

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ERICSSON INC.,  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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IPR2020-00376  
Patent 7,016,676 B2

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Before JAMESON LEE, KEVIN F. TURNER, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION

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

Granting Motion for Joinder  
*37 C.F.R. § 42.122(b)*

I. INTRODUCTION

On January 3, 2020, Ericsson Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1 and 2 of U.S. Patent No. 7,016,676 B2 (Ex. 1001, “the

IPR2020-00376  
Patent 7,016,676 B2

'676 patent").<sup>1</sup> Paper 2 ("Pet."). Petitioner also filed a Motion for Joinder with *Microsoft Corporation v. Uniloc 2017 LLC*, Case IPR2019-01116 ("the 116 IPR"). Paper 4 ("Mot."). Petitioner further filed a Supplemental Motion for Joinder, authorized by the Board. Paper 9 ("Supp. Mot").

Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response to the Petition. Paper 15 ("Prelim. Resp."). Patent Owner also filed an Opposition to the Motion for Joinder and Supplemental Motion for Joinder. Paper 11 ("Opp."). Petitioner filed a Reply to Patent Owner's Opposition. Paper 13 ("Reply").

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For reasons discussed below, we institute an *inter partes* review of claims 1 and 2 and grant Petitioner's Motion for Joinder, as supplemented by the Supplemental Motion for Joinder.

## II. RELATED PROCEEDINGS

The parties indicate that the '676 patent is the subject of multiple court proceedings and the 116 IPR. Pet. ix, x; Paper 6, 2. The parties further indicate that the '676 patent also is the involved patent in IPR2019-01125 (filed by Microsoft Corporation), IPR2019-01349 and IPR2019-01350 (filed by Marvell Semiconductor, Inc.), IPR2019-01541 (filed by Google, LLC), and IPR2019-01550 (filed by Ericsson Inc.). *Id.*

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<sup>1</sup> This is the second petition for *inter partes* review filed by Petitioner against claims of the '676 patent. Ericsson is also the Petitioner in IPR2020-01550 which seeks review of claims 1, 2, and 8 of the '676 patent. On March 17, 2020, we declined institution of review in IPR2019-01550. IPR2019-01550, Paper 8.

In the 116 IPR, we instituted an *inter partes* review of claims 1 and 2 of the '676 patent on the following grounds:

Claims Challenged	Basis	References
1 and 2	§ 103	HomeRF <sup>2</sup>
1 and 2	§ 103	HomeRF and HomeRF Tutorial <sup>3</sup>
1 and 2	§ 103	HomeRF and HomeRF Liaison Report <sup>4</sup>
1 and 2	§ 103	Lansford <sup>5</sup>

*Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01116, Paper 8 at 10, 54 (PTAB Dec. 4, 2019) (“116 Decision” or “116 Dec.”).

### III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability, directed to the same claims, as the ones on which we instituted review in the 116 IPR. *Compare* Pet. 2, with 116 Dec. 10, 54. Petitioner states that it “seeks institution on the same claims, prior art, and grounds for unpatentability that were instituted in the Microsoft IPR.” Mot. 1. Petitioner further states that its Petition “is based on the same grounds and same technical expert declaration testimony

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<sup>2</sup> Kevin J. Negus et al., *HomeRF: Wireless Networking for the Connected Home*, 7 IEEE PERSONAL COMMUNICATIONS 20–27 (2000).

<sup>3</sup> Jim Lansford et al., *HomeRF: Bringing Wireless Connectivity Home*, IEEE 802.11, 1–27 (1999), [http://www.ieee802.org/11/Documents/DocumentArchives/1999\\_docs/90548S-WPAN-HomeRF-Tutorial-Office-97.pdf](http://www.ieee802.org/11/Documents/DocumentArchives/1999_docs/90548S-WPAN-HomeRF-Tutorial-Office-97.pdf).

<sup>4</sup> Tim Blaney, *HomeRF™ Working Group 3rd Liaison Report*, IEEE 802.11, 1–13 (1998), [http://www.ieee802.org/11/Documents/DocumentArchives/1998\\_docs/82997S-HomeRF-3rd-Liaison.pdf](http://www.ieee802.org/11/Documents/DocumentArchives/1998_docs/82997S-HomeRF-3rd-Liaison.pdf).

<sup>5</sup> US 6,937,158 B2, issued Aug. 30, 2005 (Ex. 1012, “Lansford”).

relied upon in the Microsoft Petition,” and “is substantively identical to the Microsoft Petition.” *Id.* at 4. With respect to differences, Petitioner states:

The only minor changes include (1) changes necessary for proper identification of the party filing the petition and corresponding documents; (2) a substantively identical declaration (signed by a librarian at Haynes and Boone, LLP, rather than a paralegal from the law firm of Microsoft’s counsel in IPR2019-01116) regarding details related to the public accessibility of certain documents; and (3) correction of minor typographical errors.

*Id.*

We have considered Patent Owner’s Preliminary Response. Certain of Patent Owner’s arguments and evidence supporting its position that claims 1 and 2 would not have been obvious were previously addressed in the 116 Decision and need not be addressed here again. However, certain other arguments are new and those new arguments closely track arguments made in the Patent Owner Response filed in the 116 IPR. Because we need to conclude only that Petitioner has shown a reasonable likelihood that it would prevail in establishing that at least one claim is unpatentable, we only reach the alleged unpatentability of claim 1 as unpatentable over Lansford. In that regard, what we said in the Institution Decision of the 116 IPR equally applies here and need not be repeated. We address only Patent Owner’s new arguments which were not in the Preliminary Response of the 116 IPR. For reasons discussed below, those arguments are unpersuasive.

All of the new arguments with regard to alleged obviousness over Lansford pertain to our application of the Board's precedential decision in *Ex parte Schulhauser*, Appeal No. 2013–007847 (PTAB April 28, 2016) (Precedential). Prelim. Resp. 49–55. Claim 1 reads as follows:

1. An interface-control protocol method for a radio system which has at least one common frequency band that is provided for alternate use by a first and a second radio interface standard, the radio system comprising:

stations which operate in accordance with a first radio interface standard and/or a second radio interface standard, and

a control station which controls the alternate use of the frequency band,

wherein the control station controls the access to the common frequency band for stations working in accordance with the first radio interface standard and—renders the frequency band available for access by the stations working in accordance with the second radio interface standard if stations working in accordance with the first radio interface standard do not request access to the frequency band.

As we stated in the Institution Decision of the 116 IPR, we read the wherein clause of claim 1 as setting forth two steps, both carried out by the control station:

(1) “controls access to the common frequency band for stations working in accordance with the first radio interface standard,” and (2) “renders the frequency band available for access by the stations working in accordance with the second radio interface standard if stations working in accordance with the first radio interface standard do not request access to the frequency band.” 116 IPR, Paper 8, 16.

In the Institution Decision of the 116 IPR, we explained:

The insufficient accounting by Petitioner of step (2) of claim 1, however, is harmless, because step (2) is a conditional step. With regard to application of conditional steps, we are bound by the

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