

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01665
Patent 8,566,960 B2

Before DAVID C. McKONE, BARBARA A. PARVIS, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Google LLC¹ (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–25 of U.S. Patent No. 8,566,960 B2 (Ex. 1001, “the ’960 patent”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

Petitioner’s challenges to the ’960 patent are nearly identical to those raised in a prior proceeding before the Board also involving the ’960 patent, IPR2017-00948 (“the ’948 proceeding”). The primary differences between the challenges raised in this proceeding and the ’948 proceeding amount to Petitioner presenting arguments in response to arguments raised by Patent Owner in its Preliminary Response in the ’948 proceeding. Petitioner also attempts to overturn our claim construction in yet another proceeding involving the ’960 patent, IPR2016–01271 (“the ’1271 proceeding”), but does not apply the prior art differently under its proposed construction. Upon consideration of the Petition and Preliminary Response in this proceeding, we decline, under 35 U.S.C. § 325(d), to institute a review of the challenged claims.

B. Related Matters

The parties indicate that the ’960 patent has been asserted in several lawsuits in the United States District Court for the Eastern District of Texas.

¹ Google Inc. originally was named as Petitioner. Petitioner subsequently filed updated Mandatory Notices informing the Board that Google Inc. converted from a corporation to a limited liability company and changed its name to Google LLC. Paper 6.

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Pet. 2–3; Paper 5, 2. The '960 patent also was the subject of *Unified Patents Inc. v. Uniloc USA, Inc.*, Case IPR2016-01271 (PTAB) (“the '1271 proceeding”). Pet. 3. In the '1271 proceeding, we denied institution of *inter partes* review. IPR2016-01271, Paper 6 (“'1271 Dec.”). The '960 patent also is the subject of *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-00948 (PTAB) (“the '948 proceeding”). In the '948 proceeding, we instituted an *inter partes* review on grounds substantially similar to those raised in the instant Petition, as we explain in detail below. IPR2016-00948, Paper 10 (“'948 Dec.”).

C. Evidence Relied Upon

Petitioner relies on the following prior art:

Ex. 1004 (“DeMello”)	US 7,047,411 B1	May 16, 2006
Ex. 1005 (“Staruiala,”)	IE 02/0429	Nov. 27, 2002
Ex. 1006 (“Colosso”)	US 7,962,424 B1	June 14, 2011

Petitioner also relies on the Declaration of Anthony J. Wechselberger (Ex. 1003, “Wechselberger Decl.”).

Patent Owner relies on the Declaration of Val DiEuliis, Ph.D. (Ex. 2001, “DiEuliis Decl.”).

D. The Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 5):

References	Basis	Claims Challenged
DeMello and Staruiala	§ 103(a)	1–25
DeMello, Staruiala, and Colosso	§ 103(a)	1–25

E. The '960 Patent

The '960 patent describes techniques for monitoring and adjusting software usage under software licenses. Ex. 1001, 1:16–20. The '960 patent discusses problems with existing software licensing schemes, including that “consumers of software have normal patterns of use that include the installation and use of digital products on multiple devices” and that “computers are also bought, sold and replaced so over time maybe two or three times this number of computers may be used by the user over time with a legitimate need to install and use the software on every computer.” *Id.* at 1:31–41. The '960 patent addresses these problems with “an improved technique for allowing for a changing number of device installations on a per license basis over time.” *Id.* at 1:67–2:2.

Figure 2, reproduced below, illustrates an example:

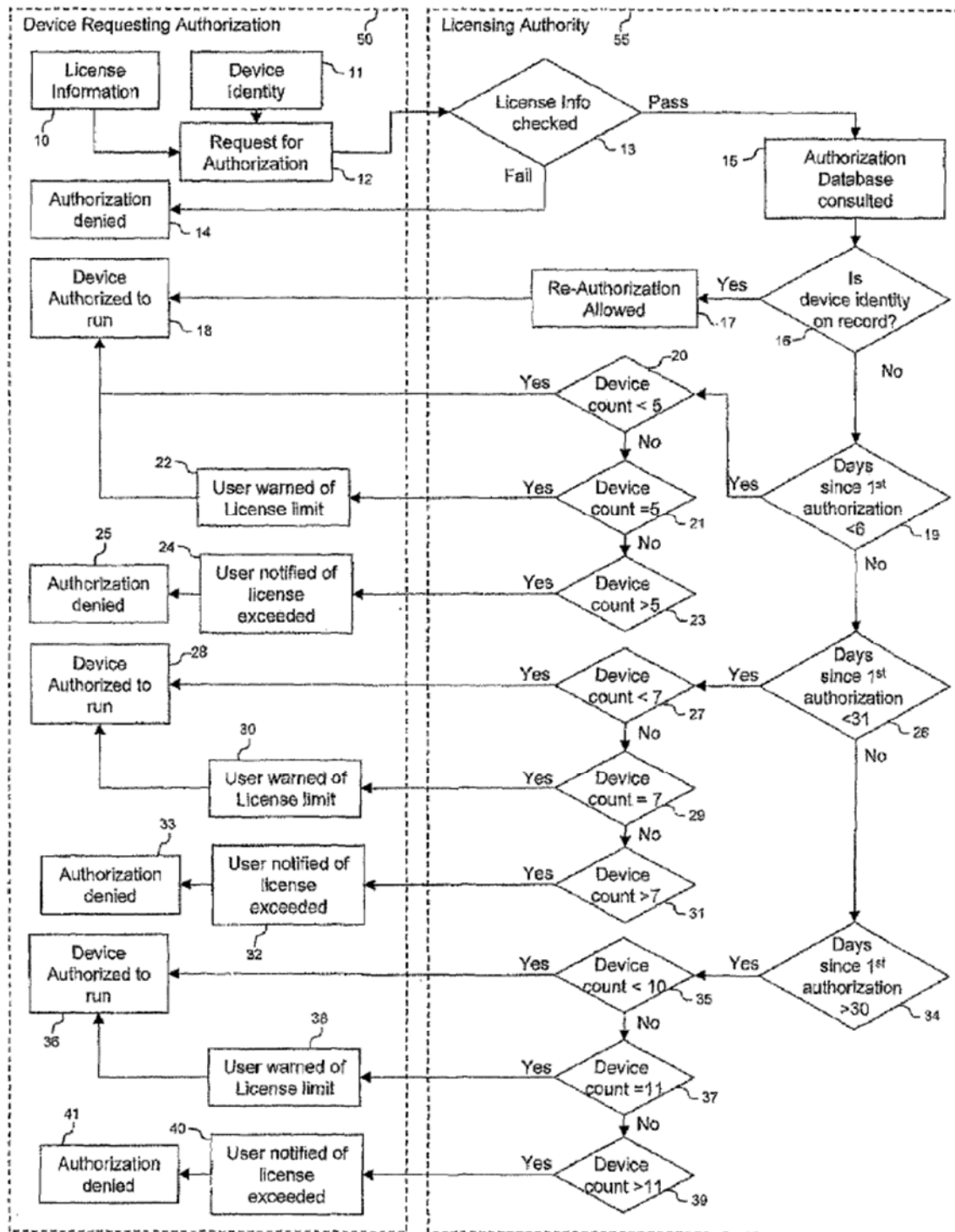


Figure 2

Figure 2 is a flowchart for an approach to adjusting a license for a digital product. *Id.* at 3:20–21. In Figure 2, device 50 requests authorization from

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