

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2018-00361
Patent 6,216,158 B1

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

QUINN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 6–9, 12, 14, 15, and 20 of U.S. Patent No. 6,216,158 B1 (Ex. 1001, “the ’158 patent”). Paper 1 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”), filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of the ’158 patent.

A. Related Matters

The parties indicate that the ’158 patent is involved in *Uniloc USA, Inc. v. Apple, Inc.*, Case No. 2-17-cv-00470 (E.D. Tex.) and other proceedings. Pet. 2; Paper 3.

B. The ’158 Patent

The ’158 patent relates to controlling network devices using a palm sized, or otherwise reduced functionality, computer. Ex. 1001, 1:8–10. A palm sized computer has limited processing, display, and input capabilities, resulting thus in inability to run the same applications on desktop or laptop computers. *Id.* at 1:22–27. Touting the desirability to access desktop functionality from palm sized computers, the ’158 patent overcomes the palm sized computer limitations by viewing a network as “an extension of the palm sized computer’s resources.” *Id.* at 1:27–29, 2:10–13. “Functions can be downloaded into the device as needed, and overlaid after they have been used.” *Id.* at 2:14–15. Thus, when a palm sized computer seeks to use

services stored on a network, the palm sized computer can access and control these services using a program (such as a middleware application) to access a registry of the network services. *Id.* at 1:36–39, 1:46–48, 2:15–23.

The '158 patent explains that middleware “allows palm sized computers to discover network-based computing resources.” *Id.* at 2:29–30. Middleware includes a directory of resources (or services), a protocol for storing and receiving from the directory, and a mechanisms to transfer software from the directory to a palm sized computer. *Id.* at 2:32–36. The palm sized computer also includes a control application to manipulate the computer services on the network. *Id.* at 2:37–40. In one embodiment, the middleware includes “Jini technology from Sun Microsystems.” *Id.* at 1:49–50, 62–67.

The '158 patent describes running a PowerPoint slide presentation as an example of a service that can be invoked and controlled via a control device, which is a palm sized computer. *Id.* at 3:4–10, 16–20. Figure 1 of the '158 patent is reproduced below.

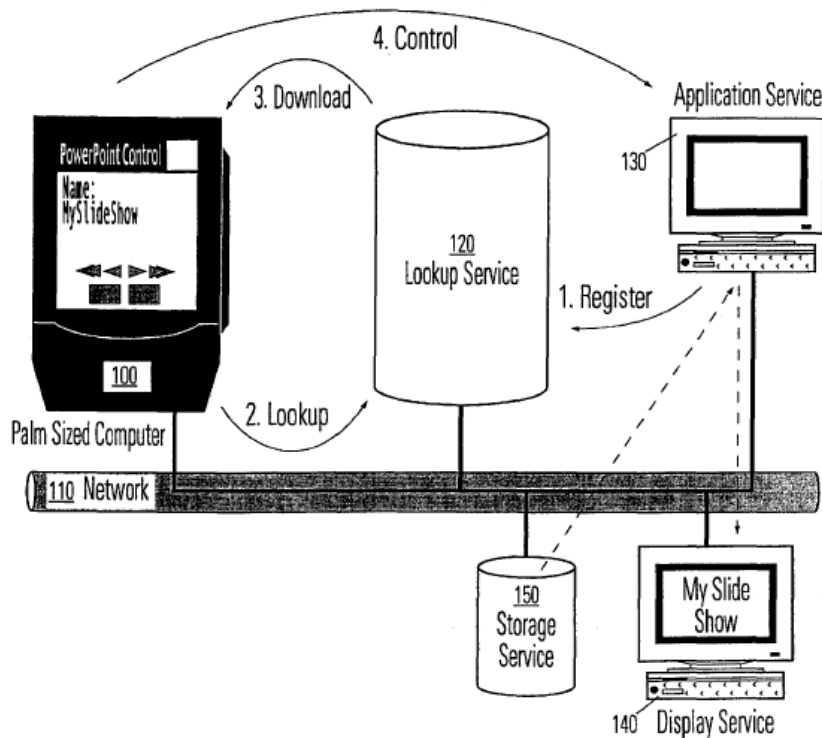


Figure 1 depicts a system having a palm sized computer controlling operations of various network devices, such as application service 130 (to run the PowerPoint application), display service 140 (to display the presentation), and storage service 150 (to store the presentation). *Id.* at Fig. 1, 3:43–54. “None of these services are resident on the palm sized computer 100.” *Id.* at 3:60–61. After locating the necessary service (e.g., PowerPoint application) using lookup service 120, the palm sized computer downloads the code required to control the located services. *Id.* at 3:45–49, 3:61–64, 6:1–3. The ’158 patent describes that the control device (i.e., palm sized computer) uses a download interface to download “the application service descriptor.” *Id.* at 6:16–21 (referring also to “the GUI code for controlling a PowerPoint presentation”). The palm sized computer is then

capable of directly controlling the service, such as by sending a “next slide” request to the application service running PowerPoint. *Id.* at 3:66–67, 6:24–26.

C. Illustrative Claim

Of the challenged claims, claims 1, 8, and 20 are independent. Each of claims 2, 6, 7, 9, 12, 14, and 15 depends directly from either claim 1 or claim 8.

Claim 1 is illustrative:

1. A method of controlling a service on a network using a palm sized computer, the palm sized computer being coupled in communications with the network, the method comprising:

accessing a description of the service from a directory of services, the description of the service including at least a reference to program code for controlling the service;

downloading the program code to the palm sized computer;

the palm sized computer executing at least a portion of the program code; and

sending control commands to the service from the palm sized computer in response to the executing, wherein the service controls an application that cannot be executed on the palm sized computer.

Ex. 1001, 12:13–28.

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