

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,¹
Patent Owner.

Case IPR2018-00294
Patent 6,736,759 B1

Before SALLY C. MEDLEY, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

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

¹ At the time the petition was filed, Uniloc Luxembourg S.A. was the patent owner.

I. INTRODUCTION

A. Background

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–32 of U.S. Patent No. 6,736,759 B1 (Ex. 1001, “the ’759 patent”). Paper 1 (“Pet.”), 1. Uniloc Luxembourg S.A., a predecessor in interest to Uniloc 2017 LLC (“Patent Owner”), filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On May 21, 2018, we instituted an *inter partes* review of claims 1–32 on all grounds raised in the Petition (Paper 7, 33–34 (“Decision” or “Dec.”)). Patent Owner filed a Patent Owner Response. Paper 9 (“PO Resp.”). Petitioner filed a Reply to the Patent Owner Response. Paper 12 (“Pet. Reply”). An oral hearing was held on January 23, 2019. A transcript of the hearing has been entered into the record. Paper 19 (“Tr.”).

Per our Scheduling Order, we notified the parties that “any arguments for patentability not raised in the [Patent Owner] response will be deemed waived.”² Nonetheless, Petitioner bears the burden to show, by a preponderance of the evidence, that the challenged claims are unpatentable. For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claims 1–32 of the ’759 patent are unpatentable.

² See Paper 8, 3; see also Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (a patent owner’s “response should identify all the involved claims that are believed to be patentable and state the basis for that belief”).

B. Related Matters

The parties indicate that the '759 patent is the subject of the following litigation: *Uniloc USA, Inc. v. Apple Inc.*, No. 2-17-cv-00708 (E.D. Tex. filed Oct. 20, 2017). Pet. 5; Paper 4, 2.

Petitioner also states that the '759 patent was previously at issue in *Paragon Solutions, LLC v. Timex Corp.*, No. 1:06-cv-677 (S.D. Ohio 2008), *vacated*, 566 F.3d 1075 (Fed. Cir. 2009). Pet. 5–6.

C. The Challenged Patent

The '759 patent discloses a monitoring system including an electronic positioning device and a physiological monitor for use in a variety of physical activities. Ex. 1001, 1:8–15, 6:37–60. Figure 3, shown below, illustrates an embodiment of the monitoring system. *Id.* at 8:49–51.

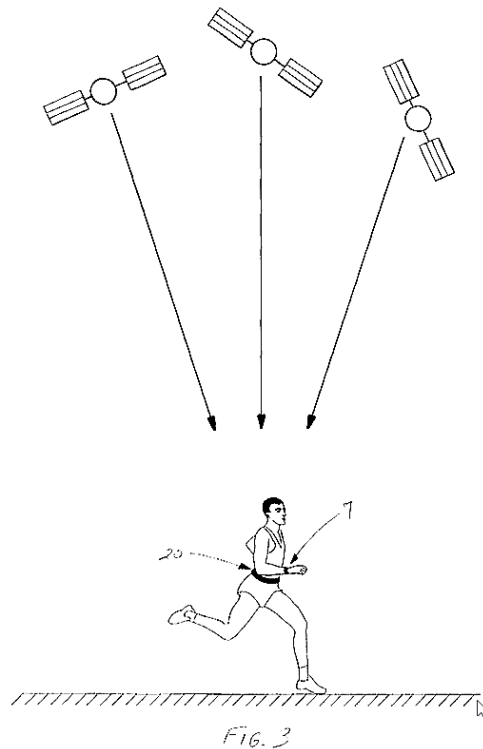


Figure 3 “depicts a human subject performing a physical activity using one embodiment of a monitoring system of the present invention,” including display unit 7 and data acquisition unit 20. *Id.* at 2:17–19, 8:51–55.

The electronic positioning device, which may be a global positioning system (“GPS”) device, receives electromagnetic signals from three or more sources to track at least one of the user’s location, altitude, heading, velocity, pace, or distance traveled. *Id.* at 3:8–10, 7:35–39, 9:16–39. The physiological monitor, which may be an oximeter or a heart rate monitor, acquires physiological data from the user, such as the user’s blood oxygen level or heart rate. *Id.* at 6:56–60, 9:40–67. The determined position and physiological data are transmitted to a separate display unit for real-time display to the user or other individual monitoring the user’s performance of a physical activity. *Id.* at 6:39–41, 7:43–46, 51–54. The display unit may include one or more alarms that are activated if a measured data value departs from a predetermined limit or range. *Id.* at 16:39–67.

D. The Challenged Claims

Petitioner challenges claims 1–32 (all claims) of the ’759 patent. Claims 1 and 29 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

1. An exercise monitoring system, comprising:
 - (a) a data acquisition unit comprising an electronic positioning device and a physiological monitor, said data acquisition unit configured to be worn by a subject performing a physical activity; and
 - (b) a display unit configured for displaying real-time data provided by said electronic positioning device and said physiological monitor, said display unit separate from said data acquisition unit;

wherein said display unit is configured to be worn by the subject, worn by someone other than the subject, or attached to an apparatus associated with the physical activity being performed by the subject so as to be visible to the subject while performing the physical activity, and

further wherein said system is configured such that said display unit displays real-time data comprising at least one of a subject's location, altitude, velocity, pace, and distance traveled.

E. Instituted Grounds of Unpatentability

We instituted trial based on all asserted claims and grounds of unpatentability as follows (Dec. 33):

| References | Basis³ | Challenged Claim(s) |
|--|--------------------------|-------------------------------|
| Fry ⁴ and Newell ⁵ | 35 U.S.C. § 103(a) | 1–7, 9, 12, 14, 17–22, and 26 |
| Fry, Newell, and Arcelus ⁶ | 35 U.S.C. § 103(a) | 20 and 22–23 |
| Fry, Newell, and Richardson ⁷ | 35 U.S.C. § 103(a) | 9 and 29–31 ⁸ |
| Fry, Newell, Richardson, and Arcelus | 35 U.S.C. § 103(a) | 32 |

³ The '759 patent was filed on November 9, 1999, prior to the date when the Leahy-Smith America Invents Act ("AIA") took effect.

⁴ US 6,002,982 (filed Nov. 1, 1996, issued Dec. 14, 1999) (Ex. 1004, "Fry").

⁵ US 6,466,232 B1 (filed Dec. 18, 1998, issued Oct. 15, 2002) (Ex. 1005, "Newell").

⁶ US 6,149,602 (filed Mar. 29, 1997, issued Nov. 21, 2000) (Ex. 1008, "Arcelus").

⁷ US 5,976,083 (filed July 30, 1997, issued Nov. 2, 1999) (Ex. 1007, "Richardson").

⁸ Although claim 32 is listed as being included in this ground (Pet. 8), the claim is not addressed in the analysis section (*see id.* at 32–38).

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