

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01218
Patent 6,836,654 B2

Before JENNIFER S. BISK, NEIL T. POWELL, and JOHN D.
HAMANN, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Samsung Electronics America, Inc., filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–9 of U.S. Patent No. 6,836,654 B2 (Ex. 1001, “the ’654 patent”). Patent Owner Uniloc 2017 LLC filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Having considered the Petition and Preliminary Response, we conclude the Petition should be denied for the reasons discussed below.

II. BACKGROUND

A. *Related Matters*

The parties identify a number of district court proceedings involving the ’654 patent. Pet. 1; Paper 3, 2. Of the identified district court proceedings, Petitioner is involved in one, specifically *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, Case No. 2-18-cv-00508 (E.D. Tex.) (hereafter “the district court proceeding”). Additionally, Petitioner has filed another Petition challenging the ’654 patent in IPR2019-01219.

B. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1–9 of the '654 patent are unpatentable based on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–3, 7–9	103 ¹	Nokia ² , Alos ³
4–6	103	Nokia, Alos, Kemppe ⁴
1, 2, 7–9	103	Matsukida ⁵ , Alos
4–6	103	Matsukida, Alos, Kemppe
3	103	Matsukida, Alos, Miller ⁶

Petitioner also relies on the Declaration of Zygmunt J. Haas, Ph.D. (Ex. 1002).

C. The '654 Patent

The '654 patent relates to protecting against theft of a mobile radiotelephony device. Ex. 1001, code (57). The '654 patent notes a previously disclosed method of protecting a radiotelephone by creating a

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the '654 patent has an effective filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of § 103.

² Owner's Manual for the Nokia 9000i Communicator, Issue 1.1 (Ex. 1004).

³ Published U.S. Patent Application No. 2002/0147028 A1, pub. Oct. 10, 2002 (Ex. 1005).

⁴ U.S. Patent No. 4,868,846, iss. Sep. 19, 1989, (Ex. 1006).

⁵ Japanese Patent Application Publication No. JP H6-216841, pub. Aug. 5, 1994 (Ex. 1021).

⁶ U.S. Patent No. 6,141,563, iss. Oct. 31, 2000, (Ex. 1022).

link between the device and a particular user identification module and preventing normal use of the device in the event that the user identification module installed in the device is not the linked user identification module. *Id.* at 1:21–29. The ’654 patent laments that this method may allow use of a lost or stolen device until the user alerts an operator and the network blocks use of the identification module linked to the device. *Id.* at 1:30–36.

To address this issue, the ’654 patent discloses a method of blocking normal use of a radiotelephony device that has a user identification module. *Id.* at 1:39–50. Specifically, the ’654 patent discloses blocking normal use of the radiotelephony device in response to confirmation of the user identification module and detection of a period of inactivity of the device. *Id.* Consequently, when the device is lost or stolen, by the time a third party has the device, “it has most probably been inactive for a period of time that is sufficiently long for its normal operation to be blocked.” *Id.* at 1:51–54. “Thanks to the invention the lost or stolen device becomes totally unusable.” *Id.* at 1:59–60.

D. Illustrative Claim

Claim 1 is independent. Each of claims 2–9 depends, directly or indirectly, from independent claim 1. Claim 1 is illustrative and recites:

1. A mobile radiotelephony device, comprising:

blocking means for preventing a normal operation of the mobile radiotelephony device, wherein the normal operation includes processing of outgoing calls;

timing means for activating the blocking means in response to the mobile radiotelephony device being inactive during the normal operation of the mobile radiotelephony device for a defined period of time subsequent to a mounting of a linked

user identification module inside the mobile radiotelephony device; and

deblocking means for permitting the normal operation of the mobile radiotelephony device in response to a supply of a deblocking code to the mobile radiotelephony device subsequent to the mounting of the linked user identification module inside the mobile radiotelephony device and subsequent to the defined period of time.

Ex. 1001, 6:39–56.

III. ANALYSIS

A. Claim Construction

In an *inter partes* review for a petition filed on or after November 13, 2018, the “[claims] of a patent ... shall be construed using the same claim construction standard that would be used to construe the [claims] in a civil action under 35 U.S.C. § 282(b), including construing the [claims] in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100(b) (2019)) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005). Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

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