

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA, INC.  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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Case IPR2018-01653  
Patent 7,881,902 B1

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Before SALLY C. MEDLEY, JOHN F. HORVATH, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION

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

Granting of Motion for Joinder  
*37 C.F.R. § 42.122(b)*

## I. INTRODUCTION

### A. Background

Samsung Electronics America, Inc., (“Petitioner” or “Samsung”)<sup>1</sup> filed a Petition requesting *inter partes* review of claims 1–6, 9, and 10 (“the challenged claims”) of U.S. Patent No. 7,881,902 B1 (Ex. 1001, “the ’902 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to the following instituted proceeding: *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424 (PTAB) (“the Apple IPR”). Paper 3 (“Mot.”). Uniloc 2017 LLC (“Patent Owner”)<sup>2</sup> filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition, but did not file an opposition to the Motion for Joinder. We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we institute *inter partes* review of all challenged claims, and grant Petitioner’s Motion for Joinder.

### B. Related Matters

The following are matters that could affect, or be affected by, a decision in this proceeding because they involve the ’902 patent or patents that are related to the ’902 patent:

- *Uniloc USA, Inc. v. Huawei Devices USA, Inc.*, 2-17-cv-00737 (EDTX);
- *Uniloc USA, Inc. v. HTC Am., Inc.*, 2-17-cv-01629 (W.D. Wa);
- *Uniloc USA, Inc. v. Samsung Elec. Am., Inc.*, 2-17-cv-00650 (EDTX);
- *Uniloc USA, Inc. v. LG Elec. USA, Inc.*, 4-18-cv-02918 (NDCA);

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<sup>1</sup> Petitioner identifies Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd. as the real parties-in-interest. Pet. 1.

<sup>2</sup> Patent Owner identifies Uniloc 2017 LLC, Uniloc USA, Inc., and Uniloc Licensing USA LLC as the real parties-in-interest. Paper 5 (1).

- *Uniloc USA, Inc. v. Apple Inc.*, 4-18-cv-00364 (NDCA);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00387 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00389 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-00424 (PTAB);
- *Apple Inc. v. Uniloc Luxembourg S.A.*, Case IPR2018-01028 (PTAB);
- *LG Elec., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01458 (PTAB);
- *HTC Corp. v. Uniloc 2017 LLC*, Case IPR2018-01589 (PTAB);
- *HTC Corp. v. Uniloc 2017 LLC*, Case IPR2018-01631 (PTAB);
- *Samsung Elec. Am., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01756 (PTAB); and
- *Samsung Elec. Am., Inc. v. Uniloc 2017 LLC*, Case IPR2018-01757 (PTAB).

*C. Evidence Relied Upon*<sup>3</sup>

Reference		Effective Date <sup>4</sup>	Exhibit
Pasolini	US 7,463,997	Oct. 2, 2006	1005
Fabio	US 7,698,097 B2	Oct. 2, 2006	1006
Mitchnick	US 2006/0084848 A1	Oct. 14, 2004	1007
Tanenhaus	US 6,469,639 B2	Oct. 22, 2002	1008
Sheldon	US 5,957,957	Sept. 28, 1999	1009

<sup>3</sup> Petitioner also relies upon the Declaration of Joseph A. Paradiso, Ph.D. (Ex. 1003). Patent Owner relies upon the Declaration of William C. Easttom II (Ex. 2001).

<sup>4</sup> Petitioner relies on the filing dates of Pasolini, Fabio, and Mitchnick as the effective date for determining their availability as prior art.

*D. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability:

Reference(s)	Basis	Claim(s) Challenged
Mitchnick	§ 103(a)	1 and 2
Mitchnick and Sheldon	§ 103(a)	3
Mitchnick, Sheldon, and Tanenhaus	§ 103(a)	4
Fabio and Pasolini	§ 103(a)	5, 6, 9, and 10

II. ANALYSIS

*A. Institution of Inter Partes Review*

In its Motion for Joinder, Petitioner represents that this Petition “introduces identical arguments and the same grounds raised in the existing Apple [IPR] proceeding (i.e., it challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combination of prior art submitted in the Apple [IPR] Petition).” Mot. 4–5. Our independent review of the Petition and the Apple IPR petition, including the expert declarations filed in both, confirm Petitioner’s representations.

The Apple IPR petition was filed on January 5, 2018, challenging claims 1–6, 9, and 10 of the ’902 patent on the same grounds raised in this Petition. *See* Apple IPR, Paper 2. Patent Owner filed a preliminary response to the Apple IPR petition on May 7, 2018. *Id.*, Paper 6 (“Apple IPR Prelim. Resp.”). We instituted *inter partes* review based on the Apple IPR petition on August 2, 2018. *Id.*, Paper 7 (“Apple IPR Institution Decision”). Patent Owner filed a Response to the Apple IPR petition on October 25, 2018. *Id.*, Paper 11 (“Apple IPR Resp.”).

Patent Owner filed its Preliminary Response to this Petition on December 12, 2018. *See* Prelim. Resp. Based on our independent review, Patent Owner’s Preliminary Response to this Petition is nearly identical to Patent Owner’s Response to the Apple IPR petition. *Compare* Prelim. Resp. 1–32, *with* Apple IPR Resp. 1–32. Moreover, Patent Owner’s Preliminary Response to this Petition raises the same or substantially the same arguments Patent Owner raised in its Preliminary Response to the Apple IPR petition. *Compare* Prelim. Resp. 1–32, *with* Apple IPR Prelim. Resp. 1–18.

The only argument raised by Patent Owner in its Preliminary Response to this Petition that substantially differs from the arguments Patent Owner raised in its Preliminary Response to the Apple IPR petition is the argument that “the Board’s appointments of administrative patent judges violate the Appointments Clause of Article II” of the U.S. Constitution. Prelim. Resp. 32. We decline to address the merits of this constitutional challenge because “administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments.” *Riggin v. Office of Senate Fair Employment Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995). This is especially true when, as here, “the constitutional claim asks the agency to act contrary to its statutory charter.” *Id.*

Accordingly, upon our review of the Petition and Preliminary Response and for the reasons discussed above, we are persuaded Petitioner has demonstrated a reasonable likelihood of success in showing the unpatentability of the challenged claims of the ’902 patent on the same grounds raised and instituted in the Apple IPR. We, therefore, institute *inter partes* review based on the Petition.

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