

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00448
Patent 6,329,934 B1

Before ROBERT J. WEINSCHENK, MONICA S. ULLAGADDI,
and SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

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

I. INTRODUCTION

On January 17, 2020, Google LLC (“Petitioner”) filed a Petition seeking institution of *inter partes* review of claim 3 of U.S. Patent No. 6,329,934 B1 (Ex. 1001, “the ’934 patent”). Paper 1 (“Pet.”). Uniloc 2017, LLC (“Patent Owner”) filed a Preliminary Response on April 23, 2020. Paper 7 (“Prelim. Resp.”).

We may institute an *inter partes* review if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. *See* 35 U.S.C. § 314. However, the Board has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; *see, e.g., Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The Trial Practice Guide identifies considerations that may warrant exercise of this discretion. Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) 55–63¹.

Having considered the parties’ submissions, we determine that it is appropriate in this case to exercise our discretion to deny institution of *inter partes* review pursuant to 35 U.S.C. § 314(a).

II. BACKGROUND

A. *Related Proceedings*

At the time the Petition was filed, the ’934 patent was asserted against Petitioner in *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00497 (E.D. Tex.).

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Pet. 1; Paper 5, 2. On June 5, 2020, Uniloc filed a voluntary motion to dismiss the litigation. Ex. 1024. The district court subsequently dismissed the case with prejudice. Ex. 3001.

The '934 patent is the subject of another petition for *inter partes* review in IPR2020-00447 filed by Google LLC on the same day as this case. Paper 5, 2.

B. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 2–3):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
3	102(e) ²	Liu ³
3	103(a)	Liu, Chitprasert ⁴

III. ANALYSIS

Petitioner filed two petitions requesting *inter partes* review of the '934 patent based on the same references, Liu and Chitprasert. *See supra*; *see also* IPR2020-00447, Paper 1, 2–3 (“the '447 petition”). The '447 petition challenges claim 1 of the '934 patent, while the present Petition challenges claim 3. Patent Owner contends the Board should exercise its discretion

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of §§ 102, 103.

³ US 5,907,374, published May 25, 1999 (Ex. 1005).

⁴ Chitprasert et al., *Discrete Cosine Transform Filtering*, Signal Processing (1990) (Ex. 1007).

under 35 U.S.C. § 314(a) and deny institution because Petitioner’s filing of two parallel petitions “places a substantial and unnecessary burden on the Board and the Patent Owner, and raises fairness, timing, and efficiency concerns.” Prelim. Resp. 18–19.⁵ In support of this position, Patent Owner cites the July 2019 Trial Practice Guide and the Consolidated Trial Practice Guide. *Id.* at 19.

Under § 314(a), we have discretion to deny institution of an *inter partes* review. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). In deciding whether to institute *inter partes* review, we consider the guidance in the Consolidated Trial Practice Guide, which states:

Based on the Board’s prior experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.

CTPG, 59. However, more than one petition may be necessary, for example, “when the patent owner has asserted a large number of claims in litigation or

⁵ Patent Owner also contends we should deny institution under § 314(a) based on its district court litigation and the rationale in *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). Prelim. Resp. 6–18. Because we deny institution on other grounds, we do not reach Patent Owner’s *NHK* argument. In any event, the district court has dismissed the litigation. Ex. 3001.

when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.*

The Consolidated Trial Practice Guide explains that “two petitions by a petitioner may be needed, although this should be rare.” *Id.* The Consolidated Trial Practice Guide instructs petitioners that file multiple petitions challenging the same patent to submit (1) a ranking of the petitions in the order that the petitioner wishes the Board to consider the merits, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute any additional petitions. *Id.* at 59–60.

Pursuant to this guidance, Petitioner filed a “Petitioner’s Notice Regarding Multiple Petitions.” Paper 3 (“Notice”). In the Notice, Petitioner ranks the Petition filed in this proceeding as second to the petition filed in IPR2020-00447. Notice 1. Also in the Notice, Petitioner justifies filing two petitions by contending:

- A) while the Board must institute trial on all challenged claims, the Board may determine that the scope of one or more of the means-plus-function terms in claim 3 is unclear (*id.* at 2; Pet. 16–18);
- B) the petitions are materially different because each petition addresses a different claim, and denying one petition would leave an asserted claim in the related litigation unaddressed (Notice 2–3);
- C) both the Administrative Procedure Act and due process weigh against denying institution (*id.* at 3);
- D) two petitions does not abuse the process because no petitioner has previously filed any petition challenging the ’934 patent (*id.*); and

E) given that both petitions are based on the same prior art and are limited to one challenged claim each, institution of both petitions would not implicate any of the concerns regarding the Board's time and resources (*id.*).

