

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00701
Patent 8,018,877 B2

Before SALLY C. MEDLEY, JEFFREY S. SMITH, and
JOHN F. HORVATH, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 8,018,877 B2 (Ex. 1001, “the ’877 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “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). Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of claims 1–20 of the ’877 patent under 35 U.S.C. § 103(a).

A. Related Matters

Petitioner and Patent Owner identify *Uniloc USA, Inc., et al. v. Apple Inc.*, Case No. 1:18-cv-00166-LY (W.D. Tex.) as related to the issues presented in this proceeding. Pet. 1; Paper 4, 2.

Petitioner additionally filed proceedings challenging related patents belonging to Patent Owner: IPR2019-00700 (U.S. Patent No. 8,406,116) and IPR2019-00702 (U.S. Patent No. 7,969,925). Pet. 1–2.

B. The ’877 Patent

The ’877 patent is directed to methods and a server-based architecture for establishing data exchange between multiple mobile devices. Ex. 1001, Abstract, 1:23–27. According to the Specification, several instant messaging (“IM”) paradigms have been developed to take advantage of the growing IM market. *Id.* at 1:31–65. However, each of those paradigms are

limited by system compatibility (*id.* at 1:38–43), or the failure to allow for real-time communication between more than two mobile devices. *Id.* at 1:65–2:4. Accordingly, the invention addresses these problems by creating (1) a session-based IM architecture and (2) data transfer techniques for establishing data exchange between multiple mobile devices. *Id.* at 2:22–25.

An example of a digital mobile network system is illustrated in Figure 1, reproduced below:

