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Paper 8
Entered: March 27, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00115
Patent 8,407,609 B2

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge.*

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

I. INTRODUCTION

On October 31, 2019, Google LLC ("Petitioner") filed a Petition seeking institution of *inter partes* review of claims 1–3 of U.S. Patent No. 8,407,609 B2 (Ex. 1001, "the '609 patent"). Paper 1 ("Pet."). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response on February 10, 2020. Paper 6 ("Prelim. Resp.").

We may institute an *inter partes* review if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. *See* 35 U.S.C. § 314. However, the Board has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; *see, e.g.*, *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."). The Trial Practice Guide identifies considerations that may warrant exercise of this discretion. Consolidated Trial Practice Guide (Nov. 2019) ("Consolidated TPG"), 55–63, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

Having considered the parties' submissions, we determine that it is appropriate in this case to exercise our discretion to deny institution of *inter partes* review pursuant to 35 U.S.C. § 314(a).

II. BACKGROUND

A. Related District Court Proceedings

The '609 patent is asserted against Petitioner in *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00502 (E.D. Tex.) ("the Texas Litigation"). Pet. 63; Prelim. Resp. 9. Patent Owner filed the Texas Litigation on November 17,

2018. Prelim. Resp. 9. The district court held a *Markman* hearing on January 10, 2020, and issued an order shortly thereafter. Ex. 2001 (District Court's Claim Construction Memorandum and Order), 1, 78. That order construes six of the disputed claim terms and phrases from the '609 patent. *Id.* at 57–78. According to the district court's Amended Docket Control Order: fact discovery must be completed and expert reports are due on March 30, 2020; expert discovery closes and dispositive and *Daubert* motions are due by May 11, 2020; a joint pretrial order, proposed jury instructions, and a proposed verdict form are due by July 6, 2020; a pretrial conference will be held on July 9, 2020. Ex. 2002, 1–3. The order also specifies that jury selection in the Texas Litigation will begin on August 17, 2020—less than five months from today. *Id.* at 1.

The parties also identify other district court proceedings involving the '609 patent that are currently pending. Pet. 63–64; Prelim. Resp. 9. Each of these proceedings was filed on or after November 17, 2018 (i.e., the filing date of the Texas Litigation). Prelim. Resp. 9; *see* Pet. 63–64.

B. Related PTAB Proceedings

The '609 patent is the subject of petitions for *inter partes* review in IPR2019-01367 (filed by Sling TV, L.L.C. on July 22, 2019; the "1367 IPR") and IPR2020-00041 (filed by Netflix, Inc. and Roku, Inc. on October 31, 2019; the "041 IPR"). Pet. 63; Prelim. Resp. 9. Both of those petitions challenge all claims of the '609 patent (i.e., claims 1–3), and the Board instituted an *inter partes* review in both proceedings. *Sling TV, L.L.C. v. Uniloc 2017 LLC*, IPR2019-01367, Paper 7 (PTAB Feb. 4, 2020) (Institution Decision); *Netflix, Inc. v. Uniloc 2017*, IPR2020-00041, Paper 10 (PTAB Mar. 25, 2020) (Institution Decision).

In addition, the '609 patent is the subject of IPR2020-00677 (filed by Vudu, Inc. on March 3, 2020), and in that proceeding, the petitioner requests joinder with IPR2019-01367. A decision whether to institute has not been entered in IPR2020-00677.

C. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 24):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	102(b)[1]	Hayward[2]
1	103(a)	Hayward, Middleton[3]
2, 3	103(a)	Hayward, Middleton, Ryan[4]

III. ANALYSIS

Patent Owner argues, *inter alia*, that we should exercise our discretion under 35 U.S.C. §314(a) to deny institution. Prelim. Resp. 10–13. For the reasons explained below,[5] we agree.

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[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of §§ 102, 103.

[2] US 2004/0045040 A1, published Mar. 4, 2004 (Ex. 1005).

[3] US 2002/0111865 A1, published Aug. 15, 2002 (Ex. 1006).

[4] US 6,421,675 B1, issued July 16, 2002 (Ex. 1007).

[5] We decline to address the other arguments advanced by Patent Owner for discretionary denial. *See generally* Prelim. Resp. 13–23.

Patent Owner contends that a trial would be "an inefficient use of Board resources." Prelim. Resp. 10–13 (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) ("*NHK*")). In particular, Patent Owner submits that "[j]ury selection is set to begin in the [Texas Litigation] on August 17, 2020, which is approximately three months after the anticipated timing of an institution decision from the Board in this case, and therefore, approximately nine months prior to any expected Final Written Decision in this IPR if trial were instituted." *Id.* at 10 (emphasis omitted) (citing Ex. 2002). Patent Owner argues that Petitioner's invalidity contentions in the Texas Litigation include "the same grounds" of unpatentability as are presented in the Petition for independent claim 1. *Id.* at 12 (citing Ex. 2003, 14–15, 18 (Invalidity Contentions)). In addition, Patent Owner contends that the district court has already construed the claims of the '609 patent and that expert discovery in the Texas Litigation "will close on May 11, 2020, which is one day after the last date to issue a decision on institution in this proceeding." *Id.* at 12–13 (citing Ex. 2001; Ex. 2002, 3). According to Patent Owner, the Board's precedential decision in *NHK* is "on point," and, consequently, the Board should exercise discretion to deny the Petition. *Id.* at 10, 13.

In the Petition, Petitioner identifies the Texas Litigation, but does not discuss its stage or the arguments advanced in that copending district court case; rather, the Petition simply notes that the Texas Litigation is "unrelated" to the litigations against the parties who filed the 1367 and 041 IPRs. Pet. 61, 63; *see generally* Pet. i, 60–65; *cf.* Consolidated TPG at 58 (noting that proceedings related to the same patent at a district court may favor denial of a petition and inviting parties to "address in their submissions whether any

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