

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00101
Patent 8,495,359 B2

Before THOMAS L. GIANNETTI, TREVOR M. JEFFERSON, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Microsoft Corporation (“Microsoft”) filed a Petition for *inter partes* review (Paper 2, “Pet.”) of claims 1–15 of U.S. Patent No. 8,495,359 B2 (Ex. 1001, “the ’359 patent”). Patent Owner Uniloc 2017 LLC (“Uniloc”) filed a Preliminary Response (“Prelim. Resp.”). Paper 8.

We may institute an *inter partes* review only if “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) (2018). Applying that standard, we do not institute an *inter partes* review, for the reasons explained below.

II. BACKGROUND

A. RELATED PROCEEDINGS

The parties identify the following proceeding as relating to the ’359 patent: *Uniloc 2017 LLC v. Microsoft Corporation*, 8:19-cv-00783¹ (D.C. Cal. filed April 29, 2019). Pet. vi; Paper 6, 2.

B. REAL PARTIES IN INTEREST

Microsoft identifies only itself as the real party in interest. Pet. vi. Uniloc does not challenge that identification, and also only identifies itself as the real party in interest. Paper 6, 2.

C. THE ’359 PATENT (EX. 1001)

The ’359 patent relates to a system in which one computing device (the originator) sends an electronic communication to a recipient computing device, after encrypting the message using a key provided by a gateway server. Ex. 1001, 33–41.

¹ Uniloc incorrectly lists the docket number as 8:19-cv-00873. Paper 6, 2.

Figure 3B of the patent, reproduced below, depicts an embodiment of the invention:

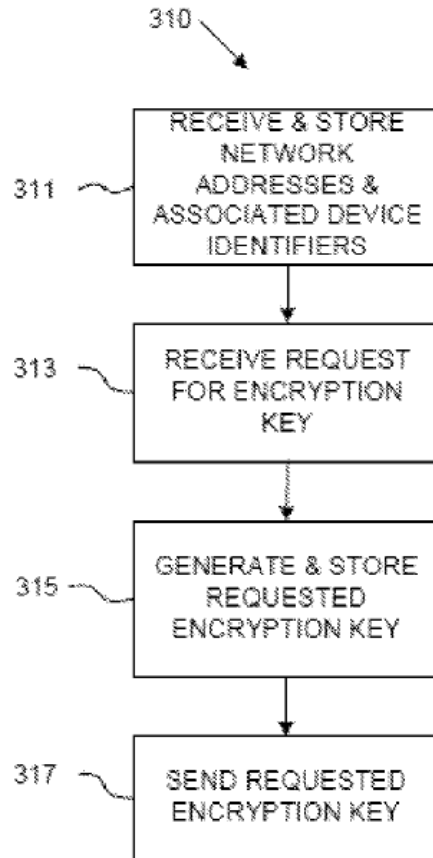


FIG. 3B

Figure 3B is a flowchart for a process (310) in which the gateway server interacts with the originator and receiver of the message. Ex. 1001, 6:60–61. Initially, in step 311, the gateway server receives and stores the network addresses and device identifiers of the devices it serves in the network. *Id.* at 6:61–64. Each device identifier “is generated by a process which operates on data indicative of the computing device’s configuration and hardware,” and “has a very high probability (e.g., greater than 99.999%) of being unique to the target device.” *Id.* at 4:3–5, 15–16.

In step 313, the gateway server receives, from the originator, a request for an encryption key associated with the recipient device. *Id.* at 6:64–65. In step 315, if the intended recipient computer exists within the gateway server’s database, the gateway server generates an encryption key unique to the intended recipient. *Id.* at 6:64–7:1. In step 317, the gateway server then sends the encryption key to the originator. *Id.* at 7:10–13. The originator uses the key to encrypt the message, and then sends the secure message over the network to the recipient computer. *Id.* at 6:56–59.

When the recipient computer receives the encrypted message, it generates its own encryption key using its stored device identifier, and uses that key to decrypt the message. Ex. 1001, 7:20–23. The recipient computer “may also take the additional step of querying the server to determine if the computer purporting to send the secure communication, i.e., the sending computer, did, in fact, request the encryption key.” *Id.* at 7:32–36; *see also* 7:13–15 (“[T]he server . . . may provide confirmations to the receiving computer that the sending computer requested and was sent the encryption key.”). According to the ’359 patent, “[s]uch confirmation aids in building trust that the communication actually originated from the sending computer.” *Id.* at 7:15–17.

D. CHALLENGED CLAIMS AND ASSERTED GROUND OF
UNPATENTABILITY

Microsoft's sole ground for the *inter partes* review is summarized in the following table:

Claims Challenged	35 U.S.C. §	References
1–15	103 ²	Olkin, ³ Kim ⁴

Pet. 2. Microsoft argues that claims 1–15 of the '359 patent are unpatentable as obvious over Olkin in view of Kim. *See* Pet. 2, 11–40.

Independent claim 1, which follows, exemplifies the invention:

- [1.1] 1. A system for securing an electronic communication, the system comprising:
 - [1.2] a gateway server configured to:
 - receive and store a device identifier and a network address from a first computing device, wherein the device identifier is generated by the first computing device from a combination of user-configurable and non-user-configurable parameters of the first computing device and uniquely identifies the first computing device, and wherein the network address is associated with the first computing device;
 - [1.3] receive from a second computing device the network address for the first computing device and an encryption key request;
 - [1.4] derive an encryption key from the device identifier for the first computing device;

² Because the filing date of the '359 patent is before March 16, 2013, we apply the version of 35 U.S.C. § 103 that existed prior to the Leahy–Smith America Invents Act. *See* Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 284, 293 (2011).

³ Olkin et al., US 7,376,835 B2, issued May 20, 2008 (Ex. 1003) (“Olkin”).

⁴ Kim et al., US 2009/0055648 A1, published Feb. 26, 2009 (Ex. 1004) (“Kim”).

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