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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01993
Patent 9,414,199 B2

Before MIRIAM L. QUINN, KERRY BEGLEY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, No. 16-969, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '199 patent is unpatentable. Paper 10, 10–43. In particular, we concluded that Petitioner showed a reasonable likelihood of establishing that claims 1 and 2 would have been obvious over Blegen and Monteverde—specifically, Blegen alone or in view of Monteverde's teaching of an offer period—but Petitioner did not demonstrate a reasonable likelihood of establishing obviousness based on any other combination of Blegen with Monteverde. *Id.* at 10–24. In addition, we likewise concluded that Petitioner showed a reasonable likelihood of establishing that claims 3–5 would have been obvious over Blegen, Monteverde, and Schmidt—specifically, Blegen and Schmidt or Blegen and Schmidt in view of Monteverde's teaching of an offer period—but Petitioner did not demonstrate a reasonable likelihood of establishing obviousness based on any other teaching of Monteverde. *Id.* at 25–28. We further concluded that Petitioner showed a reasonable likelihood of establishing that claims 1–5 would have been obvious over Charlebois and Gillies. *Id.* at 28–39. Finally, we determined that Petitioner did not show a reasonable likelihood of demonstrating that Charlebois, Gillies, and Froloff render obvious claims 1–5. *Id.* at 39–42. We instituted *inter partes* review of claims 1–5 only on the grounds of unpatentability on which we determined that Petitioner demonstrated a reasonable likelihood of prevailing. *See id.* at 43 (§ III).

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In light of *SAS*, we now modify our Decision on Institution to institute on all of the challenged claims and all of the grounds presented in the Petition. Specifically, we modify our Decision on Institution to institute the grounds challenging claims 1 and 2 as obvious over Blegen and Monteverde and claims 3–5 as obvious over Blegen, Monteverde, and Schmidt as fully presented in the Petition (i.e., without limiting the combination with Monteverde to Monteverde's teaching of an offer period). In addition, we institute review of the asserted ground challenging claims 1–5 as obvious over Charlebois, Gillies, and Froloff.

The parties shall confer to discuss the impact, if any, of this Order on the current schedule set in the Scheduling Order (Paper 11). If, after conferring, the parties wish to otherwise change the schedule or submit further briefing, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

In consideration of the foregoing, it is hereby:

ORDERED that our Decision on Institution is modified to include review of all challenged claims and all grounds presented in the Petition:

Claims 1 and 2 under 35 U.S.C. § 103 over Blegen and Monteverde;

Claims 3–5 under 35 U.S.C. § 103 over Blegen, Monteverde, and Schmidt;

Claims 1–5 under 35 U.S.C. § 103 over Charlebois and Gillies; and

Claims 1–5 under 35 U.S.C. § 103 over Charlebois, Gillies, and Froloff; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further

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briefing and if so, shall request a conference call with the panel to seek authorization for such changes or briefing within one week of the date of this Order.

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