

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00744
Patent 7,167,487 B2

Before ROBERT J. WEINSCHENK, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION

Denying Institution of Inter Partes Review
and
Denying Motion for Joinder
35 U.S.C. §§ 314(a) and 315(c)

I. INTRODUCTION

A. Background

On March 4, 2019, Microsoft Corp. (“Petitioner” or “Microsoft”) filed a Petition in IPR2019-00744 (“the Microsoft IPR”) requesting *inter partes* review of claims 1–6 (“the challenged claims”) of U.S. Patent No. 7,167,487 B2 (Ex. 1001, “the ’487 patent”). Paper 2 (“Pet.”), 5. Uniloc 2017 LLC (“Patent Owner” or “Uniloc”), filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Apple, Inc., LG Electronics, Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“collectively, Apple”) previously filed a petition in IPR2019-00222 (“the Apple IPR”) challenging claims 1–6 of the ’487 patent. *See Apple, Inc. v. Uniloc 2017 LLC*, Case IPR2019-00222, slip op. at 4 (PTAB, Nov. 12, 2018) (Paper 5). We instituted *inter partes* review of claims 1–6 based on the petition filed in the Apple IPR. *See Apple IPR*, slip op. at 58–59 (PTAB June 4, 2019) (Paper 11).

Subsequent to filing the Petition, Microsoft filed a Motion for Joinder of the Microsoft IPR to the Apple IPR. Paper 7 (“Mot.”). Uniloc filed an Opposition to the Motion for Joinder (Paper 8, “Opp.”), and Microsoft filed a Reply (Paper 10). We have jurisdiction under 35 U.S.C. § 314.

For the reasons discussed below, we *deny* Microsoft’s Motion for Joinder and *deny* Microsoft’s Petition for institution of *inter partes* review.

B. Related Matters

Petitioner and Patent Owner identify various matters between Uniloc USA, Inc. or Uniloc 2017 LLC, and Apple, Inc., Blackberry Corp., HTC America, Inc., Huawei Device USA, Inc., LG Electronics USA, Inc., Microsoft Corp., Motorola Mobility, LLC, Samsung Electronics America,

Inc., or ZTE (USA), in various Federal District Courts including District Courts for the Eastern, Western, and Northern Districts of Texas, the Central, Southern, and Northern Districts of California, the District of Delaware, and the Western District of Washington, as well as various matters at the Patent Trial and Appeal Board, as matters that can affect or be affected by this proceeding. *See* Pet. viii–ix; Paper 3, 2.

C. Evidence Relied Upon¹

References		Effective Date ²	Exhibit
Peisa	US 6,850,540 B1	Feb. 25, 2000 ³	1005
<i>QoS Concept and Architecture</i> , 3rd Generation Partnership Project, 3GPP TS 23.107 V3.5.0 (2000–12) (“TS 23.107”).		Dec. 22, 2000	1006
<i>Services provided by the physical layer (Release 1999)</i> , 3rd Generation Partnership Project, 3GPP TS 25.302 V3.6.0 (2000–09) (“TS 25.302”).		Oct. 16, 2000	1007
<i>MAC protocol specification (Release 1999)</i> , 3rd Generation Partnership Project, 3GPP TS 25.321 V3.6.0 (2000–12) (“TS 25.321”).		Dec. 10, 2000	1008
<i>Corrections to logical channel priorities in MAC protocol</i> , 3rd Generation Partnership Project, 3GPP TSG-RAN WG2 Meeting #18 (“R2-010182”).		Jan. 23, 2001	1010

¹ Petitioner also relies upon the Declarations of Fabio M. Chiussi, Ph.D., (Ex. 1003) and Friedhelm Rodermund (Ex. 1004).

² Petitioner relies upon the Rodermund Declaration to establish the public accessibility and publication dates of TS 23.107, TS 25.302, TS 25.321, and R2-010182. *See* Pet. 13–16.

³ Petitioner relies on the U.S. filing date of Peisa to establish its availability as prior art under 35 U.S.C. § 102(e). *See* Pet. 48.

D. Asserted Grounds of Unpatentability

References	Basis	Claims Challenged
TS 23.107, TS 25.302, TS 25.321, and R2-010182	§ 103(a)	1–6
Peisa and TS 23.107	§ 103(a)	1, 2
Peisa, TS 23.107, and TS 25.302	§ 103(a)	4–6

II. ANALYSIS

A. Institution of Inter Partes Review

Apple previously challenged claims 1–6 of the '487 patent as obvious over TS 25.302, TS 25.321, and R2-010182 (“the 3GPP references”), claims 1 and 2 as obvious over Peisa, and claims 4–6 as obvious over Peisa and TS 25.302. *See* Apple IPR, Paper 5, 4. Apple supported its petition with a declaration by R. Michael Buehrer, Ph.D., on the teachings of the prior art, and a declaration by Craig Bishop on the public accessibility of the 3GPP references. *Id.* at 4, 9, 12, 15. We instituted *inter partes* review of claims 1–6 of the '487 patent based upon Apple’s showing that its petition had a reasonable likelihood of success. *Id.*, Paper 11.

Microsoft, unlike petitioners who file a motion for joinder together with a “copycat” or “me too” petition, has filed a petition that raises different grounds of unpatentability than the grounds raised in the Apple IPR. Specifically, Microsoft adds a new reference, TS 23.107, to each of the grounds raised in the Apple IPR. *See* Pet. 5 (challenging claims 1–6 as obvious over *TS 23.107*, TS 25.302, TS 25.321, and R2-010182 (“the 3GPP challenges”), and challenging claims 1 and 2 as obvious over *TS 23.107* and Peisa, and claims 4–6 as obvious over *TS 23.107*, Peisa, and TS 25.302 (“the Peisa challenges”)). Microsoft also supports its petition with different

declarative testimony, relying on a declaration by Fabio M. Chiussi, Ph.D., on the teachings of the prior art, and a declaration by Friedhelm Rodermund on the public accessibility of the 3GPP references. *See id.* 13–16; Exs. 1003, 1004.

For its 3GPP challenges, Microsoft argues a person skilled in the art would have “designed the UMTS MAC Layer and Physical Layer to account for the relevant QoS Attributes specified by TS 23.107 for different types of connections.” *Id.* at 18 (citing Ex. 1003 ¶ 123; Ex. 1006, 13–26). Microsoft further argues “[t]he importance of TS 23.107 is *confirmed* by R2-010182, which expressly *explains the benefits of using TS 23.107’s maximum and guaranteed bitrate attributes* as QoS parameters in the MAC layer described in TS 25.321.” *Id.* (citing Ex. 1010, 1) (emphases added). Indeed, Microsoft argues a person skilled in the art would have modified TS 25.321’s TFC selection algorithm “to account for maximum and minimum bitrate criterion, *because R2-010182 explicitly prescribes doing so.*” *Id.* at 19 (citing Ex. 1010, 4) (emphasis added).

For the Peisa challenges, Microsoft argues “Peisa describes a MAC layer that ‘schedules packet transmission of various data flows’ by selecting valid TFCs ‘based on guaranteed rate transmission rates.’” *Id.* at 50. Microsoft further argues “Peisa teaches that the guaranteed rate for a logic[al] channel can be provided by a Radio Access Bearer (‘RAB’) parameter that is associated with the logical channel,” and TS 23.107 teaches “the minimum suitable bit rates for the various QoS classes can be specified as RAB guaranteed bit rate attributes.” *Id.* at 61–62 (citing Ex. 1005, 18:41–42; Ex. 1006, 25, Table 5). Thus, Microsoft argues, a person of ordinary skill in the art would have found it obvious “to use the minimum suitable

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