UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORP.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

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IPR2019-01026
Patent 6,993,049 B2

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Before SALLY C. MEDLEY, JEFFREY S. SMITH, and GARTH D. BAER,
Administrative Patent Judges.

BAER, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Microsoft Corporation ("Petitioner") filed a Petition (Paper 1, "Pet."), requesting an *inter partes* review of claims 11 and 12 (the "challenged claims") of U.S. Patent No. 6,993,049 B2 (Ex. 1001, "the '049 Patent"). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response to the Petition (Paper 6, "Prelim. Resp.").

We have authority to determine whether to institute an *inter partes* review. For the reasons discussed below, we grant the Petition and institute an *inter partes* review.

A. THE '049 PATENT

The '049 patent is directed to a communication system comprising a primary station and one or more secondary stations. Ex. 1001, Abstract. The primary station broadcasts a series of inquiry messages and adds to the inquiry messages an additional data field for polling secondary stations. *Id.* This system is useful for communications between the stations without requiring a permanently active link, such as is common with the Bluetooth communications protocol. *Id.*

B. ILLUSTRATIVE CLAIM

Petitioner challenges claims 11 and 12 of the '049 Patent. Claim 11 is the only independent challenged claim and is reproduced below:

> 11. A method of operating a communication system comprising a primary station and at least one secondary station, the method comprising the primary station broadcasting a series of inquiry messages, each in the form of a plurality of predetermined data fields arranged according to a first communications protocol, and adding to an inquiry message prior to transmission an additional data field for polling at least one secondary station, and further comprising the at least one polled secondary station

determining when an additional data field has been added to the plurality of data fields, determining whether it has been polled from the additional data field and responding to a poll when it has data for transmission to the primary station.

Ex. 1001, 8:35–47.

C. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 2.

Claims Challenged	35 U.S.C. §	References/Basis
11, 12	103	Larsson[1], Bluetooth Specification[2], RFC826[3]
11, 12	103	802.11[4]

II. DISCUSSION

A. CLAIM CONSTRUCTION

In *inter partes* reviews, we interpret claims "using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b). Under this standard, we construe claims "in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." *Id.* Only claim terms that are in controversy need to be construed and only to the extent

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[1] U.S. Patent No. 6,704,293 B1 (iss. Dec. 6, 1999) (Ex. 1004, "Larsson").

[2] Bluetooth™ Core Specification Vol. 1, ver. 1.0 B (pub. Dec. 1, 1999) (Ex. 1005, "Bluetooth Specification").

[3] David C. Plummer, *An Ethernet Address Resolution Protocol*, IETF Request for Comments No. 826 (Pub. Nov. 1982) (Ex. 1006, "RFC826").

[4] ANSI/IEEE Std 802.11, Part 11: *Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications* (pub. Aug. 20, 1999) (Ex. 1007, "802.11").

necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner does not propose any terms for claim construction. *See* Pet. 11–12. Patent Owner proposes we construe "additional data field" as "an extra data field appended to an inquiry message." Prelim. Resp. 5–7. We disagree with Patent Owner's construction. Independent claim 11 already has language that accounts for the language Patent Owner seeks to add through claim construction. Specifically, we do not need to construe an "additional data field" as "an extra data field appended to an inquiry message" because the challenged claims already recite "adding to an inquiry message . . . an additional data field." Ex. 1001, 8:39–40. To the extent Patent Owner seeks to distinguish "appending" from "adding," on this record and for purposes of this Decision, we do not view those two terms as meaningfully distinct. To the extent Patent Owner wishes to develop its argument in subsequent briefing, we will revisit the issue. However, based on the current record and for purposes of this decision, we decline to adopt Patent Owner's proposed construction of "additional data field."

B. ASSERTED PRIOR ART

1. *Larsson (Ex. 1004)*

Larsson discloses a:

> method and/or an apparatus which places a broadcast message which the source expects a reply message in a broadcast message for route discovery. The combined message is broadcast throughout the ad-hoc network. When the combined broadcast message is received at the destination node, the destination node generates a response message including a reply message to the broadcast message including a reply message that the source node expects a reply. The response message is sent back to the source node over the route which the combined broadcast message traveled to the destination node.

Ex. 1004, Abstract.

2. *Bluetooth Specification (Ex. 1005)*

Bluetooth Specification defines requirements for a transceiver operating the Bluetooth wireless communication protocol. Ex. 1014, 18. Section 4.4 discusses different data packet types, *id.* at 55, and Section 4.5 provides detail of the payload within a packet, including a data field, *id.* at 62.

3. *RFC826 (Ex. 1006)*

Relevant to this case, RFC826 describes the structure and content of Ethernet Address Resolution Protocol (ARP) messages. Ex. 1006, 1.

4. *802.11 (Ex. 1007)*

802.11 is an IEEE standard that specifies "[t]he medium access control (MAC) and physical characteristics for wireless local area networks (LANs)." Ex. 1007, iii. The network includes a basic service set (BSS), which is "[a] set of stations controlled by a single coordination function." *Id.* at 3. To communicate with other stations, a station uses a scan function to "determin[e] the characteristics of the available BSSs." *Id.* at 101. "Active scanning involves the generation of Probe frames and the subsequent processing of received Probe Response frames." *Id.* at 126. A typical broadcast probe request message seeks a response from any BSS and does not include the address of a specific SSID. Ex. 1003 ¶ 43 (citing Ex. 1007, 126, Fig.66). If a device wishes to probe a specific BSS, however, then it includes the SSID of the specifically-targeted BSS during the active scanning process. *Id.* (citing Ex. 1007, 126).

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