

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner.

---

Case IPR2017-02202  
Patent 8,239,852 B2

---

Before JENNIFER S. BISK, MIRIAM L. QUINN, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–8 and 16–18 (“challenged claims”) of U.S. Patent No. 8,239,852 B2 (Ex. 1101, “852 patent”). Paper 1 (“Pet.”). Uniloc Luxembourg, S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless “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.” For the reasons given below, we determine that the information presented in the Petition and the Preliminary Response does not show that there is a reasonable likelihood of Petitioner prevailing as to any of the challenged claims of the ’852 patent, and we deny institution of *inter partes* review.

## I. BACKGROUND

### A. *Related Matters*

The parties represent that Patent Owner has asserted the ’852 patent against Petitioner in an ongoing action before the U.S. District Court for the Eastern District of Texas, *Uniloc USA, Inc. v. Apple Inc.*, No. 2:17-cv-00258. Pet. 2; Paper 3, 2. In addition, the challenged claims were the subject of a previous petition for *inter partes* review filed by Petitioner in IPR2017-02041. The Board declined to institute trial on the grounds asserted in that case. *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-02041 (PTAB Mar. 7, 2018) (Paper 10).

### B. *The ’852 Patent*

The ’852 patent is directed to a system, method, and apparatus for remotely updating a program configuration of a client device. Ex. 1101, [57], 1:26–28, 2:55–58. The client device generates unique identifiers for the device, such as a device identifier and a software identifier, and sends the identifiers to an update server. *Id.* at [57], 3:4–15, 6:58–63, 9:16–27, 9:55–57. The update server analyzes the identifiers to determine an updated

program configuration for the client device and delivers the updated program configuration to the device. *Id.* at [57], 4:35–39.

In disclosed embodiments, a client device features software “that requires a license to be authorized for use,” as well as a computer program for performing a remote update. *Id.* at 2:58–60, 3:4–7, 6:3–5. The client device performs “[p]hysical device recognition” to determine “machine parameters” that are “expected to be unique to” the device. *Id.* at [57], 3:7–10, 5:36–41, Fig. 2; *see id.* at 7:1–32. The machine parameters may include, for example, “user account information, program information (e.g., serial number) . . . and features of the software/hardware the user is entitled to use.” *Id.* at 5:51–55. “An application . . . running on the client device” uses the machine parameters to “generate a device identifier.” *Id.* at 6:58–67; *see id.* at 3:10–13. In addition, the application on the client device “collects [a] software identifier” for software on the device by “collect[ing] or receiv[ing] information” that “is expected to be unique to software, for example,” “the software serial number, product identification number, [or] product key.” *Id.* at 9:16–23, 9:34–35.

The application on the client device sends the unique identifiers to an update server, which analyzes the identifiers to determine an updated program configuration for the client device. *Id.* at [57], 3:12–15, 4:35–38, 9:55–57, Fig. 4. The update server then delivers the updated program configuration to the client device. *Id.* at [57], 4:38–39.

### *C. Illustrative Claim*

Challenged claims 1 and 18 are the only independent claims of the ’852 patent. Ex. 1101, 12:2–40, 14:1–27. Claim 18, reproduced below, is illustrative of the recited subject matter:

18. A client device configured to execute a computer program to perform a remote update of a program configuration on the client device, the client device comprising:

a processor;

a memory coupled to the processor and storing the computer program which, when executed by the processor,

- (i) performs physical device recognition on the client device to determine machine parameters including account information for a user of the client device and features of software that the user of the client device is entitled to use,
- (ii) generates a unique device identifier for the client device, the unique device identifier is generated based at least in part on the determined machine parameters, and
- (iii) collects a unique software identifier for the software on the client device, the unique software identifier being unique to a particular copy of the software and to a particular user of the software; and

a transceiver configured to

- (i) send the unique device identifier and the unique software identifier to an update server via the Internet to determine, based on analyzing the unique device identifier and the unique software identifier, an updated program configuration, and
- (ii) receive, from the update server, the updated program configuration if the user associated with the unique device identifier is entitled to use features of the updated program configuration according to a license associated with the unique software identifier.

*Id.* at 14:1–27 (line breaks added for readability).

#### *D. Evidence of Record*

The Petition relies upon the following asserted prior art references:

U.S. Patent Application Publication No. 2004/0059938 A1 (published Mar. 25, 2004) (Ex. 1108, “Hughes”);

U.S. Patent Application Publication No. 2005/0076334 A1 (published Apr. 7, 2005) (Ex. 1105, “Demeyer”);

IPR2017-02202  
Patent 8,239,852 B2

U.S. Patent Application Publication No. 2007/0113090 A1 (published May 17, 2007) (Ex. 1106, “Villela”);

U.S. Patent Application Publication No. 2008/0120195 A1 (published May 22, 2008) (Ex. 1107, “Shakkarwar”); and

U.S. Patent Application Publication No. 2008/0320607 A1 (published Dec. 25, 2008) (Ex. 1104, “Richardson”).

In addition, Petitioner supports its contentions with a Declaration of Mr. James Geier (Ex. 1103, “Geier Declaration”).

*E. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability. Pet. 3.

<b>Challenged Claim(s)</b>	<b>Basis</b>	<b>References</b>
1, 5–8, 18	§ 103	Richardson and Demeyer
2–4	§ 103	Richardson, Demeyer, and Villela
16	§ 103	Richardson, Demeyer, and Shakkarwar
17	§ 103	Richardson, Demeyer, and Hughes

II. ANALYSIS

*A. Claim Construction*

The Board interprets claim terms of an unexpired patent using the “broadest reasonable construction in light of the specification of the patent.” 37 C.F.R. § 42.100(b); *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). We presume a claim term carries its “ordinary and customary meaning,” which is the meaning “the term would have to a person of ordinary skill in the art” at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (citation omitted).

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.