

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01828
Patent 6,489,974 B1

Before SALLY C. MEDLEY, BARBARA A. BENOIT, and
JESSICA C. KAISER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Ubisoft, Inc. (“Petitioner”)¹ filed a Petition for *inter partes* review of claims 1, 2, 4, 8, 12, 13, 15, and 19 of U.S. Patent No. 6,489,974 B1 (Ex. 1001, “the ’974 patent”). Paper 2 (“Pet.”). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response.² Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “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); see 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented does not show there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1, 2, 4, 8, 12, 13, 15, and 19 of the ’974 patent.

A. Related Matters

The parties state that the ’974 patent is the subject of a court proceeding styled *Uniloc v. Ubisoft, Inc.*, Case No. 2:16-cv-00781 (E.D. Tex.). Pet. 53³; Paper 3, 2.

¹ The Petition identifies Ubisoft, Inc. as a real party-in-interest, and Ubisoft Entertainment, S.A. as a “potential real party-in-interest.” Pet. 51.

² Patent Owner identifies Uniloc Luxembourg S.A. and exclusive licensee Uniloc USA, Inc. as real parties-in-interest. Paper 3, 1.

³ Petitioner did not number the pages of its Petition. For purposes of this Decision, page numbering of the Petition begins at the page with the section styled “I. INTRODUCTION.”

B. The '974 Patent

The '974 patent is directed to a method and apparatus for notifying user input situations and execution terminations in asynchronously executing tasks in multitasking computer environments. Ex. 1001, 1:10–13. Notification of an executing object becoming idle is provided in a multitasking environment. *Id.* Abstract. As the object executes, the user can interface with a second object. *Id.* When the executing object becomes accessible, a buoy icon object is suddenly displayed. *Id.* at 4:38–41, Abstract. The buoy icon has the name of the object as well as a pointer line extending from the buoy icon to the accessible object. *Id.* Abstract, Fig. 2. Figure 2 is illustrative and reproduced below.

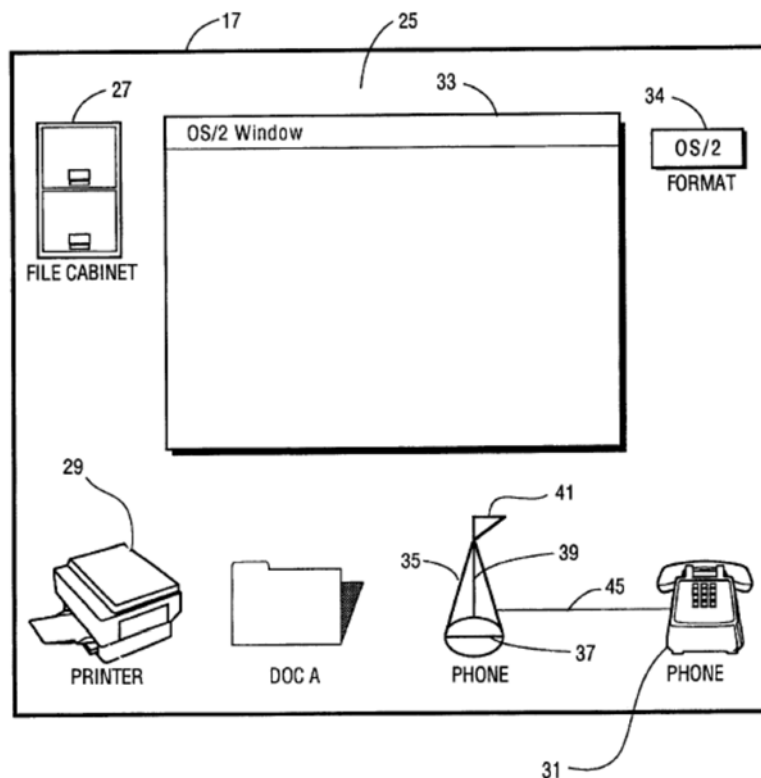


FIG 2

Figure 2 shows a desktop 25 on screen 17. *Id.* at 3:52–53. Desktop 25 includes plural icons representing plural objects. A focused object

presents a window 33 and is enabled to receive user inputs. *Id.* at 3:53–62. A user can work within the focused object 33 while waiting for another object, such as phone object 31, to execute (e.g., to send a fax). *Id.* at 4:4–12. When the execution of the phone object 31 reaches a step where a user input is required, a buoy icon 35 is displayed on the desktop to notify the user that the specified object is available for user input. *Id.* at 4:13–28.

C. Illustrative Claims

Petitioner challenges claims 1, 2, 4, 8, 12, 13, 15, and 19 of the '974 patent. Claims 1 and 12 are independent claims and are reproduced below with pertinent language italicized:

1. A method that is implemented on a multitasking computer that comprises first and second objects, said method providing notification of a status of said first object on said computer, comprising the steps of:

a) providing a representation of said first object on a user interface of said computer, with the representation supporting user interaction with said first object on said user interface of said computer;

b) executing said first object on said computer;

c) while said first object is executing, enabling said second object so as to support user interaction with said second object on said user interface of said computer;

d) while said second object is enabled so as to support user interaction, determining when said first object ceases executing;

e) *providing a notification on said user interface when said first object ceases executing by suddenly displaying a notification icon on said user interface of said computer while maintaining the representation of the first object, said notification icon being in a location that is separate from the representation of said first object on said user interface.*

Id. at 9:62–10:17.

