

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

Uniloc 2017 LLC,
Patent Owner.

IPR2020-00463
Patent 8,194,632 B2

Before DAVID C. MCKONE, JESSICA C. KAISER, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Google LLC (“Petitioner”), filed a Petition for *inter partes* review of claims 1, 8, and 15 (“the challenged claims”) of U.S. Patent No. 8,194,632 B2 (Ex. 1001, “the ’632 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization (Paper 8), Petitioner filed a Reply relating to our

discretion under 35 U.S.C. § 314(a), Paper 7 (“Reply”), and Patent Owner filed a Sur-Reply, Paper 12 (“Sur-Reply”). We have authority under 35 U.S.C. § 6(b)(4) and 35 U.S.C. § 314.

Upon consideration of the Petition, Preliminary Response, and additional briefing we decline to exercise discretion to deny institution under 35 U.S.C. § 314(a), and we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’632 patent. Accordingly, we institute *inter partes* review of all challenged claims on all grounds raised.

II. BACKGROUND

A. *Real Parties in Interest and Related Matters*

Petitioner identifies only itself as the real party in interest. Pet. 60. Patent Owner identifies only itself as the real party in interest. Paper 3, 1.

Petitioner and Patent Owner identify *Uniloc 2017 LLC v. Google LLC*, Action 2:18-cv-00499 (E.D. Tex.) as a related matter. Pet. 60; Paper 3, 2. Petitioner and Patent Owner each note that this case has been transferred to the Northern District of California. Reply, 1–2; Sur-Reply, 1; Ex. 1023.

Additionally, Petitioner identifies six patent applications to which the ’632 patent claims priority, and two patent applications that claim priority to the application that issued as the ’632 patent.

B. *The ’632 Patent*

The ’632 patent is directed to establishing network connections between a stationary terminal (such as a laptop, desktop, or workstation) and a remote device (a remote stationary terminal or a mobile device, such as a

smart phone or PDA) through intermediary mobile devices. Ex. 1001, code (54), 1:25–31, 2:51–56. Figure 1 of the '632 patent is reproduced below:

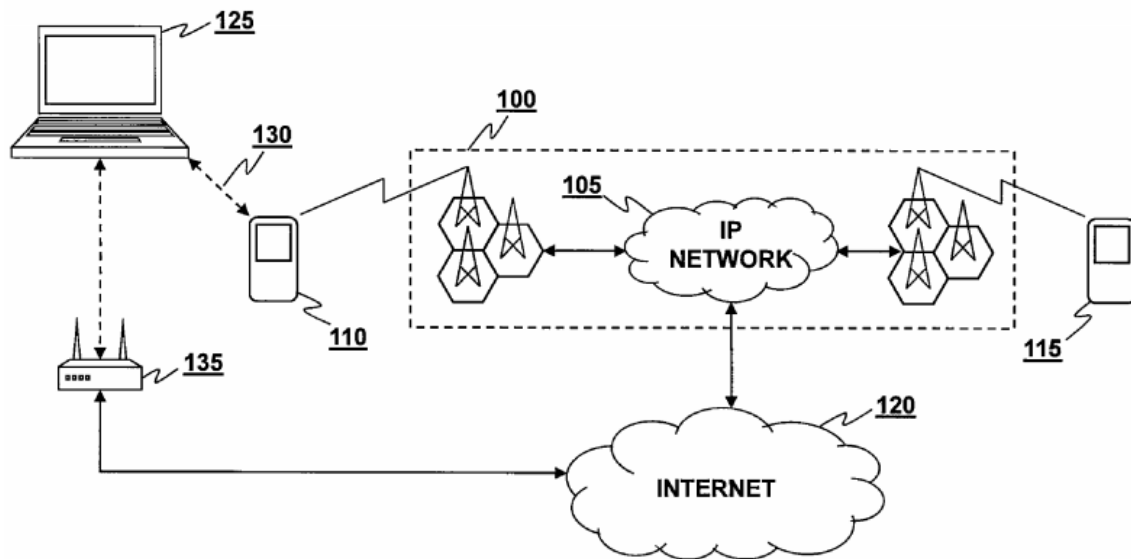


FIG. 1

Figure 1 is a diagram of an environment in which the invention may be deployed. *Id.* at 2:29–30, 2:40–41.

In Figure 1, mobile devices 110 and 115 are connected via cellular wireless network system 100, and mobile device 110 is connected via a short-range wireless technology, such as Bluetooth, with stationary terminal 125. *Id.* at 1:40–50, 1:61–67, 3:20–40, 5:1–20. Stationary terminal 125 also can access the Internet 120. *Id.* at 3:9–16.

The '632 patent describes one embodiment of the invention in which a network connection is established between an initiating stationary terminal (such as stationary terminal 125 in Fig. 1) and a remote device (such as

mobile device 115 in Fig. 1), and describes this embodiment with reference to Figure 3, reproduced below. *Id.* at 2:34–36, 4:29–67.

