

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.
Patent Owner.

Case IPR2018-01028
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)

I. INTRODUCTION

A. Background

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claim 8 (“the challenged claim”) of U.S. Patent No. 7,881,902 B1 (Ex. 1001, “the ’902 patent”). Paper 2 (“Pet.”). Uniloc 2017 LLC. (“Patent Owner”)¹, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314. Upon consideration of the Petition and Preliminary Response we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of challenged claim 8 of the ’902 patent. Accordingly, we institute *inter partes* review of claim 8.

B. Related Matters

Petitioner and Patent Owner identify the following as matters that could affect, or be affected by, a decision in this proceeding: *Uniloc USA, Inc. v. Huawei Devices USA, Inc.*, 2-17-cv-00737 (E.D. Tx.); *Uniloc USA, Inc. v. HTC America, Inc.*, 2-17-cv-01629 (W.D. Wa); *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, 2-17-cv-00650 (E.D. Tx); *Uniloc USA, Inc. v. Apple Inc.*, 4-18-cv-00364 (N.D. Ca.);² *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, 4-18-cv-02918 (N.D. Ca.).³ Pet. 1–2; Paper 6 (2). Patent Owner also identifies the following matter before the Board, which

¹ In its updated mandatory notice, Uniloc Luxembourg S.A. identifies Uniloc 2017 LLC as the patent owner, and Uniloc USA, Inc. and Uniloc Licensing USA LLC as real parties-in-interest. Paper 6 (1).

² Transferred from *Uniloc USA, Inc. v. Apple Inc.*, 2-17-cv-00522 (E.D. Tx)

³ Transferred from *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, 4-17-cv-00832 (E.D. Tx)

IPR2018-01028
Patent 7,881,902 B1

involves the '902 patent: *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424 (PTAB) (challenging claims 1–6, 9, and 10 of the '902 patent). Paper 3, 2. Neither party identifies the following matters before the Board, which also involve the '902 patent: *HTC Corp. v. Uniloc Luxembourg S.A.*, Case IPR2018-01631 (PTAB); and *Samsung Electronics America, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01653 (PTAB).

Additionally, neither party identifies the following matters before the Board, which involve U.S. Patent No. 7,653,508 B1, from which the '902 patent depends: *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00387 (PTAB); *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01026 (PTAB); *LG Electronics, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01577 (PTAB); *HTC Corp. v. Uniloc Luxembourg S.A.*, Case IPR2018-01589 (PTAB); and *Samsung Electronics America, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01756 (PTAB).

Further, neither party identifies the following matters before the Board, which involve U.S. Patent No. 8,712,723 B1, which is a continuation of the '902 patent: *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00389 (PTAB); *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01027 (PTAB); *LG Electronics, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01458 (PTAB); and *Samsung Electronics America, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01757 (PTAB).

*C. Evidence Relied Upon*⁴

References		Effective Date ⁵	Exhibit
Pasolini	US 7,463,997 B2	Oct. 2, 2006	1005
Fabio	US 7,698,097 B2	Oct. 2, 2006	1006
Tsuji	US 7,297,088 B2	Apr. 19, 2005	1010

*D. Asserted Ground of Unpatentability*⁶

Petitioner asserts the following ground of unpatentability:

References	Basis	Claim Challenged
Fabio, Pasolini, and Tsuji	§ 103(a)	8

II. ANALYSIS

A. Discretion Under 35 U.S.C. § 325(d)

Petitioner previously challenged claims 1–6, 9, and 10 of the '902 patent, including claims 5, 6, 9, and 10 as unpatentable over Fabio and Pasolini. *See Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424,

⁴ Petitioner also relies upon the Declaration of Joseph A. Paradiso, Ph.D. (Ex. 1003).

⁵ Petitioner relies on the filing dates of Pasolini, Fabio, and Tsuji as the effective date for determining their availability as prior art under 35 U.S.C. § 102(e). Pet. 8–9.

⁶ Petitioner also challenges claim 5 as obvious over Fabio and Pasolini. Pet. 8. However, Petitioner states it “seeks review with respect to only previously unchallenged claim 8,” and that “this petition is directed toward only claim 8.” *Id.* at 3. Moreover, Petitioner states that its challenge of claim 5, from which claim 8 depends, repeats the same analysis it used to challenge claim 5 in IPR2018-00424. Therefore, we interpret this Petition as challenging only dependent claim 8.

slip op. at 8 (PTAB) (Paper 2) (“the ’424 petition”). Here, Petitioner challenges claim 8 of the ’902 patent as unpatentable over Fabio, Pasolini, and Tsuji. *See* Pet. 8.

The Board has discretion to institute *inter partes* review, and can deny institution of follow-on petitions, like the present petition, as an exercise of that discretion. *See* 35 U.S.C. § 325(d) (“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially same prior art or arguments previously were presented to the Office.”).

Petitioner argues the instant petition is not redundant to the ’424 petition and should be allowed to proceed because “it seeks review with respect to only previously unchallenged claim 8,” and because “the prior art teaching the limitations of claim 8 was not located by Petitioner until after the ’424 petition was filed.” Pet. 3. Petitioner argues that in preparing this petition it has not benefited from Patent Owner’s preliminary response to the IPR2018-00389 petition (“the ’389 petition”), which challenged claims of the related ’723 patent, because “the analysis of claim 5 in this petition is verbatim identical to the analysis of claim 5 presented in the ’424 petition.” *Id.*

Patent Owner argues the instant petition should be denied under 35 U.S.C. § 325(d) because “Petitioner knew, or should have known, of the additional reference (*Tsuji*) at the time of filing” the ’424 petition. Prelim. Resp. 3. Patent Owner argues this is so because *Tsuji* is one of a small number of references cited on the face of Fabio, and Petitioner knew about

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.