

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00889
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 Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

Samsung Electronics America, Inc. (“Petitioner” or “Samsung”) 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, Samsung filed a Motion for Joinder with *HTC Corp. v. Uniloc 2017 LLC*, Case IPR2018-01589 (“the HTC IPR”). Paper 3 (“Motion” or “Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) and an Opposition to the Motion for Joinder (Paper 7, “Opposition” or “Opp.”). Samsung subsequently filed a Reply to the Opposition. Paper 8 (“Reply”). In its Reply, Petitioner stated that it “consents to limit its petition and joinder motion to claim 20.” *Id.* at 4.

For the reasons explained below, we institute an *inter partes* review of claim 20 of the ’508 patent, and grant 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 Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. as real parties-in-interest. Pet. 1. Patent Owner states that its sole real party-in-interest is Uniloc 2017 LLC. Paper 4, 1.

C. Related Matters

The parties indicate that the '508 patent is the subject of the several litigation proceedings:

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),

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. 1–2; Paper 4, 2. The '508 patent is also the subject of several proceedings before the Board:

Apple Inc. v. Uniloc 2017 LLC, Case IPR2018-00387,

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

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

HTC Corp. v. Uniloc 2017 LLC, Case IPR2018-01589, and

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

See Pet. 2; Paper 4, 2.

D. Procedural Posture

In the HTC IPR, we instituted an *inter partes* review of claim 20 of the '508 patent as being unpatentable under 35 U.S.C. § 103(a) in view of Pasolini¹ and Fabio.² Although HTC sought review of claims 1–4, 6–8, 11–16, 19, and 20 in the HTC IPR, we explained that only claim 20 would be reviewed:

Given that Petitioner is being joined as a party to [IPR2018-00387 (“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.

HTC IPR, Institution Decision (IPR2018-01589, Paper 9, “HTC Decision” or “HTC Dec.”), 10 (all but first alteration in original).

A Final Written Decision in the Apple IPR issued on June 17, 2019. Apple IPR, Paper 21. In the Decision, we determined claims 1–4, 6–8, 11–16, and 19 of the '508 patent to be unpatentable. *Id.* at 49. As such, the HTC Petitioner is estopped from maintaining any challenges to claims 1–4, 6–8, 11–16, and 19 in the HTC IPR. *See* 35 U.S.C. § 315(e)(1); 37 C.F.R.

¹ US 7,463,997 B2 (filed Oct. 2, 2006, issued Dec. 9, 2008) (Ex. 1005, “Pasolini”).

² US 7,698,097 B2 (filed Oct. 2, 2006, issued Apr. 13, 2010) (Ex. 1006, “Fabio”).

§ 42.73(d)(1). The HTC IPR, therefore, is limited to the challenge of claim 20.

In its Reply, Petitioner stated that it “consents to limit its petition and joinder motion to claim 20.” Reply 4. We understand Petitioner to withdraw its challenges in the Petition regarding claims 1–4, 6–8, 11–16, and 19, and to withdraw its requests in the Motion to join any challenge to claims 1–4, 6–8, 11–16, and 19 to the HTC IPR. As such, the challenges to claims 1–4, 6–8, 11–16, and 19 are withdrawn from consideration in this proceeding. The sole ground of unpatentability remaining in dispute is the challenge to claim 20 as being unpatentable under 35 U.S.C. § 103(a) in view of Pasolini and Fabio.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability regarding claim 20 as asserted in the HTC IPR. *Compare* Pet. 16, *with* HTC IPR, Paper 1, 16 (“HTC Petition”). Indeed, Petitioner contends that the Petition “introduces identical arguments and the same ground[] raised in the existing HTC [IPR],” there are no new arguments for the Board to consider, and the Petitioner relies on the same exhibits and expert declaration as in the HTC IPR. Mot. 4–5.

We acknowledge Patent Owner’s arguments and evidence supporting its position that claim 20 would not have been obvious. Prelim. Resp. 34–38. Certain of Patent Owner’s arguments against the merits of the Petition have been previously addressed in the HTC 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

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