

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,¹
Patent Owner.

Case IPR2018-00884
Patent 8,539,552 B1

Before SALLY C. MEDLEY, KARL D. EASTHOM, 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 1–25 (“the challenged claims”) of U.S. Patent No. 8,539,552 B1 (Ex. 1001, “the ’552 patent”). Paper 2 (“Pet.”), 1. Uniloc Luxembourg S.A., a predecessor in interest of Uniloc 2017 LLC (“Patent Owner”), filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On October 2, 2018, we instituted an *inter partes* review of the challenged claims on all grounds raised in the Petition. Paper 8 (“Institution Decision” or “Inst. Dec.”), 28.

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 11, “PO Resp.”), Petitioner filed a Reply to the Patent Owner Response (Paper 13, “Pet. Reply”), and Patent Owner filed a Sur-Reply to Petitioner’s Reply (Paper 14, “PO Sur-Reply”). An oral hearing occurred on July 15, 2019. The record includes a transcript of the hearing. Paper 19 (“Tr.”).

In 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. 35 U.S.C. § 316(e).

For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claims 1–17 and 23–25 of the ’552

² See Paper 9, 5; see also Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief.”).

patent are unpatentable. It, however, has failed to meet its burden of proof regarding the unpatentability of claims 18–22.

B. Related Matters

The parties indicate that the '552 patent is not involved in any federal district court litigation or any other challenges before the Board. Pet. i; Paper 7, 2. However, it appears that the '552 patent is the subject of the following litigation:

Uniloc 2017 LLC v. Apple Inc., No. 1:18-cv-00890 (W.D. Tex. filed Oct. 18, 2018),

Uniloc 2017 LLC v. Apple Inc., No. 1:18-cv-00992 (W.D. Tex. filed Nov. 17, 2018), and

Uniloc 2017 LLC v. Apple Inc., No. 4:19-cv-01949 (N.D. Cal. filed Apr. 12, 2019).

C. The Challenged Patent

The '552 patent discloses a system and method for network based policy enforcement of intelligent client features. Ex. 1001, 1:7–10.

In packet-based networks, intelligent end-user clients with little or no support and/or knowledge of the network can deliver many features and services. For networks to retain control over the features and services used by subscribers that use intelligent end-user clients, the networks need to be able to recognize signaling and call control messages and transactions that implement these features and services within the network. This is particularly important in next-generation IP telephony and IP multimedia networks where many basic and advanced services may be signaled, controlled, and/or delivered by intelligent end-user clients which are not owned or controlled by the network or service providers, thereby enabling the potential bypassing by the end user of service agreements or other subscription accounting mechanisms.

Id. at 2:61–3:7.

The '552 patent provides network-based policy enforcement to control access to and use of features and services. *Id.* at 3:20–23. A policy enforcement point within the core network, to which local networks seek access, is used to provide such enforcement. *Id.* at 7:32–34; *see also id.* at 3:48–61 (discussing an exemplary network architecture). The policy enforcement point is in the communications path of every call control and signaling message between any end-user client and any call control and signaling entity of the core network, and uses information regarding the sender and/or the intended recipient to determine whether access to the services and features of the core network is authorized. *Id.* at 7:34–52, 7:66–8:11. Figure 1 illustrates the network and is reproduced below.

