

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00056
Patent 6,467,088 B1

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

MICROSOFT CORP.
EXHIBIT 1012

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–21 of U.S. Patent No. 6,467,088 B1 (Ex. 1001, “’088 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC, (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . 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.” For the reasons given below, we determine Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing that claims 1–21 of the ’088 patent are unpatentable.

I. BACKGROUND

A. THE ’088 PATENT

1. *Disclosure*

The ’088 patent is directed to techniques for upgrading or reconfiguring software and/or hardware components in electronic devices. Ex. 1001, 1:6–9. The ’088 patent explains that prior art systems developed for updating components of electronic devices rely on a central computer system that tracks all software configurations for a number of remote systems. *Id.* at 1:31–36. These prior art systems updated software by the central computer transmitting patches to each of the remote systems. *Id.* at 1:39–42; *see also* 2:4–10 (explaining that a distributed system transmits patches to mobile units). Other known techniques for software update involve assuming that each desktop computer has a set of resources determined in accordance with a set of enterprise policies or a central server maintaining a master list that is used to keep files on a remote device

updated to the latest version. *Id.* at 1:49–52, 1:60–65. According to the '088 patent, all of the above techniques fail to avoid potential conflicts and ensure compatibility because they do not account for interdependencies of the resources required by the desktops or the files resident in the remote devices. *Id.* at 1:41–45, 1:52–56, 1:65–2:3, 2:10–14.

The '088 patent solves the problem by providing a list or listing, that indicates “which of a set of software components supported by the manager 10 are known to work well together or are otherwise compatible.” *Id.* at 3:36–42. For instance, Figure 1 of the '088 patent, reproduced below, illustrates reconfiguration manager 10 that includes a listing 16 of known configurations, and a repository 18 of software components. *Id.* at 3:27–29.

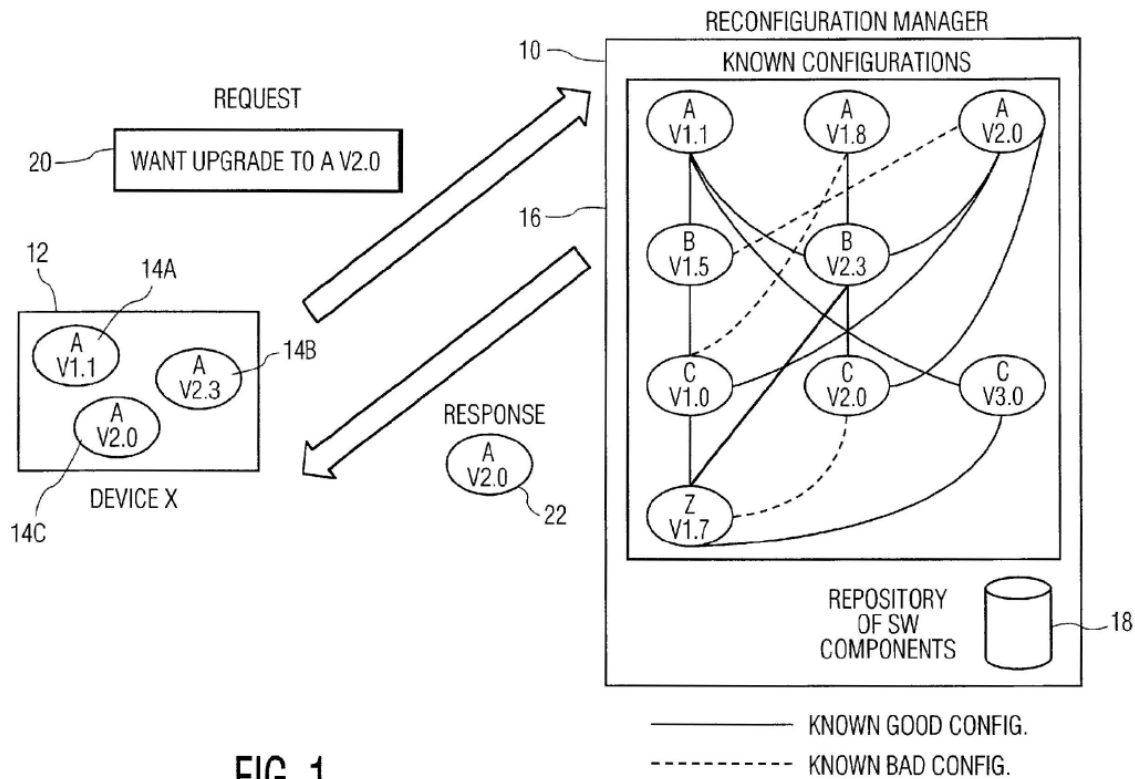


FIG. 1

Figure 1, above, illustrates a reconfiguration manager 10 interacting with an electronic device 12, also referred to as “Device X.” *Id.* at 3:14–16. When reconfiguration manager 10 receives a request for an upgrade from Device X, the request indicates that the device wants to upgrade to version 2.0 of software component A, and includes a list of the components currently on the device, i.e., version 1.1 of component A, version 2.0 of component C, and version 2.3 of component B. *Id.* at 4:12–19. Reconfiguration manager 10 processes the request, and if appropriate, delivers the requested version 2.0 of software component A. *Id.* at 4:22–26. Processing the request involves generating a potential upgrade configuration that will satisfy the received request, and searching through a set of known “bad” configurations. *Id.* at 4:62–66. A known “bad” configuration is indicated in Figure 1 as a dashed line between components that are not compatible. *Id.* at 4:58–61. For example, the pair including version 1.8 of component A and version 1.0 of component C is an example of a known bad configuration. *Id.* at 3:61–63.

If the upgrade configuration corresponds to a bad configuration, the reconfiguration manager attempts to find a set or sets of potential upgrade configurations from a set of known “good” configurations. *Id.* at 4:67–5:3. A known “good” configuration is indicated in Figure 1 by a solid line between a given pair of components indicating that the components work well together or are otherwise compatible. *Id.* at 3:52–55.

2. Prosecution History

During prosecution of the '088 patent, the Examiner issued a Rejection of claims 1–21 under 35 U.S.C. § 103 over U.S. Patent No. 6,301,707 B1 (“Carroll”). Ex. 1007. The Examiner found that Carroll

teaches all the limitations of claim 1, and, in particular, with respect to the comparing step, the Examiner found that Carroll performs a comparison using the profile of the target system to install components identified in that profile. *Id.* at 3.¹ The Applicant filed a Response. Ex. 1008. It argued that the installation process in Carroll installs in the target system only components that are defined in the profile of the target system, and that the invention, in contrast, ensures that upgrades are compatible with the configuration of a given device before they are implemented in that device. *Id.* at 2–3. Thus, Applicant argued, although Carroll teaches the use of a profile comparison to install software, Carroll did not teach the limitation of “comparing the determined component and information specifying at least one additional component currently implemented in the electronic device with at least one of a list of known acceptable configurations for the electronic device and a list of known unacceptable configurations for the electronic device.” *Id.* at 3–4.

The Examiner, in response to Applicant’s arguments, issued a Notice of Allowability of all pending claims stating:

The applicant argues that Carroll[I] fails to teach “receiving information representative of a configuration request.” However, see Carroll[I’s] fig. 3, item 320 (placing order). The placing of an order is inherently “information representative of a request.” It is further specified that Carroll[I] does not teach or suggest comparing the determined (requested) component and at least one additional component to at least one of an acceptable or an unacceptable list. Carroll[I], as indicated in the previous action compares the requested component with an acceptable list (one of an acceptable and an unacceptable

¹ Page numbers to this Exhibit refer to the page number in the original Office Action.

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