

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2018-00057
Patent 6,110,228

Before MIRIAM L. QUINN, ROBERT J. WEINSCHENK, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Unified Patents, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 6, 7, 10, 18, 25, 26, 29, 67, 68, 70 and 71 (“the challenged claims”) of U.S. Patent No. 6,110,228 (Ex. 1001, “the ’228 patent”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. 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.” 35 U.S.C. § 314(a).

For the reasons set forth below, Petitioner does not demonstrate a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims of the ’228 patent. Accordingly, the Petition is denied, and no trial is instituted.

A. *Related Proceedings*

The parties indicate that the ’228 patent is the subject of several district court cases. Pet. 1–2; Paper 3, 2.

B. *The ’228 Patent*

The ’228 patent relates to “software support in distributed systems.” Ex. 1001, 1:6–8. Specifically, the ’228 patent describes a computer network system that includes a software maintenance facility at a central site. *Id.* at 2:47–52. According to the ’228 patent, a customer at a remote location initiates servicing of a software program product by composing a service request through a front end. *Id.* at 2:52–57. The front end permits the customer to specify a range of operations, including service research, requesting service, applying service, providing fixes, and installing serviced

products or fixes at the remote location. *Id.* at 2:58–61. A service machine at the central site then performs the requested service, and the results are provided back to the customer at the remote location. *Id.* at 2:61–63.

C. *Illustrative Claim*

Claims 1, 18, and 67 are independent. Claim 1 is reproduced below.

1. A method of applying service to a computer program that is to be executed at a remote location connected to a central computer site of a computer network, the method comprising the steps of:

interactively receiving a request for a computer program service from a customer at a remote location interface with optional service incorporation instructions of the remote location customer;

providing the received request for service over the computer network to a service facility at the central computer site;

determining the components of the requested service at the central computer site; and

providing the results of the requested service over the computer network back to the customer at the remote location interface.

Ex. 1001, 25:39–55.

D. *Evidence of Record*

Petitioner submits the following references and declaration (Pet. 3–5):

Reference or Declaration	Exhibit No.
Declaration of Dr. Ethan L. Miller (“Miller Declaration”)	Ex. 1003
Crawford, U.S. Patent No. 7,080,051 B1 (filed Mar. 12, 2002, issued July 18, 2006) (“Crawford”)	Ex. 1004
Reisman, U.S. Patent No. 5,694,546 (filed May 31, 1994, issued Dec. 2, 1997) (“Reisman”)	Ex. 1005
Frye, U.S. Patent No. 6,038,586 (filed May 2, 1997, issued Mar. 14, 2000) (“Frye”)	Ex. 1006

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 5):

Claim(s)	Basis	Reference(s)
1, 6, 7, 10, 18, 25, 26, 29, 67, 68, 70 and 71	35 U.S.C. § 103(a)	Crawford and Reisman
1	35 U.S.C. § 103(a)	Frye

II. ANALYSIS

A. *Claim Construction*

The parties agree that the '228 patent has expired. Pet. 8; Prelim. Resp. 9. As a result, we construe the claims of the '228 patent pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b); *see also In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (holding, on appeal from a reexamination decision by the Board of Patent Appeals and Interferences, that “the Board’s review of the claims of an expired patent is similar to that of a district court’s review”). Under *Phillips*, we generally give claim terms their “ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips*, 415 F.3d at 1312–13. We consider the intrinsic evidence, namely, the claim language, the specification, and the prosecution history, if in evidence. *Id.* at 1314–17. We also can consider extrinsic evidence, but it is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Id.* at 1317.

1. *“optional service incorporation instructions”*

Each of the challenged independent claims recites “optional service incorporation instructions.” Ex. 1001, 25:45, 27:26–27, 32:23. Petitioner acknowledges (Pet. 7–8) that during prosecution of the application that

issued as the '228 patent, the Board of Patent Appeals and Interferences (“BPAI”) construed the term “optional service incorporation instructions” to mean that “the customer specifies a range of optional instructions including ‘service research, requesting service, applying service, providing fixes, and installing serviced products or fixes at the remote location’” (Ex. 1002, 256–257). The BPAI explained that its construction was supported by the specification and prosecution history. *Id.* For example, the specification states that “the front end permits the customer to specify a range of operations, including service research, requesting service, applying service, providing fixes, and installing serviced product or fixes at the remote location.” Ex. 1001, 2:58–61. Likewise, during prosecution, the applicant stated that “[t]he invention provides a computer network system in which a customer at a remote location can request software service . . . through a local software interface ‘front-end’ that permits the remote location customer to specify a range of optional service incorporation instructions, including service research, requesting service, applying service, providing fixes, and installing serviced products or fixes at the remote location.” Ex. 1002, 173.

Petitioner does not identify any specific error in the BPAI’s previous construction of the term “optional service incorporation instructions.” *See* Pet. 11–13. Nor does Petitioner contend that the BPAI’s previous construction under the broadest reasonable interpretation standard is incorrect under the *Phillips* standard. *See id.* Nonetheless, Petitioner proposes a different construction in this proceeding. *Id.* at 13. Specifically, Petitioner proposes construing the term “optional service incorporation instructions” to mean “instructions arising from selection of an option by a

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.