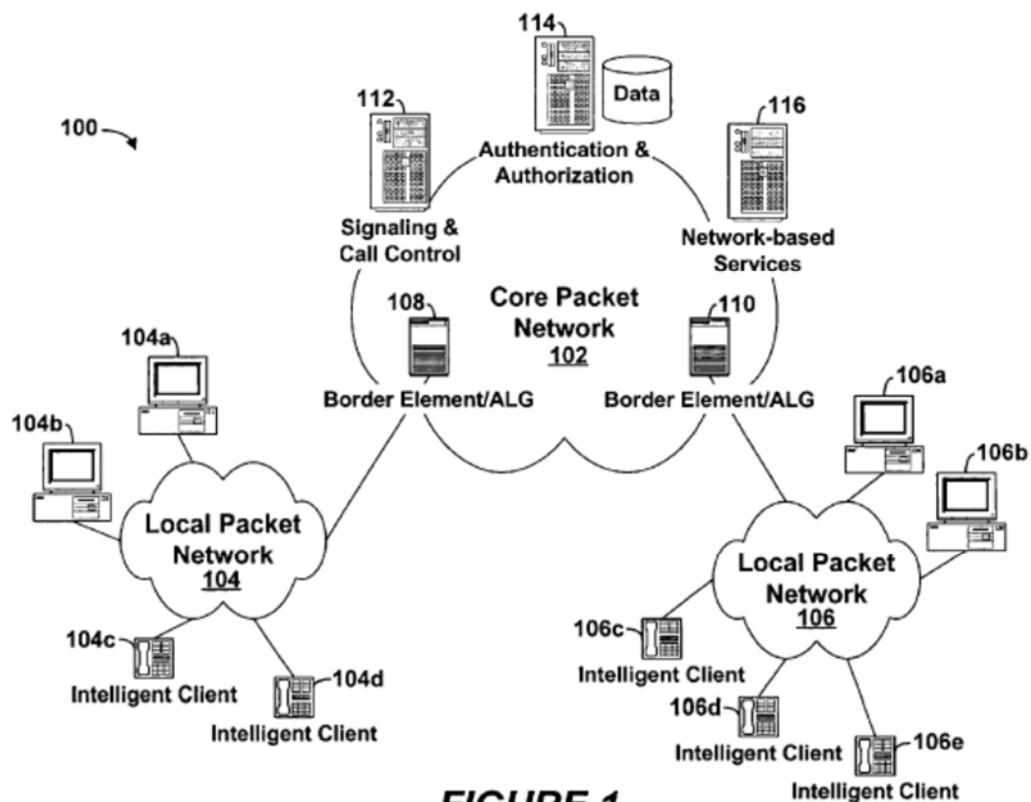


FIGURE 1

Figure 1 illustrates the '552 patent's network 100, which includes

a core packet network **102**, and two local packet networks **104** and **106**, as well as intelligent end-user clients **104a-d** and **106a-e** associated with the local packet networks **104** and **106**. Access to the core packet network **102** is available through border elements **108** and **110**, such as a firewall or application layer gateway (ALG) device.

Id. at 3:50–56.

Figure 3, which is a flowchart depicting one embodiment of a method of network-based policy enforcement of intelligent client features (*id.* at 2:44–46), is reproduced below:

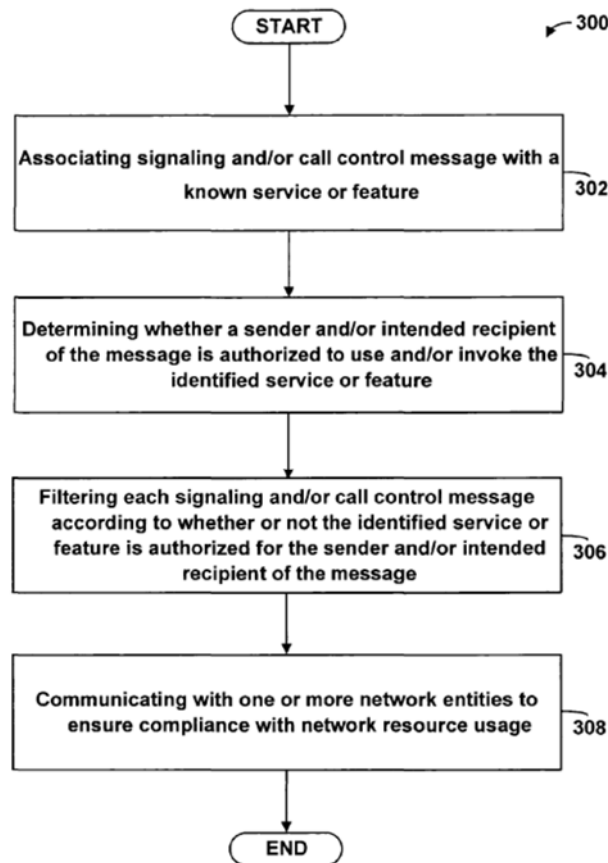


FIGURE 3

Figure 3 is a flowchart depicting one embodiment of a method 300 of network-based policy enforcement of intelligent client features. *Id.* at 8:54–

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