

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00756
Patent 9,564,952 B2

Before SALLY C. MEDLEY, MICHAEL R. ZECHER, and
NABEEL U. KHAN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC (“Google”), filed a Petition requesting an *inter partes* review of claims 9–12 of U.S. Patent No. 9,564,952 B2 (Ex. 1001, “the ’952 patent”). Paper 1 (“Pet.”). Patent Owner, Uniloc 2017 LLC (“Uniloc”), filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). With our authorization, Google filed a Reply (Paper 10), and Uniloc filed a Sur-reply (Paper 12), each of which were tailored narrowly to address the non-exclusive list of six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (order authorizing supplemental briefing) (precedential) (“*Fintiv*”) that we consider in determining whether to exercise our discretion to institute an *inter partes* review when there is a related district court case involving the same patent.

Based on the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may not institute an *inter partes* review unless the information presented in the Petition and any response thereto shows “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) (2018). Taking into account Uniloc’s Preliminary Response, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Google would prevail in challenging at least one of claims 9–12 of the ’952 patent as unpatentable under 35 U.S.C. § 103(a). Pursuant to § 314, we hereby institute an *inter partes* review as to these claims of the ’952 patent.

A. Related Matters

The parties indicate that the ’952 patent is involved in a district court case captioned *Uniloc 2017 LLC v. Google LLC*, No. 2:18-cv-552 (E.D. Tex.

IPR2020-00756
Patent 9,564,952 B2

filed Dec. 31, 2018). Pet. 68–69; Paper 6, 2. On June 19, 2020, the U.S. District Court for the Eastern District of Texas granted Google’s Motion to Transfer Venue to the U.S. District Court for the Northern District of California. Ex. 1021.

B. The ’952 Patent

The ’952 patent generally relates to near field authentication of users and their computing devices, specifically by means of encoded sound waves. Ex. 1001, 1:12–16. Figure 1 of the ’952 patent is reproduced below.

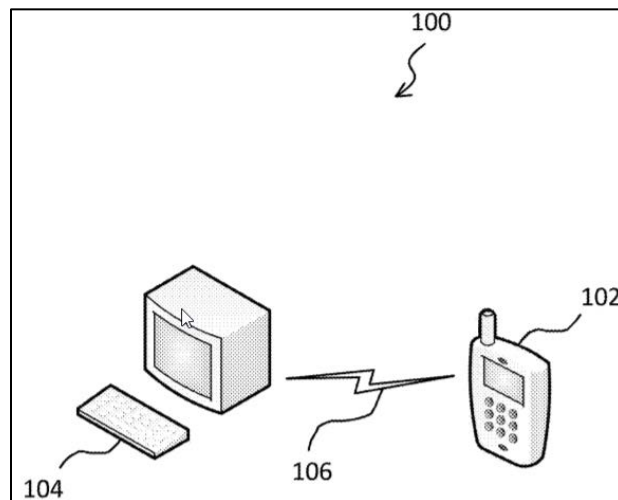


Figure 1, reproduced above, is a block diagram showing an audio transceiving computing device transmitting data to an audio receiving computing device. *Id.* at 3:23–25. In Figure 1, system 100 includes audio transceiving computing device 102 and audio receiving computing device 104. *Id.* at 3:64–67. Audio transceiving computing device 102 can transmit data to audio receiving computing device 104 in the form of modulated carrier wave 106, which can be a sound wave. *Id.* at 3:64–4:4. The ’952 patent explains that “[s]ound waves can transmit information accurately over a very short distance (near field communications) using inexpensive equipment.” *Id.* at 4:4–6.

The '952 patent describes an illustrative example of a user seeking to purchase a product at a register using a mobile phone. Ex. 1001, 11:9–11. In this example, the mobile phone through its microphone first scans a plurality of predetermined frequencies for a free frequency. *Id.* at 11:15–17. Next, the mobile phone selects a free frequency that meets a pre-established criteria. *Id.* at 11:18–24. Then, the mobile phone generates a periodic enclosed content message representing device identification data and the user's credit card information. *Id.* at 11:26–30. The mobile phone also generates a carrier wave and modulates the carrier wave using the periodic enclosed content message. *Id.* at 11:33–35. The mobile phone transmits the modulated carrier wave at the free frequency through its output speaker. *Id.* at 11:39–41. In this example, the mobile phone does not have its physical components modified with expensive equipment, but can use the speaker already included in the phone. *Id.* at 11:44–47.

The periodic enclosed content message includes a plurality of enclosed content messages. Ex. 1001, 5:55–57, Fig. 3 (item 302a–n). Each of the enclosed messages includes a begin indication, a content, and an end indication. *Id.* at 5:58–60, Fig. 3 (items 304, 306, 308).

Furthermore, the device identification data includes a device fingerprint. Ex. 1001, 6:11–19. A device fingerprint is derived from user-configurable and non-user-configurable data specific to the audio transceiver computing device. *Id.* at 6:34–37. Non-user-configurable data includes data such as serial numbers. *Id.* at 6:37–39. User-configurable data includes data such as registry entries, application usage data, file list information, and Media Access Control addresses. *Id.* at 6:41–43.

C. Challenged Claims

Of the challenged claims, claim 9 is the only independent claim. Independent claim 9 is directed to “[a] method for near field authentication of a source.” Ex. 1001, 14:53. Claims 10–12 directly depend from independent claim 9. *Id.* at 15:6–14. Independent claim 9 is illustrative of the challenged claims and is reproduced below.

9. A method for near field authentication of a source, the source using an audio transceiver computing device, the method comprising:

scanning a plurality of predetermined frequencies for a free frequency;

selecting the free frequency from the plurality of predetermined frequencies;

generating a periodic enclosed content message;

generating a modulated carrier wave representing the periodic enclosed content message; and

transmitting the modulated carrier wave at the free frequency;

wherein each period of the periodic enclosed content message includes a begin indication, a content, and an end indication;

wherein the content includes device identification data including a bit array derived from user-configurable and non-user-configurable data specific to the audio transceiver computing device; and

wherein the modulated carrier wave comprises a sound wave.

Id. at 14:53–15:5.

D. Prior Art and Asserted Grounds

Google relies on the following prior art references set forth in the table below. Pet. 7–8.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.