer;
>
> c) while said first object is executing, enabling said
> second object so as to support user interaction with said second
> object on said user interface of said computer;
>
> d) while said second object is enabled so as to support
> user interaction, determining when said first object ceases
> executing;
>
> e) *providing a notification on said user interface when
> said first object ceases executing by suddenly displaying a
> notification icon on said user interface of said computer while
> maintaining the representation of the first object*, said
> notification icon being in a location that is separate from the
> representation of said first object on said user interface.

Id. at 9:62–10:17.

12. An apparatus for use with a multitasking computer, said computer comprising first and second objects, said apparatus providing notification of a status of said first object on said computer, comprising:

a) means for providing a representation of said first object on a user interface of said computer, with the representation supporting user interaction with said first object on said user interface of said computer;

b) means for executing said first object on said computer;

c) means for enabling said second object so as to support user interaction with said second object on a user interface of said computer while said first object is executing;

d) means for determining when said first object ceases executing while said second object is enabled so as to support user interaction;

e) means *for providing a notification on said user interface when said first object ceases executing by suddenly displaying a notification icon on said user interface of said computer while maintaining the representation of the first object*, said notification icon being in a location that is separate from the representation of said first object on said user interface.

Id. at 11:13–36.

D. *Asserted Ground of Unpatentability*

Petitioner asserts that claims 1, 2, 4, 8, 12, 13, 15, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Inside Macintosh, Volume VI ("Inside Macintosh") (Ex. 1002). Pet. 1.

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