

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01804
Patent 8,724,622 B2

Before JENNIFER S. BISK, MIRIAM L. QUINN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, “the ’622 patent”). Paper 2 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”)¹ filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314. Based on the particular circumstances presented, we exercise our discretion under 37 C.F.R. § 42.108 and do not institute an *inter partes* review in this case.

II. DISCUSSION

A. *Related Matters*

The parties indicate that the ’622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 4, 2. The ’622 patent also was the subject of two requests for *inter partes* review filed by Petitioner on November 14, 2016

¹ Patent Owner’s Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as exclusive licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as “Patent Owner.” *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

(Cases IPR2017-00223 and IPR2017-00224), both of which were denied. *See* IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with filing of the instant Petition on July 20, 2017, Petitioner additionally filed a petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of the ’622 patent (Case IPR2017-01805). IPR2017-01805, Paper 2. By Petitioner’s own admission, the instant Petition and the petition filed in Case IPR2017-01805 are “substantively identical” to petitions filed June 22, 2017, by Facebook, Inc. and WhatsApp Inc. (collectively, “Facebook”) in Cases IPR2017-01667 and IPR2017-01668, respectively, apart from the inclusion of two new sections addressing such identity. *See* Pet. 76; IPR2017-01805, Paper 2, 65. Earlier today, the Board instituted *inter partes* review in Cases IPR2017-01667 and IPR2017-01668. IPR2017-01667, Paper 8 (PTAB Jan. 19, 2018); IPR2017-01668, Paper 8 (PTAB Jan. 19, 2018).

Further, Samsung Electronics America, Inc. also filed two requests for *inter partes* review of certain claims of the ’622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Huawei Device Co., Ltd. (“Huawei”) filed a request for *inter partes* review of the same claims as the instant Petition and the petition in Case IPR2017-01668 on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the ’622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Huawei additionally filed a motion for joinder to Case IPR2017-01667 concurrently with its petition in Case IPR2017-02090. IPR2017-02090, Paper 3.

B. Discretionary Non-institution

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. “In determining whether to institute or order a proceeding under . . . Chapter 31 [of Title 35 of the U.S. Code, providing for *inter partes* review], the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In this case, as noted in the previous section, Petitioner admits that the Petition is substantively identical to Facebook’s petition in Case IPR2017-01667 (“the ’1667 IPR”), which challenges the same claims on the same grounds, aside from the addition of new “sections VII–VIII.” Pet. 76. Moreover, the new “sections VII–VIII” referenced by Petitioner do not alter the substance of the asserted grounds. Rather, Section VII represents that “Petitioner has limited its grounds to those in [the ’1667 IPR], including the same analysis, prior art and declaration”; that “any differences are shown in Exhibit 1020”;² and that Petitioner will request joinder with the ’1667 IPR “when appropriate.” *Id.* Petitioner further represents that “[i]f joined, Petitioner will accept a limited capacity unless Facebook terminates as a party,” and “[i]f not [joined], Petitioner consents to coordinating schedules.” *Id.* In Section VIII of the Petition, titled “The Board should institute in view

² We note that in addition to the redlined petition that Petitioner filed as Exhibit 1020, showing differences relative to Facebook’s petition in the ’1667 IPR, Petitioner also filed a redlined version of Facebook’s supporting expert declaration of Tal Lavian, Ph.D. from that case, as Exhibit 1021. *See* Pet. ix. Our review of Exhibits 1020 and 1021 confirms Petitioner’s representation that Petitioner has limited its ground in this case to those in the ’1667 IPR.

of §325(d),” Petitioner contends that “the eight §325(d) factors have marginal relevance here because Petitioner does not present grounds beyond” the ’1667 IPR, and that “the eight factors in *Blue Coat Systems v. Finjan*, IPR2016-01443, Paper 13, pp. 8–9, support this subsequent petition.” *Id.* at 76–77.

