

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORP., HTC AMERICA, INC., and LG ELECTRONICS, INC.
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2018-01631
Patent 7,881,902 B1

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

HORVATH, *Administrative Patent Judge*.

DECISION

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

Granting of Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

HTC Corporation, HTC America, Inc., and LG Electronics, Inc. (collectively, “Petitioner” or “HTC/LG”)¹ filed a Petition requesting *inter partes* review of claims 1–6, 9, and 10 (“the challenged claims”) of U.S. Patent No. 7,881,902 B1 (Ex. 1001, “the ’902 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to the following instituted proceeding: *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424 (PTAB) (“the Apple IPR”). Paper 4 (“Mot.”). Uniloc 2017 LLC (“Patent Owner”)² filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition, but did not file an opposition to the Motion for Joinder. We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we institute *inter partes* review of all challenged claims, and grant Petitioner’s Motion for Joinder.

B. Related Matters

The following are matters that could affect, or be affected by, a decision in this proceeding because they involve the ’902 patent, or patents that are related to the ’902 patent:

- *Uniloc USA, Inc. v. Huawei Devices USA, Inc.*, 2-17-cv-00737 (EDTX);
- *Uniloc USA, Inc. v. HTC Am., Inc.*, 2-17-cv-01629 (W.D. Wa);

¹ Petitioner identifies HTC Corporation, HTC America, Inc., LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics MobileComm USA, Inc. as the real parties-in-interest. Pet. 1.

² Patent Owner identifies Uniloc 2017 LLC, Uniloc USA, Inc., and Uniloc Licensing USA LLC as the real parties-in-interest.

- *Uniloc USA, Inc. v. Samsung Elec. Am., Inc.*, 2-17-cv-00650 (EDTX);
- *Uniloc USA, Inc. v. LG Elec. USA, Inc.*, 4-18-cv-02918 (NDCA);
- *Uniloc USA, Inc. v. Apple Inc.*, 4-18-cv-00364 (NDCA);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00387 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00389 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01028 (PTAB);
- *LG Elec., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01458 (PTAB);
- *HTC Corp. v. Uniloc 2017 LLC*, Case IPR2018-01589 (PTAB);
- *Samsung Elec. Co., Ltd. v. Uniloc 2017 LLC*, Case IPR2018-01653 (PTAB);
- *Samsung Elec. Am., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01756 (PTAB); and
- *Samsung Elec., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01757 (PTAB).

*C. Evidence Relied Upon*³

Reference		Effective Date ⁴	Exhibit
Pasolini	US 7,463,997	Oct. 2, 2006	1005
Fabio	US 7,698,097 B2	Oct. 2, 2006	1006
Mitchnick	US 2006/0084848 A1	Oct. 14, 2004	1007

³ Petitioner also relies upon the Declaration of Joseph A. Paradiso, Ph.D. (Ex. 1003). Patent Owner relies upon the Declaration of William C. Easttom II (Ex. 2001).

⁴ Petitioner relies on the filing dates of Pasolini, Fabio, and Mitchnick as the effective date for determining their availability as prior art.

Reference		Effective Date ⁴	Exhibit
Tanenhaus	US 6,469,639 B2	Oct. 22, 2002	1008
Sheldon	US 5,957,957	Sept. 28, 1999	1009

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Reference(s)	Basis	Claim(s) Challenged
Mitchnick	§ 103(a)	1 and 2
Mitchnick and Sheldon	§ 103(a)	3
Mitchnick, Sheldon, and Tanenhaus	§ 103(a)	4
Fabio and Pasolini	§ 103(a)	5, 6, 9, and 10

II. ANALYSIS

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner represents that this Petition “is a carbon copy of the original Apple IPR petition in all material respects,” and differs from the Apple IPR petition only in the introduction, which identifies the Petitioner and provides the mandatory notices required by 37 C.F.R. § 42.8(b). Mot. 1. Petitioner, therefore, represents that this Petition and the Apple IPR petition “challenge the same claims of the ’902 patent on the same grounds relying on the same prior art and evidence, including a declaration identical in substance from the same expert.” *Id.* Our independent review of the Petition and the Apple IPR petition, including the expert declarations filed in both, confirm Petitioner’s representations.

The Apple IPR petition was filed on January 5, 2018, challenging claims 1–6, 9, and 10 of the ’902 patent on the same grounds raised in this

IPR2018-01631
Patent 7,881,902

Petition. *See* Apple IPR, Paper 2. Patent Owner filed a preliminary response to the Apple IPR petition on May 7, 2018. *Id.*, Paper 6 (“Apple IPR Prelim. Resp.”). We instituted *inter partes* review based on the Apple IPR petition on August 2, 2018. *Id.*, Paper 7 (“Apple IPR Institution Decision”). Patent Owner filed a Response to the Apple IPR petition on October 25, 2018. *Id.*, Paper 11 (“Apple IPR Resp.”).

Patent Owner filed its Preliminary Response to this Petition on December 6, 2018. *See* Prelim. Resp. Based on our independent review, Patent Owner’s Preliminary Response to this Petition is nearly identical to Patent Owner’s Response to the Apple IPR petition. *Compare* Prelim. Resp. 5–36, *with* Apple IPR Resp. 1–32. Moreover, Patent Owner’s Preliminary Response to this Petition raises the same or substantially the same arguments Patent Owner raised in its Preliminary Response to the Apple IPR petition. *Compare* Prelim. Resp. 5–36, *with* Apple IPR Prelim. Resp. 1–18.

The only argument raised by Patent Owner in its Preliminary Response to this Petition that substantially differs from the arguments Patent Owner raised in its Preliminary Response to the Apple IPR petition is the argument that “the Board’s appointments of administrative patent judges violate the Appointments Clause of Article II” of the U.S. Constitution. Prelim. Resp. 36. We decline to address the merits of this constitutional challenge because “administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments.” *Riggin v. Office of Senate Fair Employment Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995). This is especially true when, as here, “the constitutional claim asks the agency to act contrary to its statutory charter.” *Id.*

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.