

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

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

Case IPR2018-00199
Patent 7,092,671 B2

Before MIRIAM L. QUINN, CHARLES J. BOUDREAU, and
GARTH D. BAER, *Administrative Patent Judges*.

Opinion of the Board filed by Administrative Patent Judge BAER.

Opinion Concurring filed by Administrative Patent Judge QUINN.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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I. INTRODUCTION

Petitioner, Unified Patents Inc., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–16 of U.S. Patent No. 7,092,671 B2 (Ex. 1001, “the ’671 patent”). Pursuant to 35 U.S.C. § 314(a), we determined Petitioner showed a reasonable likelihood that it would prevail in establishing the unpatentability of all challenged claims and instituted an *inter partes* review. Paper 7, 15. Patent Owner Uniloc USA, Inc. and Uniloc Luxembourg, S.A. filed a Response (Paper 13, “Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 21, “Reply”). An oral hearing was held before the Board. Paper 31.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Having considered the record before us and as explained below, we determine Petitioner has shown by a preponderance of the evidence that claims 1–16 of the ’671 patent are unpatentable. *See* 35 U.S.C. § 316(e).

A. RELATED PROCEEDINGS

Petitioner and Patent Owner identify several related litigations in the Eastern District of Texas involving the ’671 patent. Pet. 2; Paper 4, 2. Another petitioner has also requested *inter partes* review of the ’671 patent in IPR2018-00282.

B. THE ’671 PATENT

The ’671 patent is directed to a “method and system for wirelessly autodialing a telephone number from a record stored on a personal information device.” Ex. 1001, [54]. According to the ’671 patent, at the time of filing, personal information devices (“PIDs”) and electronic organizers were in widespread use. *Id.* at 1:35–37. The ’671 patent

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describes these devices as “physically smaller,” having “more limited hardware and data processing capabilities” than conventional computers, and including “a screen and data processor,” “substantial electronic memory,” and “a substantial variety of applications,” relating to, for example, contact information made up of addresses and telephone numbers. *Id.* at 1:14–33. In addition to PIDs, the ’671 patent describes cellphones as widely used handheld digital devices similar to PIDs, but with substantially fewer applications, less available memory for storage, and a limited capacity for data entry. *Id.* at 1:38–53.

Because of these differences between PIDs and cellphones, the ’671 patent observes that PIDs, and not cellphones, are used to store contact information. *Id.* at 1:54–63. This leads to a requirement for users to find contact numbers on their PID and then manually dial those numbers on the cellphone. *Id.* at 1:58–2:10. Thus, the ’671 patent identifies a need for “a method whereby a user’s handheld PID can automatically dial a telephone number stored in its memory” such that the user need not access controls of a telephone. *Id.* at 2:11–22.

To solve this problem, the ’671 patent describes using the wireless ports of the telephone and the PID to link the two devices using a standard communication protocol, such as short-range radio frequency (“RF”) over Bluetooth or infrared signals (“IR”) over the Infrared Data Association (“IrDA”) specification. *Id.* at 4:40–5:27, 6:35–57. The ’671 patent describes a method in which the user chooses a phone number from the memory of the PID, using the appropriate application, and indicates to the PID that the chosen number should be dialed by a cellphone. *Id.* at 8:10–17. In response, the PID application accesses the cellphone, transmits the

desired telephone number, and “control[s] [the cellphone] to dial the number and establish[] the telephone call” in a manner that is seamless and “without requiring any intervening steps or actions by the user” or involving direct interaction with the cellphone. *Id.* at 8:17–25. Figure 8, reproduced below, shows a flowchart of the steps in one embodiment of this autodialing process. *Id.* at 9:39–41.

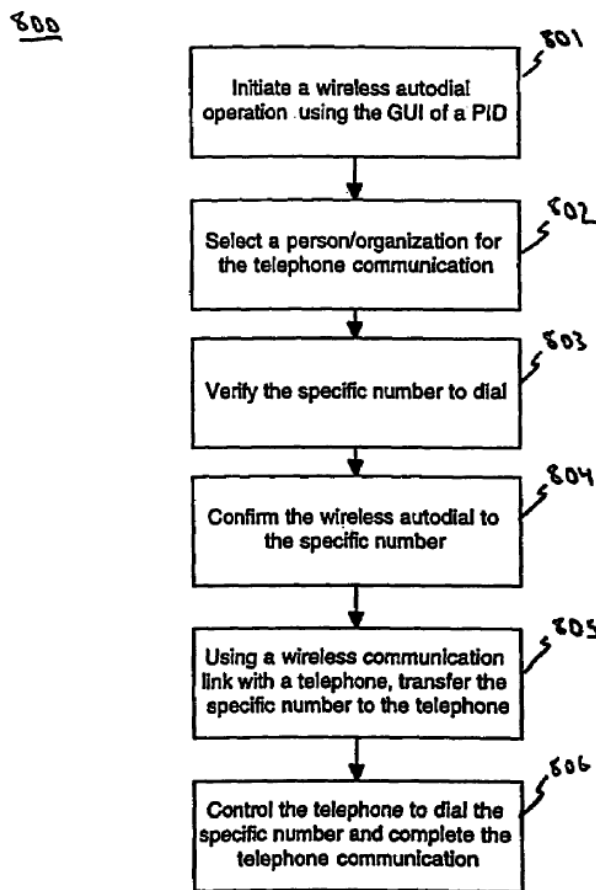


FIG. 8

The flow chart of Figure 8, above, begins with step 801—the user accessing the graphical user interface (“GUI”) of a PID to initiate wireless autodialing of a cellphone. *Id.* at 9:46–47. The user chooses the desired

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contact from a list displayed by the PID in step 802, verifies the correct phone number in step 803, and confirms that the number should be autodialed by the cellphone in step 804. *Id.* at 9:55–59. The PID, in step 805, transfers the chosen number to the cellphone over the wireless communication link. *Id.* at 9:62–64. Finally, in step 806, the PID “controls telephone 14 to dial the specific number and complete the telephone communication.” *Id.* at 9:65–67.

C. ILLUSTRATIVE CLAIM

Of the challenged claims, claims 1 and 9 are independent. Claim 1 is illustrative of the claims at issue and is reproduced below with added indentations and spacing for clarity.

1. An automated telephone dialing system, comprising:
a telephone having a wireless port for short range wireless data transfer; and
a handheld computer system having a wireless port for communication with the wireless port on the telephone,
wherein a specific telephone number is selectable from a list displayed on the handheld computer system and
wherein the handheld computer system is operable to transfer the specific telephone number to the telephone using a wireless communication, and
wherein the handheld computer system is configured to control the telephone via the wireless communication such that the telephone dials the specific telephone number.

Ex. 1001, 10:55–67.

D. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability:

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