

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-00700
Patent 8,406,116 B2

Before SALLY C. MEDLEY, JEFFREY S. SMITH, and
JOHN F. HORVATH, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 8,406,116 B2 (Ex. 1001, “the ’116 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted *inter partes* review, pursuant to 35 U.S.C. § 314, as to claims 1–20 based on all challenges set forth in the Petition. Paper 7 (“Decision to Institute” or “Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 9, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 10, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 11, “Sur-reply”). On May 21, 2020, we held an oral hearing. A transcript of the hearing is of record. Paper 16 (“Tr.”).

In our Scheduling Order, we notified the parties that “any arguments not raised in the [Patent Owner] response may be deemed waived.” *See* Paper 8, 7; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief.”). Patent Owner argues that it “does not concede, and specifically denies, that there is any legitimacy to any arguments in the instant Petition that are not specifically addressed” in its Patent Owner Response. PO Resp. 17 n.7. We decline to speculate as to what arguments Patent Owner considers illegitimate in the Petition. Any arguments for patentability not raised in the Patent Owner Response are deemed waived.

For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claims 1–20 of the ’116 patent are unpatentable.

A. Related Matters

Petitioner and Patent Owner identify *Uniloc USA, Inc., et al. v. Apple Inc.*, Case No. 1:18-cv-00166-LY (W.D. Tex.) as related to the issues presented in this proceeding. Pet. 1; Paper 4, 2.

Petitioner additionally filed proceedings challenging related patents belonging to Patent Owner (which we instituted): IPR2019-00701 (U.S. Patent No. 8,018,877 B2) and IPR2019-00702 (U.S. Patent No. 7,969,925 B2). Pet. 1–2.

B. The '116 Patent¹

The '116 patent is directed to methods and a server-based architecture for establishing data exchange between multiple mobile devices. Ex. 1001, code (57). According to the Specification, several instant messaging (“IM”) paradigms have been developed to take advantage of the growing IM market. *Id.* at 1:31–65. However, each of those paradigms are limited by system compatibility (*id.* at 1:39–44), or the failure to allow for real-time communication between more than two mobile devices. *Id.* at 1:66–2:5. Accordingly, the invention addresses these problems by creating (1) a session-based IM architecture and (2) data transfer techniques for establishing data exchange between multiple mobile devices. *Id.* at 2:22–25.

An example of a digital mobile network system is illustrated in Figure 1, reproduced below:

¹ Petitioner argues that the effective filing date of the '116 patent is no earlier than March 28, 2005. Pet. 8–10. For purposes of this Decision, we need not determine the effective filing date of the '116 patent.

