UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner

_____

PETITION FOR *INTER PARTES* REVIEW

OF

U.S. PATENT NO. 6,216,158

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

I. INTRODUCTION 1

II. MANDATORY NOTICES 2

A. Real Party-in-Interest 2

B. Related Matters 2

C. Lead and Back-up Counsel and Service Information 2

III. GROUNDS FOR STANDING 3

IV. THE '158 PATENT 3

A. State of the Art before the '158 Patent 3

B. Overview of the '158 Patent 4

C. Prosecution History 7

D. Claim Construction 8

1. "*palm sized computer*" (Claims 1-2, 6-9, 12, 14-15) 8

2. "*means for accessing a description of a service*" (Claim 20) 9

3. "*means for downloading the program code*" (Claim 20) 10

4. "*means for executing at least a portion of the program code*" (Claim 20) 11

5. "*means for sending control commands to the service in response to the means for executing*" (Claim 20) 12

V. RELIEF REQUESTED AND THE REASONS FOR THE REQUESTED RELIEF 13

VI. IDENTIFICATION OF CHALLENGES 13

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

A. The Challenges Presented in This Petition are Neither Cumulative Nor Redundant 14

VII. IDENTIFICATION OF HOW THE CLAIMS ARE UNPATENTABLE 16

A. Challenge #1: Claims 1-2, 6-9, 12, 14-15, and 20 are invalid under 35 U.S.C § 103 over Jini-QS in view of Arnold and McCandless 16

1. Summary of Jini-QS 16

2. Summary of Arnold 17

3. Summary of McCandless 19

4. Reasons to Combine Jini-QS, Arnold, and McCandless 20

a. Reasons for utilizing Arnold's RMI protocol to control services in the Jini platform described by Jini-QS 21

b. Reasons for the PalmPilot in Jini-QS to control an application it cannot execute itself, as described in McCandless 22

c. Reasons for utilizing Arnold's service registration in the Lookup Service described by Jini-QS 24

5. Detailed Analysis 25

B. Challenge #2: Claims 1-2, 6-9, 12, and 14-15 are invalid under 35 U.S.C § 103 over Riggins in view of Devarakonda 50

1. Summary of Riggins 51

2. Summary of Devarakonda 52

3. Reasons to Combine Riggins and Devarakonda 54

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

a. Reasons for utilizing Devarakonda's PDA as Riggins' network computer to control applications too resource intensive for the PDA to execute itself 54

b. Reasons for using Devarakonda's service registration method in Riggins' network service method 57

4. Detailed Analysis 58

VIII. CONCLUSION.....81

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

I. INTRODUCTION

U.S. Patent No. 6,216,158 ("the '158 Patent," APPL-1001) is generally directed to controlling network services with a palm-sized computer. The '158 Patent admits, however, that the specific steps for controlling network services recited in the claims—accessing a directory of services, downloading code associated with a service, and sending control commands—were already well known. In that regard, the only embodiment disclosed in the specification is based on Sun Microsystems' Jini technology, which was announced and publicized in the summer of 1998, well before the priority date of the '158 Patent. Jini allows a client to access a directory of services, download code associated with a service, and control the service with the code.

The allegedly-inventive aspect of the '158 Patent is the performance of the well-known Jini steps by a *palm-sized computer*. Jini, however, was designed for use with any type of device including palm-sized devices—as illustrated by trade articles pre-dating the '158 Patent that *explicitly tout the use of PalmPilots with Jini*. U.S. patents filed by the architect of Jini provide additional details regarding the Jini platform.

This petition further establishes that others besides Sun Microsystems had also developed and disclosed methods for controlling network services with a palm-sized computer. The claimed subject matter of the '158 Patent is also taught

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.