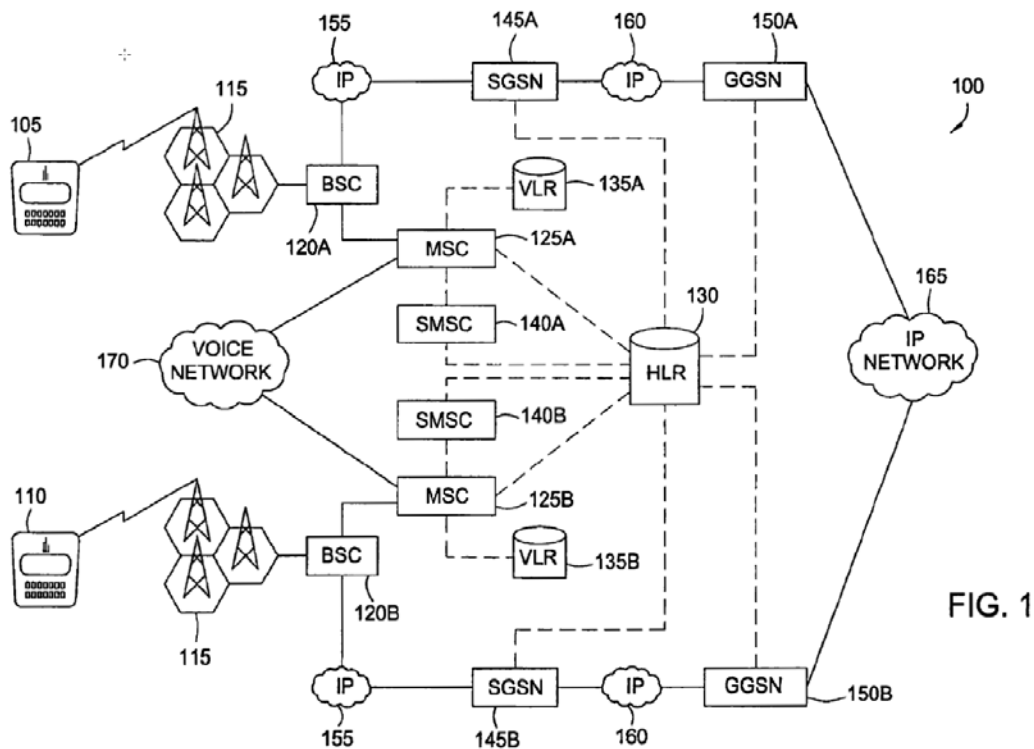


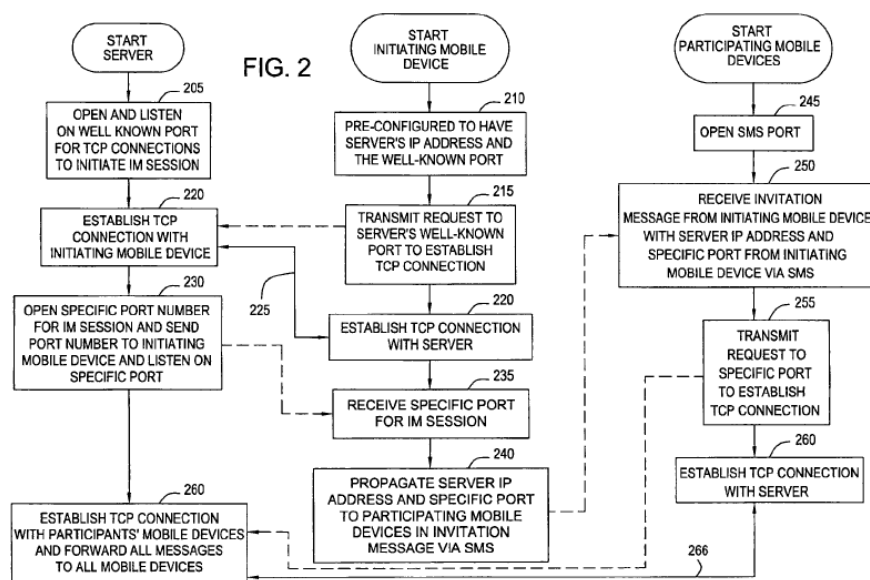
FIG. 1

Figure 1 is a diagram of a Global System for Mobile communications (GSM) mobile networking system 100 including a first mobile device 105 and a second mobile device 110. *Id.* at 2:64–3:5. As disclosed in the Specification, each of the mobile devices 105 and 110 includes a Subscriber Information Module (SIM) card that contains unique identification information that enables the GSM system 100 to locate the mobile devices within the network and route data to them. *Id.* at 3:1–5. The Specification further discloses that the GSM system 100 supports a page-mode messaging

service, such as Short Message Service (SMS), that relies upon the underlying GSM mechanisms to resolve routing information in order to locate destination mobile devices. *Id.* at 3:42–46; *see also id.* at 3:57–4:4 (describing a typical transmission of an SMS text message from the initiating mobile device 105 to the receiving mobile device 110).

Generally, the invention initiates data exchange between multiple mobile devices by first, receiving at a server, a request from the initiating mobile device to allocate a session identifier to use for data exchange. *Id.* at 2:25–40. Once the session identifier has been allocated, the server transmits the session identifier to the initiating mobile device, whereupon the initiating mobile device communicates the session identifier to the participating mobile device. *Id.* Once the initiating mobile device and participating mobile device have the session identifier, the session identifier is used to establish a connection at the server, whereby data exchange is facilitated. *Id.*

Figure 2, reproduced below, illustrates a flow chart depicting one embodiment of a server-based architecture in accordance with the present invention:



In Figure 2, the initiating device transmits a request 215 to establish a connection with a server. *Id.* at 4:55–59. Once the connection between the server and initiating device is established 220, the server transmits a port number to the initiating mobile device, which receives the port number 235, and propagates the server information in an invitation to other mobile devices through a page-mode messaging service such as SMS. *Id.* at 4:60–5:8. The invited mobile devices can use this information to request a server connection in the event they wish to join the IM session. *Id.* at 5:15–20. As illustrated in box 260, the server can establish connections with mobile devices requesting participation in the IM session, and monitors all connections in addition to forwarding all messages between participating mobile devices. *Id.* at 5:20–30.

C. Illustrative Claim

Petitioner challenges claims 1–20 of the '877 patent. Claims 2–7 depend either directly or indirectly from independent claim 1; claims 9–14 depend either directly or indirectly from independent claim 8; and claims 16–20 depend either directly or indirectly from independent claim 15.

Claim 1 is reproduced below:

1. A method of initiating a data exchange session among mobile devices, the method comprising:
 - transmitting a request to a server to allocate a network address and port associated with the server to use in a data exchange session with a participating mobile device;
 - receiving the network address and port from the server;
 - using a page-mode messaging service to assist in communicating the network address and port to the participating mobile device, wherein the page-mode messaging service utilizes a unique identifier to locate the participating mobile device; and

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