

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-00251¹
Patent 6,993,049 B2

Before SALLY C. MEDLEY, JEFFREY S. SMITH, and GARTH D. BAER,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

JUDGEMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

DECISION
Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

¹ LG Electronics, Inc., who filed a petition in IPR2019-01530, has been joined as a petitioner in this proceeding.

I. INTRODUCTION

Apple, Inc., (“Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting an *inter partes* review of claims 11 and 12 of U.S. Patent No. 6,993,049 B2 (Ex. 1001, “the ’049 patent”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 6, “Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted *inter partes* review of all challenged claims on all grounds raised. Paper 7 (“Dec. Inst.”).

On September 3, 2019, Petitioner filed a Motion to Submit Supplemental Information (Paper 9, “Mot.”), and Patent Owner filed an Opposition to Petitioner’s Motion (Paper 10, “Opp.”). Patent Owner filed a Response to the Petition (Paper 11, “PO Resp.”) and Petitioner filed a Reply (Paper 12, “Pet. Reply”). Patent Owner filed a Sur-Reply (Paper 13, “PO Sur-Reply”). An oral hearing was held on April 23, 2020, and the hearing transcript is included in the record. *See* Paper 21 (“Tr.”).

In our Scheduling Order, we notified the parties that “any arguments not raised in the [Patent Owner] response may be deemed waived.” *See* Paper 8, 7; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief.”). Patent Owner argues that it “does not concede, and specifically denies, that there is any legitimacy to any arguments in the instant Petition that are not specifically addressed” in its Patent Owner Response. PO Resp. 28 n.3. We decline to speculate as to what Patent Owner considers to be not legitimate in the Petition. Any arguments for patentability not raised in the Patent Owner Response are deemed waived.

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We have jurisdiction under 35 U.S.C. § 6(b). This is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we grant Petitioner's motion to submit supplemental information. Further, we find Petitioner has shown by a preponderance of evidence that claims 11 and 12 of the '049 patent are unpatentable.

A. RELATED PROCEEDINGS

The parties identify the following related matters:

Uniloc USA, Inc. et al v. Apple Inc., Case No. 1:18-cv-00164 (W.D. Tex.); *Uniloc USA, Inc. et al v. Samsung Electronics America, Inc. et al*, Case No. 2:18-cv-00040 (E.D. Tex.); *Uniloc USA, Inc. et al v. Logitech Inc. et al.*, Case No. 5:18-cv-01304 (N.D. Cal.); *Uniloc USA, Inc. et al. v. LG Electronics USA, Inc. et al*, Case No. 3:18-cv-00559 (N.D. Tex.); *Uniloc USA, Inc. et al v. Huawei Device USA, Inc.*, Case No. 2:18-cv-00074 (E.D. Tex.); *Uniloc USA, Inc. et al v. ZTE (USA), Inc. et al*, Case No. 2:18-cv-00307 (E.D. Tex.); *Uniloc USA, Inc. et al v. Blackberry Corp.*, Case No. 3:18-cv-01885 (N.D. Tex.); *Uniloc 2017 LLC et al v. Microsoft Corp.*, Case No. 8:18-cv-01279 (C.D. Cal.); *Uniloc USA Inc. et al v. ZTE (USA), Inc. et al*, Case No. 3:18-cv-02839 (N.D. Tex.); *Uniloc USA, Inc. et al v. LG Electronics USA Inc. et al*, Case No. 5:18-cv-06738 (N.D. Cal.); *Uniloc 2017 LLC v. ZTE, Inc. et al.*, Case No. 3:18-cv-03063 (N.D. Tex.); *Uniloc 2017 LLC v. Blackberry Corp.*, Case No. 3:18-cv-03068 (N.D. Tex.); *Uniloc 2017 LLC v. Motorola Mobility, LLC*, Case No. 1:18-cv-01840 (D. Del.); *Uniloc 2017 LLC v. HTC America, Inc.*, Case No. 2:18-cv-01727 (W.D. Wash.). Pet. 56; Paper 3, 2.

B. THE '049 PATENT

The '049 patent is directed to a communication system comprising a primary station and one or more secondary stations. Ex. 1001, code (57).

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The primary station broadcasts a series of inquiry messages, and adds to the inquiry messages an additional data field for polling secondary stations. *Id.* This system is useful for communications between the stations without requiring a permanently active link, such as is common with the Bluetooth communications protocol. *Id.*

C. ILLUSTRATIVE CLAIM

Petitioner challenges claims 11 and 12 of the '049 Patent. Claim 11 is the only independent challenged claim and is reproduced below:

11. A method of operating a communication system comprising a primary station and at least one secondary station, the method comprising the primary station broadcasting a series of inquiry messages, each in the form of a plurality of predetermined data fields arranged according to a first communications protocol, and adding to an inquiry message prior to transmission an additional data field for polling at least one secondary station, and further comprising the at least one polled secondary station determining when an additional data field has been added to the plurality of data fields, determining whether it has been polled from the additional data field and responding to a poll when it has data for transmission to the primary station.

Ex. 1001, 8:35–47.

D. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following grounds of unpatentability. Pet. 1–2.

| Claim(s) Challenged | 35 U.S.C. § ² | Reference(s)/Basis |
|---------------------|--------------------------|----------------------|
| 11, 12 | § 103 | Larsson ³ |

² The Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. *See* Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011). As the application that issued as the '049 patent was filed before the effective date of the relevant amendments, the pre-AIA version of § 103 applies.

³ U.S. Patent No. 6,704,293 B1 (iss. March 9, 2004) (Ex. 1005, “Larsson”).

| Claim(s) Challenged | 35 U.S.C. §² | Reference(s)/Basis |
|----------------------------|--------------------------------|-------------------------------|
| 11, 12 | § 103 | Larsson, BT Core ⁴ |
| 11, 12 | § 103 | IrOBEX ⁵ |

II. PETITIONER'S MOTION TO SUBMIT ADDITIONAL INFORMATION

In its motion to submit additional information, Petitioner seeks to submit Exhibit 1020 as evidence to confirm the public accessibility of the BT Core reference, which serves as part of Petitioner's second ground of unpatentability in this proceeding. Mot. 1. Patent Owner opposes the motion. As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c) (2018). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if (1) a request for authorization to file such motion is made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted. With respect to the first requirement of § 42.123(a), trial was instituted in this proceeding on July 22, 2019. Paper 7. Because Petitioner requested authorization to file a motion to submit supplemental information on August 21, 2019, Mot. 1, Petitioner's request was made within one month of the date the trial was instituted. With respect to the second requirement of § 42.123(a), the supplemental information Petitioner seeks to submit relates to claims for which trial has been instituted because it is directed to the public accessibility of the BT Core reference, which is one

⁴ Bluetooth™ Core Specification Vol. 1, ver. 1.0 B (pub. Dec. 1, 1999) (Ex. 1014, "BT Core").

⁵ Infrared Data Association, "IrDA Object Exchange Protocol IrOBEX," ver. 1.2, 1-85 (1999) (Ex. 1006, "IrOBEX").

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