Patent Owner argues that "Petitioner's alleged justification essentially boils down to the excuse that one petition challenges claim 1 and one challenges claim 3." Prelim. Resp. 18. Patent Owner further contends that this is not the rare case outlined in the Consolidated Trial Practice Guide involving a large number of asserted claims in litigation or a dispute about priority date requiring arguments under multiple prior art references. *Id.* at 19 (citing CTPG 59). Moreover, Patent Owner contends that the Consolidated Trial Practice Guide "provides no indication that dividing claims between two petitions justifies filing multiple petitions." *Id.*

As discussed below, Petitioner's arguments fall short of establishing that this second-ranked petition is necessary under our operating guidance set forth in the Consolidated Trial Practice Guide.

Addressing Petitioner's argument (A), we are not persuaded that the presence of alleged indefinite means-plus-function terms in claim 3 justifies a second petition. The Consolidated Trial Practice Guide does not identify potential indefiniteness as a factor justifying multiple petitions. *See* CGTP 59. Petitioner's indefiniteness concern does not implicate either of the examples identified in the Consolidated Trial Practice Guide, namely a large number of asserted claims in litigation or a priority dispute. *See id.* Although these factors are not exhaustive, Petitioner does not persuasively argue this case is analogous to those examples.

Petitioner could have filed a single petition directed to both claims. Then, even if claim 3 had an unclear means-plus-function term, we still could have instituted the petition if Petitioner had met its burden on claim 1. *See* 35 U.S.C. § 314(a) (authorizing institution if “the petition . . . 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.”) (emphasis added). We are, in fact, concurrently instituting trial on claim 1 based on the ’447 petition. This is not the kind of situation as in other cases where the Board has denied institution when petitioners met their institution burden on only a small subset of the challenged claims. *See Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923 (Nov. 7, 2018) (Paper 9) (informative) (denying institution where Petitioner demonstrated at most a reasonable likelihood of prevailing on two dependent claims of twenty challenged claims.); *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310 (Jan. 24, 2019) (Paper 7) (informative) (denying institution where Petitioner demonstrated a reasonable likelihood of prevailing on only two claims out of twenty-three challenged claims.).

Turning to Petitioner’s argument (B), the mere fact that each petition addresses a different claim is insufficient to justify filing two petitions. Petitioner also does not persuade us that leaving unaddressed a claim that was asserted in the related litigation should affect our analysis at least because the related litigation has been dismissed. *See* Ex. 3001.

As to Petitioner’s argument (C), Petitioner merely contends, without support, that both the Administrative Procedure Act and due process weigh against denying institution. Such conclusory arguments are unpersuasive. In any event, we disagree because “[Section] 314(a) invests the Director

with discretion on the question whether to institute review.” *SAS*, 138 S. Ct. at 1356 (emphasis omitted). As to Petitioner’s argument (D), we are not persuaded that the absence of any previous petition challenging the ’934 patent justifies this parallel petition.

Finally, as to Petitioner’s argument (E), the fact that both petitions are based on the same prior art and are each directed to one claim—both of which are nearly identical—weighs against institution here. The highly duplicative nature of these two petitions and the small number of claims at issue further indicates that one petition should have been sufficient.⁶

For the foregoing reasons, we are not persuaded by Petitioner’s arguments that two petitions are necessary, and we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of review in this second-ranked proceeding.

IV. CONCLUSION

For the foregoing reasons, based on a balanced assessment of the circumstances of this case, we exercise our discretion under 35 U.S.C. § 314 and decline to institute this *inter partes* review of the ’934 patent.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that no *inter partes* review is instituted.

⁶ We also question the necessity of the Petition using 13,874 words to address a single claim. *See* Pet., Certificate of Compliance.

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