

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2019-01667
Patent 7,020,252 B2

Before JEFFREY S. SMITH, BARBARA A. PARVIS, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER

Granting Authorization to File a Motion to Terminate
Granting Authorization to File Response to Estoppel Arguments
Denying Request for Additional Discovery
37 C.F.R. § 4.5(a)

On January 28, 2021, a call was held with respective counsel for the parties and Judges Smith, Parvis, and Beamer to discuss the parties' requests for additional briefing and discovery. That additional briefing and discovery relates to the issue of estoppel due to a Petition filed by Unified Patents LLC ("Unified Patents") in IPR2019-00453 and a final written decision, which

issued in that proceeding on July 22, 2020 determining all challenged claims unpatentable. *See Unified Patents LLC v. Uniloc 2017 LLC*, IPR2019-00453, Paper 38 (PTAB July 22, 2020) (“the ’453 Final Written Decision”). Each of the parties’ requests is discussed further below.

I. ADDITIONAL DISCOVERY

Uniloc 2017 LLC (“Uniloc”) requests additional discovery including documents relating to whether Apple Inc. (“Apple”) or Unified Patents is a real party-in-interest or privy of the other. During the call on January 28, 2021, Uniloc indicated that its remaining discovery requests are set forth in an e-mail sent to the Board on December 7, 2020. *See Ex. 3001*. Apple already produced documents identified as APPLE00001–APPLE00031 to address certain of Uniloc’s requests.

During the call on January 28, 2021, the parties indicated that they conducted a meet and confer on January 26, 2021 regarding Uniloc’s remaining requests. Apple represents that it conducted further searches and investigations and will not agree to produce additional documents. Importantly, Apple represents that it does not have written communications between Apple and Unified Patents regarding the challenged patent. Apple acknowledges that it may have received system generated e-mails from Unified Patents that are identical to publicly available posts on Unified Patents’s web site, but Apple contends those communications do not fall within the scope of Uniloc’s request. Apple argues that Uniloc’s remaining requests are overly broad.

We are persuaded that Uniloc may obtain the same information that is in the system generated e-mails using the Unified Patents web site. In light of Apple’s representation that it does not have other responsive written communications, we do not grant Uniloc’s request for additional discovery.

We agree with Apple that Uniloc's other requests are overly broad. Further, Apple has conducted searches regarding pertinent documents and Apple represents that it does not have those documents. Accordingly, Uniloc's request for additional discovery is denied.

II. MOTION TO TERMINATE

Upon consideration of the parties' arguments relating to Uniloc's Motion to Terminate, we believe additional briefing on the issue will be helpful to the panel. We therefore grant Uniloc's request for authorization to file a Motion to Terminate the instant proceeding. Uniloc's Motion is limited to fifteen (15) pages and is due February 10, 2021. We also grant Apple authorization to file an Opposition, which is limited to fifteen (15) pages and is due February 19, 2021. We further grant Uniloc a Reply, which is limited to five (5) pages and is due February 26, 2021.

III. APPLE'S REQUEST

During the call on January 28, 2021, Uniloc indicated that its Motion to Terminate will not overlap significantly with the arguments made in its Sur-reply. Also, Apple indicated during the hearing on January 21, 2021, that Apple no longer opposes a short responsive paper by Uniloc.

We, therefore, also grant Apple's request for authorization to file a submission to respond to only pages 2 through 6 of Uniloc's Sur-reply (Paper 13) asserting that Apple is estopped from maintaining the instant *inter partes* review. Apple's submission is limited to five (5) pages and is due February 10, 2021. We further grant Uniloc authorization to file a submission responding to only arguments in Apple's submission. Uniloc's submission is limited to five (5) pages and is due February 19, 2021.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Uniloc's request for additional discovery is *denied*;

FURTHER ORDERED that Uniloc is authorized to file a Motion to Terminate the instant proceeding, which is limited to fifteen (15) pages and is due by February 10, 2021;

FURTHER ORDERED that Apple is authorized to file an Opposition to Uniloc's Motion to Terminate, which is limited to fifteen (15) pages and is due February 19, 2021;

FURTHER ORDERED that Uniloc is authorized to file a Reply to Apple's Opposition to Uniloc's Motion to Terminate, which is limited to five (5) pages and is due February 26, 2021;

FURTHER ORDERED that Apple is authorized to file a submission to respond to only pages 2 through 6 of Uniloc's Sur-reply (Paper 13); Apple's submission shall be limited to five (5) pages and is due February 10, 2021; and

FURTHER ORDERED that Uniloc is authorized to file a submission responsive to Apple's submission, which is limited to five (5) pages and is due February 19, 2021.

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