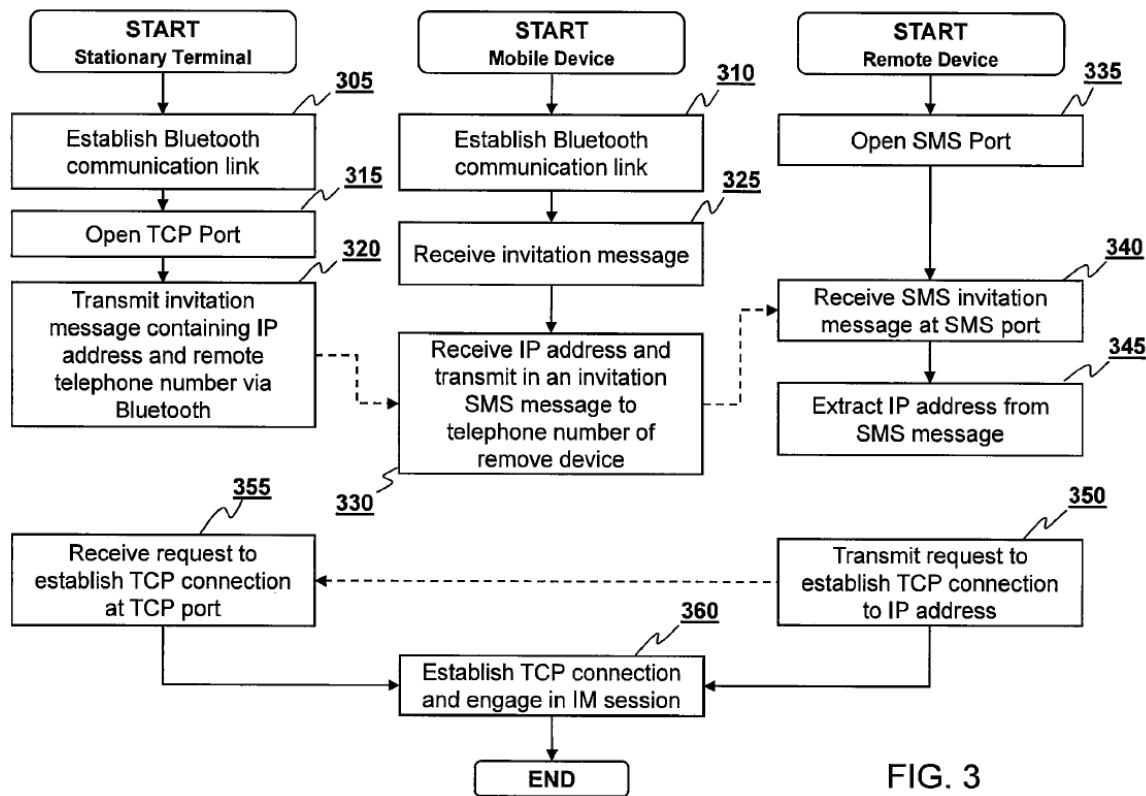


Figure 3 is a flow chart that depicts steps performed by a stationary terminal, a mobile device proximate to the stationary terminal, and a remote device. *Id.* at 4:29–67. The stationary terminal and proximate mobile device establish a Bluetooth (or other short-range wireless technology) communication link with each other. *Id.* at 4:36–44, Fig. 3 (elements 305, 310). The stationary terminal transmits an invitation message to the proximate mobile device. *Id.* at 4:47–51, Fig. 3 (element 320). This message includes information necessary for the remote device to establish a connection with the stationary terminal (such as an IP address and TCP port information) and the remote device’s cellular telephone number. *Id.* at 4:47–51. The proximate mobile device transmits an SMS message to the remote device, using the provided cellular telephone number and including the

provided connection information, and the remote device extracts and utilizes the included information to establish a connection to the stationary terminal. *Id.* at 4:51–67, Fig. 3 (elements 330, 340, 345, 350, 355, 360).

C. Illustrative Claims

Claim 1 of the '632 patent is a representative claim and is reproduced below.

1. A method for establishing a data communications session between a stationary terminal and a remote device, the method comprising:

establishing a communication link through a short-range wireless technology between the stationary terminal and a proximate mobile device wherein the proximate mobile device operates within a cellular wireless network system;

transmitting, by the stationary terminal, an invitation message comprising a network address relating to the stationary terminal and a remote device identifier to the proximate mobile device through the established communication link, whereupon the proximate mobile device establishes communication with the remote device using the remote device identifier and provides the network address of the stationary terminal to the remote device; and

establishing a connection between the stationary terminal and the remote device for data communications based upon an initial communication by the remote device through use of the network address of the stationary terminal provided to the remote device by the proximate mobile device.

Ex. 1001, 6:26–48.

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