12. An apparatus for use with a multitasking computer, said computer comprising first and second objects, said apparatus providing notification of a status of said first object on said computer, comprising:

a) means for providing a representation of said first object on a user interface of said computer, with the representation supporting user interaction with said first object on said user interface of said computer;

b) means for executing said first object on said computer;

c) means for enabling said second object so as to support user interaction with said second object on a user interface of said computer while said first object is executing;

d) means for determining when said first object ceases executing while said second object is enabled so as to support user interaction;

e) means *for providing a notification on said user interface when said first object ceases executing by suddenly displaying a notification icon on said user interface of said computer while maintaining the representation of the first object*, said notification icon being in a location that is separate from the representation of said first object on said user interface.

Id. at 11:13–36.

D. Asserted Ground of Unpatentability

Petitioner asserts that claims 1, 2, 4, 8, 12, 13, 15, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Inside Macintosh, Volume VI (“Inside Macintosh”) (Ex. 1002). Pet. 1.

II. DISCUSSION

A. Claim Construction

The '974 patent expired on June 19, 2017. Ex. 1001; Pet. 2; Prelim. Resp. 5. For claims of an expired patent, the Board's claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc)). There is, however, a presumption that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Although Petitioner proffers constructions for the corresponding structure for several means-plus-function terms (Pet. 2–8), and Patent Owner weighs in on those constructions (Prelim. Resp. 5–7), for purposes of this decision we need not expressly construe any of the corresponding structures for the means-plus-function terms or any other claim term. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy"); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in the context of an *inter partes* review).

B. Anticipation of Claims over Inside Macintosh

Petitioner contends claims 1, 2, 4, 8, 12, 13, 15, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Inside Macintosh. Pet. 4–43.

1. Inside Macintosh

According to Petitioner, Inside Macintosh, Volume VI, was published in 1991 and publicly available at least as early as December 1991. Pet. 14–15 (citing Ex. 1005⁴ ¶ 43). In its Preliminary Response, Patent Owner does not challenge Inside Macintosh as prior art. For purposes of this decision, we assume without deciding that Inside Macintosh is prior art.

Inside Macintosh describes “the system software version 7.0 environment, new managers available with version 7.0, new routines and data structures, new user interface guidelines, and how to take advantage of the version 7.0 environment.” Ex. 1002, P–3. Inside Macintosh provides the following description:

The Macintosh Operating System lets the user have several applications open at the same time and lets the user switch between them. The Operating System also gives the user constant access to the Finder. This lets a user move among open documents and applications without having to save or quit the previous document or application. This environment also allows applications to run in the background. For example, the Finder can copy files while the user is working on another task in the foreground.

Id. at 1–4.

⁴ Ex. 1005 is a declaration of Dr. Scott Bennett, retired academic librarian, whose testimony Petitioner relies on regarding the authenticity and public accessibility of Inside Macintosh. Ex. 1005 ¶¶ 8, 36–42.

Inside Macintosh describes a Notification Manager used to inform users of significant occurrences in applications that are running in the background. *Id.* at 24–3. A description of the Notification Manager follows:

The Notification Manager provides an asynchronous notification service. It allows software running in the background (or otherwise unseen by the user) to communicate information to the user. For example, applications that manage lengthy background tasks (such as printing many documents or transferring large amounts of data to other machines) might need to inform the user that the operation is complete. These applications cannot use the standard methods of communicating with the user, such as alert or dialog boxes, because such windows might easily be obscured by the windows of other applications. Moreover, even if those windows are visible, the background application cannot be certain that the user is aware of the change. So some more reliable method must be used to manage the communication between a background application and the user, who might be awaiting the completion of the background task while running other applications in the foreground.

In the same way, relatively invisible operations such as Time Manager tasks, VBL tasks, or device drivers might need to inform the user that some previously started routine is complete or perhaps that some error has rendered further execution undesirable or impossible.

In all these cases, the communication generally needs to occur in one direction only, from the background application (or task, or driver) to the user. The Notification Manager, included in system software versions 6.0 and later, allows you to post to the user a notification, which is an audible or visible indication that your application (or other piece of software) requires the user's attention. *You post a notification by issuing a notification request to the Notification Manager, which places your request*

into a queue. When your request reaches the top of the queue, the Notification Manager posts a notification to the user.

Id. (emphasis added).

2. Discussion

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *accord In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Independent claims 1 and 12 recite “providing a notification on said user interface when said first object ceases executing by suddenly displaying a notification icon on said user interface of said computer while maintaining the representation of the first object.” Although Petitioner asserts that Inside Macintosh describes “*suddenly* displaying a notification icon on the user interface while maintaining the window of the background application (i.e., representation of the first object),” Petitioner does not explain how that is so. Pet. 35–44. For the disputed limitation, Petitioner merely directs attention to the paragraph from Inside Macintosh that is reproduced above, with the pertinent language italicized without any further meaningful explanation. *Id.* at 43.

As Patent Owner points out, once an object ceases executing, the Notification Manager places notification requests in a queue, such that

“[w]hen your request reaches the top of the queue, the Notification Manager posts a notification to the user.” Prelim. Resp. 9–10 (citing Ex. 1002, 24–3). Based on the record before us, we find that the “when” indicates that only until the request reaches the top for some unspecified amount of time will a notification be posted to the user. Petitioner does not explain, however, with supporting evidence, how Inside Macintosh’s description of a request waiting in a queue until it reaches the top of that queue before a notification is posted to a user, meets the claim language of “*suddenly* displaying a notification icon on the user interface.” Accordingly, we are not persuaded that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claims 1, 2, 4, 8, 12, 13, 15, and 19 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Inside Macintosh.⁵

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not shown a reasonable likelihood that it would prevail in showing that any of claims 1, 2, 4, 8, 12, 13, 15, and 19 of the ’974 patent are unpatentable.

IV. ORDER

For the foregoing reasons, it is

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

⁵ Because we find Petitioner has not shown a reasonable likelihood of prevailing on this challenge for the reasons discussed above, we do not reach Patent Owner’s other argument as to this challenge.

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