

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2018-01589¹
Patent 7,653,508 B1

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

O'HANLON, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

¹ Samsung Electronics America, Inc., which filed a petition in IPR2019-00889, has been joined as a petitioner in this proceeding.

I. INTRODUCTION

A. Background

HTC Corporation and HTC America, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–4, 6–8, 11–16, 19, and 20 of U.S. Patent No. 7,653,508 B1 (Ex. 1001, “the ’508 patent”). Paper 1 (“Pet.”), 1. Concurrently with its Petition, Petitioner filed a Motion for Joinder with *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00387 (“the Apple IPR”). Paper 3 (“Motion” or “Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 8.

On February 27, 2019, we instituted an *inter partes* review. Paper 9 (“Institution Decision” or “Inst. Dec.”), 10–12. In the Institution Decision, we granted in part Petitioner’s Motion with respect to claims 1–4, 6–8, 11–16, and 19, and denied in part Petitioner’s Motion with respect to claim 20 (which was not challenged in the Apple IPR). *Id.* We explained,

Given that Petitioner is being joined as a party to the Apple IPR and that “Petitioner[] agree[s] to proceed on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted,” Petitioner is bound by the ultimate determination made in the Apple IPR regarding claims 1–4, 6–8, 11–16, and 19. *See* 35 U.S.C. §§ 315(e)(1), 325(d); 37 C.F.R. § 42.73(d)(1). Accordingly, Petitioner shall not advance any arguments regarding these claims in this proceeding; all grounds raised by Petitioner regarding these claims will be addressed in the Apple IPR. The parties are limited to advancing arguments regarding claim 20 in this proceeding.

Id. at 10 (alterations in original).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 11, “PO Resp.”), Petitioner filed a Reply to the Patent

Owner Response (Paper 12, “Pet. Reply”), and Patent Owner filed a Sur-Reply to Petitioner’s Reply (Paper 14, “PO Sur-Reply). An oral hearing was held on December 11, 2019. A transcript of the hearing has been entered into the record. Paper 26 (“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.” *See* Paper 10, 5; *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”) 66 (Nov. 2019)² (“The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief.”).

For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claims 1–4, 6–8, 11–16, 19, and 20 of the ’508 patent are unpatentable.

B. Related Matters

The parties indicate that the ’508 patent is the subject of the following litigation:

Uniloc USA, Inc. v. Apple Inc., No. 2-17-cv-00522 (E.D. Tex. filed June 30, 2017),

Uniloc USA, Inc. v. Samsung Electronics America, Inc., No. 2-17-cv-00650 (E.D. Tex. filed Sept. 15, 2017),

Uniloc USA, Inc. v. LG Electronics USA, Inc., No. 4-12-cv-00832 (N.D. Tex. filed Oct. 13, 2017),

Uniloc USA, Inc. v. HTC America, Inc., No. 2-17-cv-01629 (W.D. Wash. filed Nov. 1, 2017),

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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Uniloc USA, Inc. v. Huawei Devices USA, Inc., No. 2-17-cv-00737 (E.D. Tex. filed Nov. 9, 2017),

Uniloc USA, Inc. v. Apple Inc., No. 4-18-cv-00364 (N.D. Cal. filed Jan. 17, 2018), and

Uniloc USA, Inc. v. LG Electronics USA, Inc., No. 4-18-cv-02918 (N.D. Cal. filed May 17, 2018).

Pet. 2; PO Resp. 2. The '508 patent is also the subject of several *inter partes* reviews:

Apple, Inc. v. Uniloc 2017, LLC, IPR2018-00387 (the Apple IPR),

Apple, Inc. v. Uniloc 2017, LLC, IPR2018-01026,

LG Electronics, Inc. v. Uniloc 2017, LLC, IPR2018-01577,

Samsung Electronics America, Inc. v. Uniloc 2017, LLC, IPR2018-01756, and

Samsung Electronics America, Inc. v. Uniloc 2017, LLC, IPR2019-00889.

C. Real Parties-in-Interest

The statute governing *inter partes* review proceedings sets forth certain requirements for a petition for *inter partes* review, including that “the petition identif[y] all real parties in interest.” 35 U.S.C. § 312(a)(2); *see also* 37 C.F.R. § 42.8(b)(1) (requiring identification of real parties-in-interest in mandatory notices). The Petition identifies HTC Corporation and HTC America, Inc. as the real parties-in-interest. Pet. 2. Patent Owner states that its real parties-in-interest are Uniloc 2017 LLC, Uniloc USA, Inc., and Uniloc Licensing USA LLC. Paper 6, 2.

D. The Challenged Patent

The '508 patent discloses a device and method for counting a user's steps using an inertial sensor. Ex. 1001, 1:5–7, 2:8–9. As used in the '508 patent, a “step” is “any user activity having a periodic set of repeated movements.” *Id.* at 3:32–36. A tri-axis inertial sensor can be used to provide acceleration data as a function of time along three axes. *Id.* at 3:37–44, Fig. 2. Steps are counted by analyzing acceleration data relative to a dominant axis, which can be the axis most influenced by gravity or an axis that is defined as approximately aligned to gravity. *Id.* at 6:22–55. An example acceleration chart is shown in Figure 2, which is reproduced below:

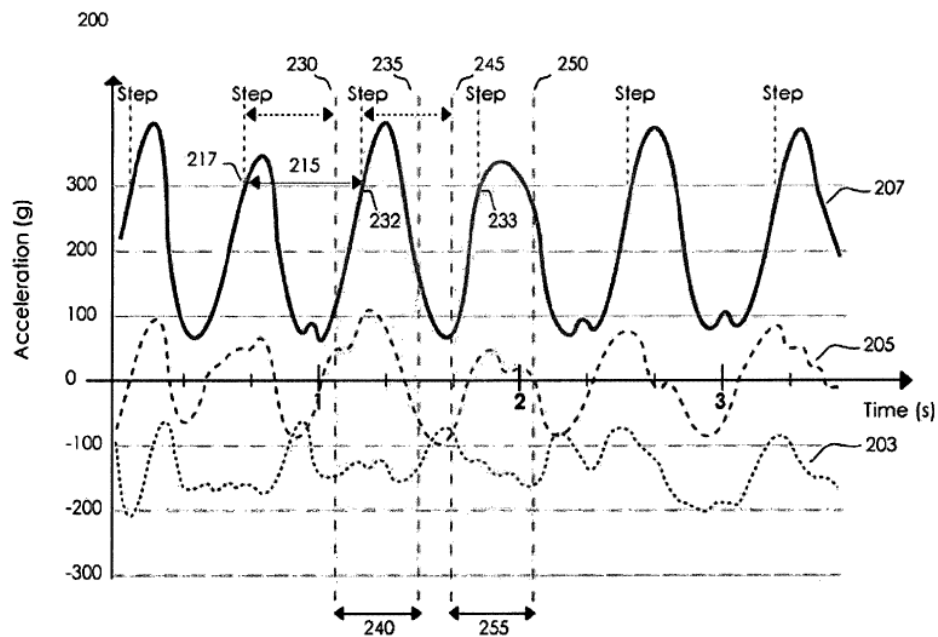


Figure 2

Figure 2 illustrates an exemplary cadence of motion graph displaying acceleration measurements versus time along a first axis 203, a second axis 205, and a third (dominant) axis 207. *Id.* at 1:45–47, 3:42–45.

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