

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. and MOTOROLA MOBILITY LLC,  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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IPR2020-00701  
Patent 6,836,654 B2

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

HAMANN, *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 March 11, 2020, Apple Inc. (“Apple”) and Motorola Mobility LLC (“Motorola”) (collectively “Petitioner”)<sup>1</sup> filed a Petition for *inter partes* review of claims 10–20 of U.S. Patent No. 6,836,654 B2 (Ex. 1001, “the ’654 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 11 (“Prelim. Resp.”).

Petitioner also filed a Motion for Joinder with *Microsoft Corporation v. Uniloc 2017 LLC*, Case IPR2019-01471 (“the 1471 IPR”). Paper 5 (“Mot.”). Patent Owner did not file an opposition to the Motion for Joinder.

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 10–20 and grant Petitioner’s Motion for Joinder.

## II. RELATED PROCEEDINGS

The parties indicate that the ’654 patent is the subject of multiple district court proceedings. Pet. vi–vii; Paper 7, 2–3. The parties further indicate that the ’654 patent was the subject of the following proceedings, for which we denied institution: (1) IPR2019-01218 and IPR2019-01219, filed by Samsung; and (2) IPR2019-01470, filed by Microsoft Corporation (“Microsoft”). Pet. vii–viii; Paper 7, 2. Lastly, the parties indicate that the

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<sup>1</sup> Samsung Electronics America, Inc. (“Samsung”) also was a Petitioner when the Petition was filed. Subsequently, the proceeding was terminated as to Samsung due to settlement. *See generally* Paper 12.

IPR2020-00701  
Patent 6,836,654 B2

'654 patent is the subject of IPR2019-01471, for which the Board instituted trial on February 11, 2020. Pet. viii; Paper 7, 2.

In the 1471 IPR, we instituted an *inter partes* review of claims 10–20 of the '654 patent on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
10–20	103(a)	Nokia <sup>2</sup> and Barvesten <sup>3</sup>
10–20	103(a)	Barvesten and Schultz <sup>4</sup>

*Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01471, Paper 7 at 8, 24 (PTAB Feb. 11, 2020) (“1471 Decision” or “1471 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 1471 IPR. *Compare* Pet. 2, with 1471 Dec. 8, 24. Indeed, Petitioner argues that the Petition and the 1471 Petition “are substantially identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims.” Mot. 1 (citing Ex. 1016) (“Comparison between the Current Petition and Petition in IPR2019-01471”). Petitioner also indicates that it relies on the same declaration from the same expert as in the 1471 IPR. *Id.* at 3, 7–8.

We have considered Patent Owner’s Preliminary Response. Patent Owner raises arguments therein that it did not raise in its Preliminary Response in the 1471 IPR. *Compare generally* Prelim. Resp., with

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<sup>2</sup> Owner’s Manual for the Nokia 9000i Communicator, Issue 1.1 (Ex. 1003).

<sup>3</sup> U.S. Patent No. 5,940,773 (issued Aug. 17, 1999) (Ex. 1006).

<sup>4</sup> Charles P. Schultz, *Communication Device Inactivity Password Lock*, 29 MOTOROLA TECH. DEVS. 14–15 (Nov. 1996) (Ex. 1008).

*Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01471, Paper 6. For example, Patent Owner argues here that the asserted combinations of references (i.e., Nokia and Barvesten, and Barvesten and Schultz) fail to teach a limitation of the independent claims, and that one of skill in the art would not have combined the relevant teachings of the references. *See* Prelim. Resp. 6–13. For reasons discussed below, Patent Owner’s arguments are unpersuasive.

First, Patent Owner argues that the asserted grounds fail to teach “verifying a user identification module mounted inside the mobile radiotelephony device is linked to the mobile radiotelephony device,” as recited in independent claims 10 and 17. *Id.* To that end, Patent Owner argues that this claim limitation should be given its plain and ordinary meaning, but the Petition misconstrues its plain and ordinary meaning. *Id.* at 6–7. According to Patent Owner, this step also includes “limiting the use of the user identification module only to the device that it is linked with.” *Id.* at 8; *see also id.* at 7–8 (citing Ex. 1001, Fig. 3, 2:61–3:43, 4:23–30) (arguing that embodiments in the ’654 patent teach this limiting use requirement). Patent Owner argues that the Petition thus fails because the references do not teach “any user identification module that is linked to a device *such that it can only function with that device.*” *Id.* at 7 (emphasis added); *see also id.* at 6–13 (arguing that Barvesten, Nokia, and Schultz fail to teach this limitation).

At this stage of the proceeding, we conclude that rather than seeking to apply the plain and ordinary meaning of this step, Patent Owner seeks to import limitations from the Specification into the claim language. However, even if the cited portions of the Specification disclose what Patent Owner

alleges, Patent Owner does not provide sufficient justification for importing “such that [the user identification module] can only function with that device” from certain embodiments in the Specification into this step.

Prelim. Resp. 7; *see Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“[I]t is important not to import into a claim limitations that are not a part of the claim.”). Accordingly, on this record we are not persuaded by Patent Owner’s arguments, which are premised on this importation, that Nokia, Barvesten, and Schultz fail to teach the claimed verifying step. We also are not persuaded by Patent Owner’s arguments that Nokia, Barvesten, and Schultz fail to teach this step to the extent that the arguments focus on the references individually, rather than the combined teachings of the references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references”).

Second, we also are not persuaded by Patent Owner’s argument that Nokia is not enabled. Prelim. Resp. 8–9. This argument “is misplaced, since even ‘[a] non-enabling reference may qualify as prior art for the purpose of determining obviousness,’ . . . and even ‘an inoperative device . . . is prior art for all that it teaches.’” *ABT Sys., LLC v. Emerson Elec. Co.*, 797 F.3d 1350, 1360 n.2 (Fed. Cir. 2015) (quoting *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989) and *Symbol Tech., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991)).

Third, we also are not persuaded by Patent Owner’s argument that “Barvesten cannot be reasonably combined with Nokia because it was well known to any [person of ordinary skill in the art] at the time of the ’654

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