

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION, APPLE INC.,
and MOTOROLA MOBILITY LLC,
Petitioners,

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.*

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Microsoft Corporation (“Microsoft”), Apple Inc. (“Apple”), and Motorola Mobility LLC (“Motorola”) (“Petitioners”) challenge the patentability of claims 10–20 (“the challenged claims”) of U.S. Patent No. 6,836,654 B2 (Ex. 1001, “the ’654 patent”), owned by Uniloc 2017 LLC (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed herein, we determine that Petitioners have shown by a preponderance of the evidence that claims 10–20 are unpatentable.

II. BACKGROUND

A. Procedural History

Microsoft filed a Petition requesting *inter partes* review of the challenged claims of the ’654 patent. Paper 2 (“Pet.”). The Petition is supported by the Declaration of Henry Houh (Ex. 1010). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We instituted *inter partes* review of all of the challenged claims of the ’654 patent on all of the grounds raised in the Petition with Microsoft as the sole petitioner. Paper 7 (“Dec. on Inst.”), 8, 24. Thereafter, we instituted *inter partes* review in IPR2020-00701 (whose petition challenged the same claims of the ’654 patent on the same grounds as Microsoft’s Petition), and

granted Apple’s and Motorola’s Motion¹ for Joinder, joining them as petitioners in this proceeding. Paper 11, 10. Patent Owner filed a Response to the Petition. Paper 9 (“PO Resp.”). Petitioners filed a Reply to Patent Owner’s Response. Paper 10 (“Pet. Reply”). The Reply is supported by the Second Declaration of Henry Houh (Ex. 1020). Patent Owner filed a Sur-Reply to Petitioners’ Reply. Paper 12 (“PO Sur-Reply”).

An oral hearing was held on November 10, 2020. A transcript of the oral hearing is included in the record. Paper 19 (“Tr.”).

B. Related Matters

Petitioners identify 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)

¹ Samsung Electronics America, Inc. (“Samsung”) also was a petitioner seeking joinder at the time the petition in IPR2020-00701 was filed. IPR2020-00701, Paper 1. The -701 proceeding was terminated as to Samsung, however, before we instituted *inter partes* review in the -701 proceeding and joined it with this proceeding.

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

C. 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.

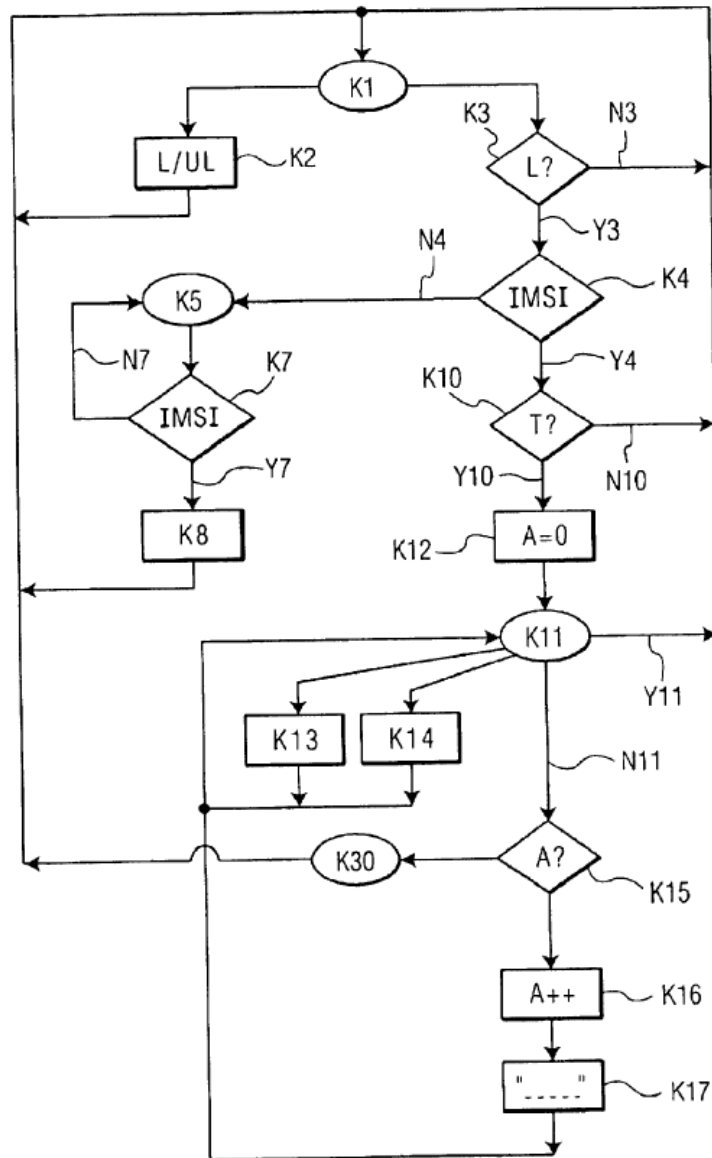


FIG. 3

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,

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