

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01471
Patent 6,836,654 B2

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; 37 C.F.R. § 42.4

I. INTRODUCTION

Microsoft Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 10–20 of U.S. Patent No. 6,836,654 B2 (Ex. 1001, “the ’654 patent”) pursuant to 35 U.S.C. § 311. Uniloc 2017 LLC (“Patent Owner”) filed a Patent Owner Preliminary Response (Paper 6, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may be instituted if “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the Petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* Trial Practice Guide Update (July 2019) (“TPGU”), 31 (“The Board will not institute on fewer than all claims or all challenges in a petition.”), *available at* <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>.

Upon consideration of the Petition and the Preliminary Response, we determine that the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’654 patent. Accordingly, we institute *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition.

A. Related Matters

Petitioner identifies the following as related matters that involve the '654 patent.

1.	<i>Uniloc 2017 LLC v. Microsoft Corp.</i> , 8-19-cv-00781 (C.D. Cal.)
2.	<i>Uniloc USA, Inc. v. Apple Inc.</i> , 3-19-cv-01697 (C.D. Cal.)
3.	<i>Uniloc 2017 LLC v. HTC Am., Inc.</i> , 2:18-cv-01732 (W.D. Wash.)
4.	<i>Uniloc 2017 LLC v. Motorola Mobility, LLC</i> , 1:18-cv-01844 (D. Del.)
5.	<i>Uniloc 2017 LLC v. Google LLC</i> , 2:18-cv-00493 (E.D. Tex.)
6.	<i>Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.</i> , 2:18-cv-00508 (E.D. Tex.)
7.	<i>Uniloc 2017 LLC v. Huawei Device USA, Inc.</i> , 2:18-cv-00509 (E.D. Tex.)
8.	<i>Uniloc 2017 LLC v. Google LLC</i> , 2:18-cv-00422 (E.D. Tex.)
9.	<i>Uniloc USA, Inc. v. Huawei Device USA, Inc.</i> , 2-18-cv-00357 (E.D. Tex.)
10.	<i>Uniloc USA, Inc. v. Motorola Mobility, LLC</i> , 1:18-cv-01230 (D. Del.)
11.	<i>Uniloc USA, Inc. v. Samsung Elecs. Am., Inc.</i> , 2:18-cv-00309 (E.D. Tex.)
12.	<i>Uniloc USA, Inc. v. Huawei Device USA, Inc.</i> , 2:18-cv-00310 (E.D. Tex.)
13.	<i>Uniloc USA, Inc. v. Apple Inc.</i> , 1:18-cv-00293 (W.D. Tex.)
14.	<i>Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC</i> , IPR2019-01218 (PTAB)
15.	<i>Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC</i> , IPR2019-01219 (PTAB)
16.	<i>Microsoft Corp. v. Uniloc 2017 LLC</i> , IPR2019-01470 (PTAB)

Pet. vii–viii. Patent Owner identifies nine of these matters as being “active proceedings.” Paper 3, 2.

B. The Challenged Patent (Ex. 1001)

The '654 patent relates to deterring the theft of a mobile radiotelephony device. Ex. 1001, code (57), 1:60–65. In particular, the '654 patent discloses that it deters theft by making the device “totally unusable,” if it is stolen. *Id.* at 1:60–65. The '654 patent states that it does so by

resolving what it identifies as a problem in a prior art protection method. *Id.* at 1:31–41.

More specifically, and as described by the '654 patent, the prior art method provides protection by “establishing a link between [a] device and a specific user identification module and blocking the normal operation of the device when the user identification module that is placed inside the device is not the one that is linked to the device.” *Id.* at 1:21–29. The '654 patent, however, identifies as a problem with this method that “[w]hen the device is lost or stolen with the identification module to which it is linked,” the device can be freely used until the device’s network operator is notified to block the device, which “may take a certain period of time.” *Id.* at 1:31–37.

In resolving this problem, the '654 patent notes that “when the device falls into the hands of a third party together with the identification module to which it is linked, it has most probably been inactive for a period of time.” *Id.* at 1:52–54. The '654 patent discloses that this inactive period is “sufficiently long” so that it can be used as a way to block the device’s normal operation, and to require a deblocking code to use the device, in accordance with the '654 patent’s invention. *Id.* at 1:55–59.

Figure 3, shown below, “represents a flow chart explaining the operation of the device,” in accordance with the invention of the '654 patent. *Id.* at 2:26–27, 2:30–31.

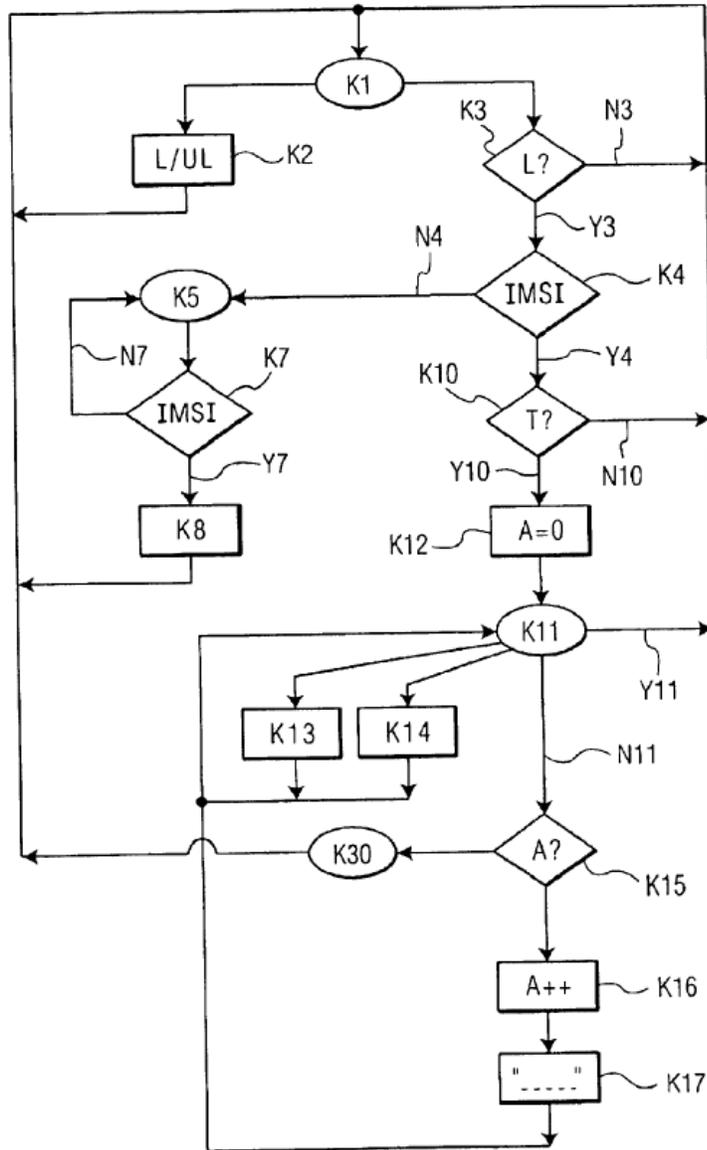


FIG. 3

Figure 3 illustrates “a function flow chart of a device in accordance with the invention” of the ’654 patent. *Id.* at 2:61–62. Starting at box K1, “the device is in a state of availability, that is to say that the user has access to all the functions of the device.” *Id.* at 2:62–65. As illustrated by box K2, the user has the choice whether to lock the device. *Id.* at 2:65–66. If the user locks the device (box K2), “the identification module that is inside the device is automatically linked to the device. For this purpose, the device

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