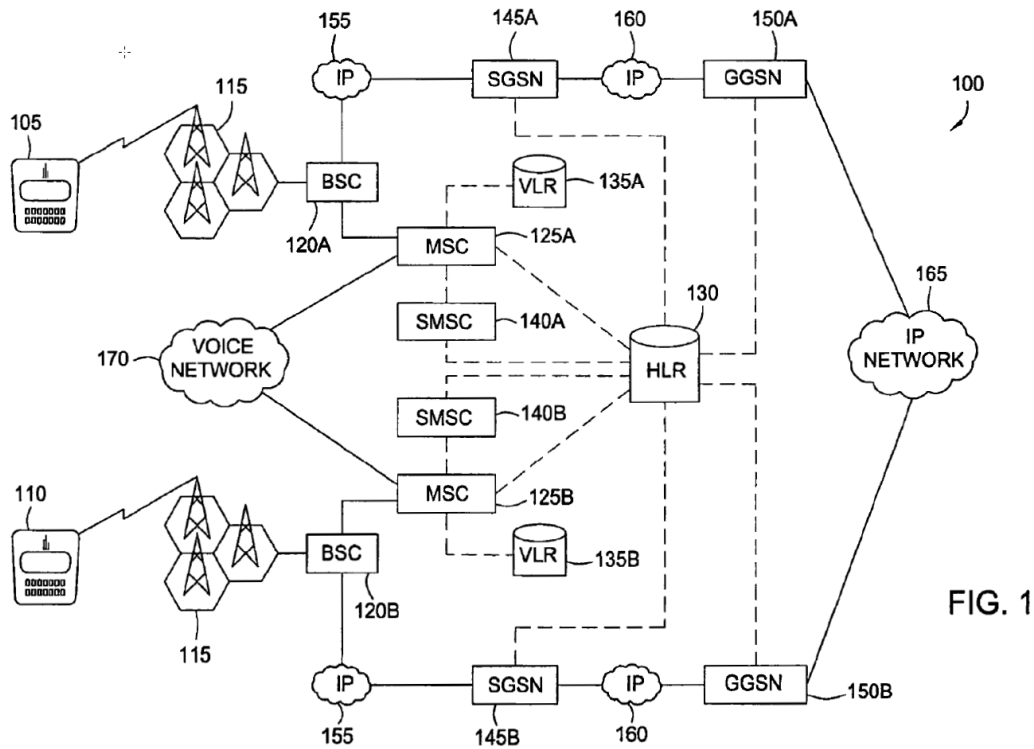


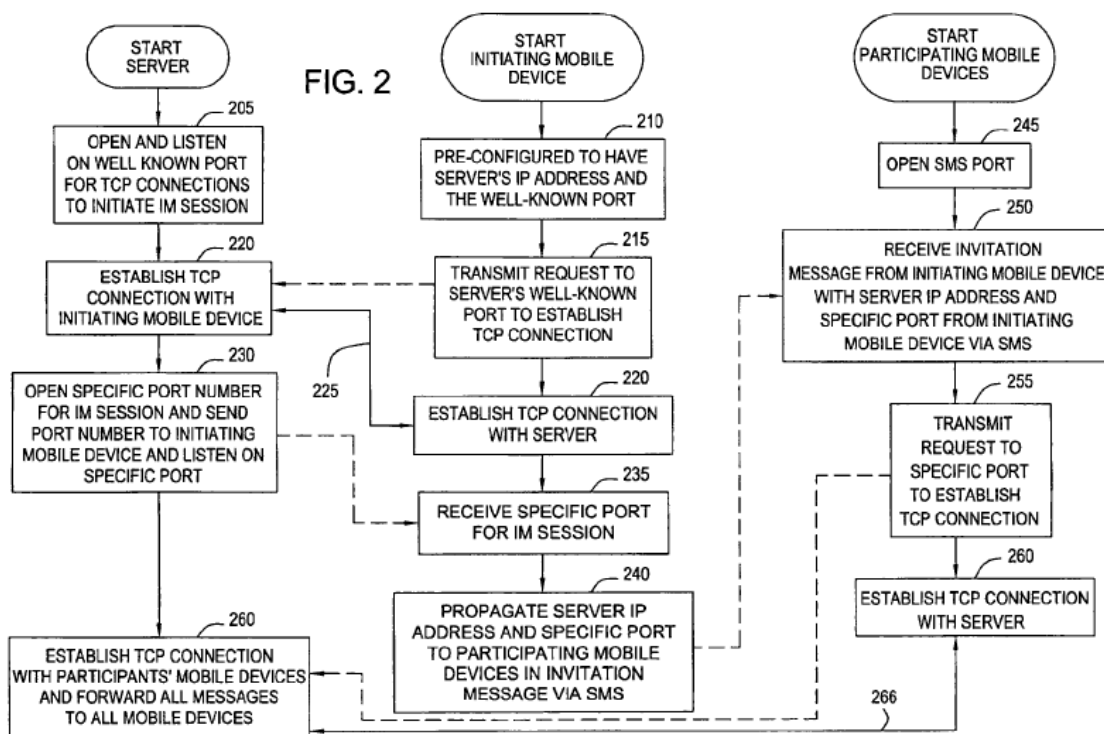
FIG. 1

Figure 1 is a diagram of a Global System for Mobile communications (GSM) mobile networking system 100 including a first mobile device 105 and a second mobile device 110. *Id.* at 2:64–3:5. As disclosed in the Specification, each of the mobile devices 105 and 110 includes a Subscriber Information Module (SIM) card that contains unique identification information that enables the GSM system 100 to locate the mobile devices within the network and route data to them. *Id.* at 3:1–5. The Specification further discloses that the GSM system 100 supports a page-mode messaging service, such as Short Message Service (SMS), that relies upon the underlying GSM mechanisms to resolve routing information in order to locate destination mobile devices. *Id.* at 3:42–46; *see also id.* at 3:57–4:4 (describing a typical transmission of an SMS text message from the initiating mobile device 105 to the receiving mobile device 110).

Generally, the invention initiates data exchange between multiple mobile devices by first receiving, at a server, a request from the initiating

mobile device to allocate a session identifier to use for data exchange. *Id.* at 2:25–40. Once the session identifier has been allocated, the server transmits the session identifier to the initiating mobile device, whereupon the initiating mobile device communicates the session identifier to the participating mobile device. *Id.* Once the initiating mobile device and participating mobile device have the session identifier, the session identifier is used to establish a connection at the server, whereby data exchange is facilitated. *Id.*

Figure 2, reproduced below, illustrates a flow chart depicting one embodiment of a server-based architecture in accordance with the present invention:



In Figure 2, the server, having a publically accessible network address, opens and listens for mobile device connection requests on a well-known port. *Id.* at 4:40–51. After receiving a connection request from an initiating mobile device, the server establishes a connection with the initiating mobile

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