UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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Case IPR2017-01839
Patent 6,324,578 B1

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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. and Square Enix, Inc. ("Petitioner")[1] filed a Petition for *inter partes* review of claims 1–18, 20–33, and 35–46 of U.S. Patent No. 6,324,578 B1 (Ex. 1001, "the '578 patent"). Paper 3 ("Pet."). Uniloc USA, Inc. and Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response.[2] Paper 7 ("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 1–18, 20–33, and 35–46 of the '578 patent.

A. Related Matters

The parties indicate that the '578 patent is the subject of several court proceedings. Pet. 68; Paper 4, 2.

B. The '578 Patent

The '578 patent relates to application program management on a computer network. Ex. 1001, 1:22–24. In particular, the invention is

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[1] The Petition identifies Ubisoft, Inc. and Square Enix, Inc. as real parties-in-interest, and that "[a]dditional real parties in interest may include Ubisoft Entertainment, S.A., Square Enix of America Holdings, Inc., and Square Enix Holdings Co., Ltd." Pet. 68.
[2] Patent Owner identifies Uniloc Luxembourg S.A. and exclusive licensee Uniloc USA, Inc. as real parties-in-interest. Paper 4, 1.

directed to methods and systems for management of configurable application programs on a computer network which allows a mix of user and system administrator defined configurable preferences to be associated with specific application programs. *Id*. at 3:39–45. An application program having configurable preferences and authorized users is installed on a server. *Id*. at 4:24–26. An application launcher program associated with the application program is distributed to a client. *Id*. at 4:26–28. A user set of preferences associated with an authorized user executing the application launcher program and an administrator set of preferences is obtained. *Id*. at 4:28–33. The application program is then executed using obtained user set and administrator set of preferences. *Id*. at 4:33–39.

C. Illustrative Claims

Petitioner challenges claims 1–18, 20–33, and 35–46 of the '578 patent. Claims 1, 15, 16, 17, 31, 32, and 46 are independent claims. Claims 1 and 17 are reproduced below.

> 1. A method for management of configurable application programs on a network comprising the steps of:
>
> installing an application program having a plurality of configurable preferences and a plurality of authorized users on a server coupled to the network;
>
> distributing an application launcher program associated with the application program to a client coupled to the network;
>
> obtaining a user set of the plurality of configurable preferences associated with one of the plurality of authorized users executing the application launcher program;
>
> obtaining an administrator set of the plurality of configurable preferences from an administrator; and
>
> executing the application program using the obtained user set and the obtained administrator set of the plurality of

configurable preferences responsive to a request from the one of the plurality of authorized users.

Id. at 14:63–15:13.

17. An application management system for a network comprising:

means for installing an application program having a plurality of configurable preferences and a plurality of authorized users on a server coupled to the network;

means for distributing an application launcher program associated with the application program to a client coupled to the network;

means for obtaining a user set of the plurality of configurable preferences from one of the plurality of authorized users executing the application launcher program;

means for obtaining an administrator set of the plurality of configurable preferences from an administrator; and

means for providing an instance of the application program and a stored user set and the administrator set of the plurality of configurable preferences for use in executing the application program responsive to a request from the one of the plurality of authorized users.

Id. at 17:23–17:41.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–18, 20–33, and 35–46 are unpatentable based on the following grounds (Pet. 1):

References	Basis	Challenged Claims
Kasso[3] and JavaStation[4]	§ 103(a)	1, 6–9, 11–17, 22–25, 27–32, 37–40, and 42–46
Kasso, JavaStation, and Sanders[5]	§ 103(a)	2–5, 10, 18, 20, 21, 26, 33, 35, 36, and 41

II. DISCUSSION

A. Claim Construction

Pursuant to 37 C.F.R. § 42.100(b), Petitioner avers that the '578 patent will expire on December 14, 2018, within 18 months of entry of the Notice of Filing Date Accorded the Petition (Paper 6), and requests that the '578 claims be construed under *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005). Pet. 2. Patent Owner does not dispute that the '578 patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to the Petition. Nor does Patent Owner oppose a *Phillips* type construction. Prelim. Resp. 2–13. For purposes of this decision, we *grant* Petitioner's request and construe the claims as though the '578 patent has expired.

For claims of an expired patent, the Board's claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution

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[3] U.S. Patent No. 5,832,505, issued Nov. 3, 1998 (Ex. 1002) ("Kasso").
[4] *JavaStation Software Environment for Developers* (JSE 1.0.2) (June 1997) (Ex. 1003) ("JavaStation").
[5] U.S. Patent No. 5,734,831, issued Mar. 31, 1998 (Ex. 1004) ("Sanders").

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