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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2018-01589
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*.

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

Granting-in-Part Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

HTC Corporation and HTC America, Inc. ("Petitioner" or "HTC") 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, HTC filed a Motion for Joinder with *Apple Inc. v. Uniloc 2017 LLC*, Case IPR2018-00387 ("the Apple IPR"). Paper 3 ("Motion" or "Mot."). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp.").

For the reasons explained below, we institute an *inter partes* review of claims 1–4, 6–8, 11–16, 19, and 20 of the '508 patent, and grant-in-part and deny-in-part Petitioner's Motion for Joinder.

B. 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.

C. Related Matters

The parties indicate that the '508 patent is involved in *Uniloc USA, Inc. v. HTC Am., Inc.*, Case No. 2-17-cv-01629 (W.D. Wash) and other proceedings. Pet. 2; Prelim. Resp. 3–4.

In the Apple IPR, we instituted an *inter partes* review of claims 1–4, 6–8, 11–16, and 19 of the '508 patent on the following grounds:

Reference(s)	Basis[1]	Challenged Claims
Pasolini[2]	35 U.S.C. § 103(a)	1, 2, 11, and 12
Fabio[3]	35 U.S.C. § 103(a)	6–8, 15, 16, and 19
Pasolini and Fabio	35 U.S.C. § 103(a)	3, 4, 13, and 14

Apple Inc. v. Uniloc 2017 LLC, Case IPR2018-00387, slip. op. at 6, 27 (PTAB July 23, 2018) (Paper 8) ("Apple Decision" or "Apple Dec.").

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts substantially the same grounds of unpatentability as the one on which we instituted review in the Apple IPR. *Compare* Pet. 24–72, *with* Apple Dec. 6, 27. Indeed, Petitioner contends that the Petition asserts only the grounds that the Board instituted in the Apple IPR, and the Petitioner relies on the same exhibits and expert declaration as in the Apple IPR. Mot. 6–12. We note that in this Petition,

[1] The '508 patent was filed on December 22, 2006, prior to the date when the Leahy-Smith America Invents Act ("AIA") took effect.
[2] US 7,463,997 B2 (filed Oct. 2, 2006, issued Dec. 9, 2008) (Ex. 1005, "Pasolini").
[3] US 7,698,097 B2 (filed Oct. 2, 2006, issued Apr. 13, 2010) (Ex. 1006, "Fabio").

Petitioner also asserts a challenge to claim 20, which is further discussed below.

We acknowledge Patent Owner's arguments and evidence supporting its position that the claims would not have been obvious. Prelim. Resp. 12–33. Certain of Patent Owner's arguments against the merits of the Petition have been previously addressed in the Apple Decision, and we need not address them here again. Certain other arguments against the merits of the Petition closely mirror arguments made in the Patent Owner Response filed in the Apple IPR (*compare* Prelim. Resp. 12–33, *with* Apple IPR PO Resp. (IPR2018-00387, Paper 11), 11–30). Those common arguments will be fully considered in the Apple IPR with the benefit of a complete record.

Regarding claim 20, Petitioner relies on its analysis of claim 3, and Patent Owner relies on its arguments regarding claim 6. *See* Pet. 72–73; Prelim. Resp. 31. Patent Owner also argues that the challenge to claim 20 is conclusory, asserting that "Petitioner may not rely on conclusory testimony of a declarant as to what would have been common knowledge at the time." Prelim Resp. 31–32. This argument is unpersuasive because neither Petitioner nor Petitioner's declarant present an argument based on "common knowledge." Rather, as discussed below, Petitioner relies on prior arguments regarding claim 3. *See* Pet. 72–73.

In sum, based on the current record, Patent Owner's arguments made in its Preliminary Response in this case do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the grounds asserted in the Petition, including the same grounds instituted in IPR2018–00387.

Additionally, Patent Owner notes that an argument made in an appeal pending at the U.S. Court of Appeals for the Federal Circuit asserts that "the Board's appointments of administrative patent judges violate the Appointments Clause of Article II" of the U.S. Constitution. Prelim. Resp. 32–33. "Patent Owner . . . adopts this constitutional challenge . . . to ensure the issue is preserved pending the appeal." *Id.* at 33.

The Board has previously "declin[ed] to consider [the] constitutional challenge as, generally, 'administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments.'" *Square, Inc. Unwired Planet LLC*, IPR2014-01165, Paper 32, 25 (PTAB Oct. 30, 2015) (quoting *Riggin v. Office of Senate Fair Employment Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995)). We, likewise, decline to consider Patent Owner's constitutionality argument.

III. MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of August 23, 2018. *See* Paper 5. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Apple IPR, i.e., July 23, 2018. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a

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