

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORP.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01283
Patent 7,167,487 B2

Before ROBERT J. WEINSCHENK, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

BlackBerry Corporation (“Petitioner”) filed a Petition requesting *inter partes* review of claims 11–13 (“the challenged claims”) of U.S. Patent No. 7,167,487 B2 (Ex. 1001, “the ’487 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to the following instituted proceeding: *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00252 (PTAB) (“the Apple IPR”). Paper 3 (“Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 7, “Opp.”) and a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”). Petitioner file a Reply to Patent Owner’s Opposition. Paper 8 (“Reply”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we institute *inter partes* review of all challenged claims, and grant Petitioner’s Motion for Joinder.

B. Real Parties in Interest

Petitioner identifies itself and BlackBerry Ltd. as the real parties-in-interest. Pet. 81. Patent Owner identifies itself as the real party-in-interest. Paper 4, 1.

C. Related Matters

Petitioner and Patent Owner identify various matters between Uniloc Luxembourg SA, Uniloc USA, Inc. or Uniloc 2017 LLC, and Apple, Inc., AT&T Services, Inc., BlackBerry Corp., HTC America, Inc., Huawei Device USA, Inc., LG Electronics USA, Inc., Microsoft Corp., Motorola Mobility, LLC, Samsung Electronics America, Inc., or ZTE (USA) Inc., currently before the Board and various Federal District Courts, including District Courts for the Eastern, Western, and Northern Districts of Texas, the

Central and Northern Districts of California, the District of Delaware, and the Western District of Washington, as matters that could affect or be affected by this proceeding. *See* Pet. 81–83; Paper 4, 2.

D. Evidence¹

References	Effective Date ²	Exhibit	
<i>MAC protocol specification (Release 1999), 3rd Generation Partnership Project, 3GPP TS 25.321 V3.6.0 (2000–12) (“TS 25.321”).</i>	Dec. 10, 2000	1007	
<i>Corrections to logical channel priorities in MAC protocol, 3rd Generation Partnership Project, 3GPP TSG-RAN WG2 Meeting #18 (“R2-010182”).</i>	Jan. 23, 2001	1008	
<i>Services provided by the physical layer (Release 1999), 3rd Generation Partnership Project, 3GPP TS 25.302 V3.6.0 (2000–09) (“TS 25.302”).</i>	Oct. 16, 2000	1009	
Peisa	US 6,850,540 B1	Oct. 27, 2000 ³	1013

E. Asserted Grounds

Petitioner asserts that claims 11–13 are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References
11–13	103(a)	TS 25.321, TS 25.302, R2-010182
11–13	103(a)	Peisa

¹ Petitioner also relies upon the Declarations of R. Michael Buehrer, Ph.D., FIEEE (Ex. 1002) and Craig Bishop (Ex. 1006).

² Petitioner relies upon the Bishop Declaration to establish the public availability of TS25.302, TS25.321, and R2-010182, and their respective publication dates. *See* Pet. 10, 13, 17.

³ Petitioner relies on the U.S. filing date of Peisa to establish its availability as prior art under 35 U.S.C. § 102(e). *See* Pet. 21.

II. ANALYSIS

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner avers that its Petition “is substantively identical to the Apple [p]etition, containing only minor differences related to the formalities required by a different party filing the petition and the updated claim construction standard.” Mot. 5.⁴ Petitioner, therefore, avers that the Petition “challenges the same claims, relies on declarations from the same experts, and is based on the same grounds and combinations of prior art submitted in the Apple [p]etition.” *Id.* Our independent review of the Petition and the Apple petition, including the expert declarations filed in both, confirm Petitioner’s representations.

The petition in the Apple IPR was filed on November 12, 2018, challenging claims 11–13 of the ’487 patent on the same grounds raised in this Petition. *Compare* Apple IPR, Paper 5 at 4, *with* Pet. 4. Patent Owner filed a preliminary response to the Apple IPR petition on March 6, 2019. Apple IPR, Paper 9. We instituted *inter partes* review of claims 11–13 of the ’487 patent based on the petition in the Apple IPR on June 4, 2019. *Id.*,

⁴ In the Apple IPR, we applied the broadest reasonable interpretation claim construction standard, but declined to expressly construe any claim term. Apple IPR, Paper 11 at 7–8. Thus, we found all claim terms had their ordinary and customary meaning as understood by a person skilled in the art in the context of the patent’s disclosure. *Id.* (citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007)). In this Petition, we apply the claim construction standard applied in civil proceedings under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2019). Nonetheless, because neither Petitioner nor Patent Owner request express construction of any claim term, we decline to expressly construe any claim term, and instead find all claim terms have their ordinary and customary meaning as understood by a person skilled in the art in the context of the patent’s disclosure and prosecution history. *Id.*; *see also* Pet. 24; Prelim. Resp. 15.

Paper 11 at 60. Patent Owner filed a response to the petition in the Apple IPR on August 27, 2019. *Id.*, Paper 14.

Patent Owner filed a Preliminary Response to this Petition on October 22, 2019. *See* Prelim. Resp. 27. Based on our independent review, the arguments raised in Patent Owner’s Preliminary Response are the same as or substantially similar to the arguments raised in Patent Owner’s preliminary response to the petition in the Apple IPR. *Compare* Prelim. Resp. 16–27, *with* Apple IPR, Paper 9 at 20–35.⁵ Moreover, the arguments raised in Patent Owner’s Preliminary Response are nearly identical to the arguments raised in Patent Owner’s response to the petition in the Apple IPR. *Compare* Prelim. Resp. 1–27, *with* Apple IPR, Paper 14 at 1–27.

At this stage of the proceeding and based on our preliminary review, we find Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims for the same reasons discussed in our Decision on Institution in the Apple IPR. Granting the Petition and joining Petitioner to the Apple IPR will provide us with the opportunity to more fully consider Patent Owner’s arguments—first raised in response to the petition in the Apple IPR—in the context in which they were first raised.

Accordingly, for the reasons discussed above, we are persuaded Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims of the ’487 patent, grant the Petition, and institute *inter partes* review of the challenged claims.

⁵ The Preliminary Response does not raise several arguments Patent Owner raised in its preliminary response to the petition in the Apple IPR, including arguments regarding raising redundant challenges in multiple grounds, and arguments regarding the Constitutionality of *inter partes* reviews. *See* Apple IPR, Paper 9 at 17–19, 36.

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