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Paper 20
Date: November 27, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01026
Patent 6,993,049 B2

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

BAER, *Administrative Patent Judge*.

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

Microsoft Corporation ("Petitioner") filed a Petition (Paper 1, "Pet."), requesting an *inter partes* review of claims 11 and 12 (the "challenged claims") 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.").

Patent Owner filed a Response to the Petition (Paper 9, "PO Resp.") and Petitioner filed a Reply (Paper 10, "Pet. Reply"). Patent Owner filed a Sur-Reply (Paper 12, "PO Sur-Reply"). An oral hearing was held on September 10, 2020, and the hearing transcript is included in the record. *See* Paper 19 ("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. 27 n.5. 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.

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 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 2017 LLC v. HTC America, Inc., 2:18-cv-01727 (W.D. Wash.), filed November 30, 2018; *Uniloc 2017 LLC v. Motorola Mobility, LLC*, 1:18-cv-01840 (D. Del.), filed November 20, 2018; *Uniloc 2017 LLC v. ZTE, Inc. et al.*, 3:18-cv03063 (N.D. Tex.), filed November 17, 2018; *Uniloc 2017 LLC v. Blackberry Corporation*, 3:18-cv-03068 (N.D. Tex.), filed November 17, 2018; *Uniloc USA Inc., et al. v. LG Electronics USA Inc., et al.*, 5:18-cv-06738 (N.D. Cal.), filed November 6, 2018; *Uniloc USA Inc., et al., v. ZTE (USA) Inc., et al.*, 3:18-cv-02839 (N.D. Tex.) filed October 24, 2018; *Uniloc 2017 LLC v. Microsoft Corporation*, 8:18-cv-01279 (C.D. Cal.), filed July 24, 2018; *Uniloc USA, Inc. v. ZTE (USA), Inc.*, 2:18-cv-00307 (E.D. Tex.), filed July 23, 2018; *Uniloc USA Inc. v. Blackberry Corporation*, 3:18-cv-01885 (N.D. Tex.), filed July 23, 2018; *Uniloc USA, Inc., v. Huawei Device USA, Inc.*, 2:18-cv-00074 (E.D. Tex.), filed March 13, 2018; *Uniloc USA Inc. v. LG Electronics USA Inc.*, 3:18-cv-00559 (N.D. Tex.), filed March 9, 2018; *Uniloc USA, Inc. v. Logitech, Inc.*, 5:18-cv-01304 (N.D. Cal.), filed February 28, 2018; *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, 2:18-cv-00040; *Apple Inc., et al. v. Uniloc 2017 LLC*, PTAB IPR2019-00251. Pet. ix–x; 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). 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. 2.

Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
11, 12	103	Larsson[2], Bluetooth Specification[3], RFC826[4]

[1] 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.
[2] U.S. Patent No. 6,704,293 B1 (iss. Dec. 6, 1999) (Ex. 1004, "Larsson").
[3] Bluetooth™ Core Specification Vol. 1, ver. 1.0 B (pub. Dec. 1, 1999) (Ex. 1005, "Bluetooth Specification").
[4] David C. Plummer, *An Ethernet Address Resolution Protocol*, IETF Request for Comments No. 826 (Pub. Nov. 1982) (Ex. 1006, "RFC826").

Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
11, 12	§ 103	802.11[5]

I. ANALYSIS

A. LEVEL OF SKILL IN THE ART

Petitioner asserts that a skilled artisan would have had "a Master's Degree in electrical or computer engineering with a focus in communication systems or, alternatively, a Bachelor's Degree in electrical or computer engineering and at least two years of experience in wireless communication systems." Pet. 10. In addition, according to Petitioner, "[a]dditional education in a relevant field, or industry experience may compensate for a deficit in one of the other aspects of the requirements stated above." *Id.* Patent Owner does not contest or offer its own formulation for a skilled artisan. PO Resp. 4. We agree with and adopt Petitioner's proposal because it is consistent with the '049 patent, as well as the problems and solutions in the prior art of record. *See Daiichi Sankyo Co., Ltd. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

B. CLAIM CONSTRUCTION

In *inter partes* reviews, we interpret claims "using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b). Under this standard, we construe claims "in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." *Id.* Only claim

[5] ANSI/IEEE Std 802.11, Part 11: *Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications* (pub. Aug. 20, 1999) (Ex. 1007, "802.11").

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