Notwithstanding Petitioner’s contentions regarding § 325(d),³ we exercise our discretion under 37 C.F.R. § 42.108(a) to deny the Petition, based on the *complete identity* of prior art and arguments to those presented to the Office in the ’1667 IPR. We recognize that the Board often institutes *inter partes* review on petitions substantively identical to earlier successful petitions, where the second petition is accompanied by an unopposed or

³ It is unclear whether Petitioner, in its reference to “eight §325(d) factors hav[ing] marginal relevance here,” intends to refer to the same “eight factors in *Blue Coat Systems*” that allegedly “support this subsequent petition.” Pet. 76. Of the eight factors presented in the cited *Blue Coat Systems* proceeding, only the eighth factor, “whether the same or substantially the same prior art or arguments previously were presented to the Office,” directly relates to § 325(d). Notably, Petitioner does not persuasively address that eighth factor. *See id.* at 76–77 (arguing with respect to “Factors 3–5 and 8,” collectively, only that “Courts and the PTAB have differentiated between art that should be known by a ‘skilled searcher conducting a diligent search,’ as opposed to ‘a scorched-earth search,’” and that “[b]efore filing earlier petitions, Petitioner performed a reasonable prior art search that did not uncover” the particular prior art cited in the Petition, neither of which arguments has any discernible bearing on § 325(d)). The remaining seven factors articulated in *Blue Coat Systems*, while relevant to the Board’s more general discretion under 35 U.S.C. § 314(a), do not enter into the determination under § 325(d) “whether . . . the same or substantially the same prior art or arguments previously were presented.” In any event, we agree with Patent Owner’s arguments that the factors set forth in *Blue Coat Systems*, to the extent applicable, do not weigh in Petitioner’s favor in this case. *See* Prelim. Resp. 8–11.

unpersuasively opposed request for joinder pursuant to 37 C.F.R. § 42.112(b), in which cases the filer of the second petition is then joined as a petitioner in the first proceeding and the second proceeding is immediately terminated. *See, e.g.*, IPR2017-01636, slip op. at 14–16 (PTAB Oct. 3, 2017) (Paper 10) (instituting *inter partes* review in Case IPR2017-01636; joining Facebook, Inc. and WhatsApp, Inc. as petitioners in Case IPR2017-00221, *Apple Inc. v. Uniloc USA, Inc.*, a pending review involving the same asserted grounds of unpatentability; and then terminating Case IPR2017-01636). That, however, is not the posture of this case. Petitioner has not filed a request for joinder with the '1667 IPR, but merely has represented that it will do so at some unspecified time “when appropriate.”

Pet. 76. If we were to institute trial at this time, Patent Owner would be required to participate in duplicative proceedings with different petitioners, each having its own counsel, until such time, if ever, as Petitioner deemed it “appropriate” to request joinder. Further, because we are required to enter a decision on institution within three months of Patent Owner’s filing of its Preliminary Response on November 8, 2017—i.e., by February 8, 2018—35 U.S.C. § 314(b) (“The Director shall determine whether to institute an *inter partes* review . . . within 3 months after . . . receiving a preliminary response to the petition . . .”), there would be insufficient time for briefing to be completed before entry of our decision on institution even if Petitioner were to file a motion for joinder immediately, *see* 37 C.F.R. § 42.25(a)(1) (providing that an opposition is due one month after service of a motion).

Accordingly, under the circumstances, the Petition is denied, without prejudice to Petitioner’s ability to file a new petition accompanied by a

request for joinder pursuant to and within the time period permitted by
37 C.F.R. § 42.122(b).

III. CONCLUSION

In summary:

Ground	Basis	Claims Challenged	Claims Instituted
1	§ 103 Zydney ⁴ and Shinder ⁵	3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38	None
2	§ 103 Zydney, Shinder, and Clark ⁶	14–17, 28–31	None
3	§ 103 Zydney, Shinder, and Appelman ⁷	22, 39	None
Summary		3, 6–8, 10, 11, 13–23, 27–35, 38, 39	None

IV. ORDER

Upon consideration of the record before us, it is, therefore,
ORDERED that the Petition is *denied*, and no trial or *inter partes*
review is instituted on any asserted ground.

⁴Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added as Exhibit 1003).

⁵ Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1014).

⁶ Clark et al., US 6,725,228 B1, issued Apr. 20, 2004 (Ex. 1008).

⁷ Appelman, US 6,750,881 B1, issued June 15, 2004 (Ex. 1004).

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