

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, INC.

SAP AMERICA INC.

Petitioners

v.

CLOUDING IP, LLC

Patent Owner

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Case IPR2013-000586

Case IPR2014-00306

Patent 6,738,799

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PATENT OWNER'S RESPONSE TO  
PETITIONS FOR *INTER PARTES* REVIEW OF  
U.S. PATENT NO. 6,738,799  
UNDER 35 USC §§ 316 AND 37 CFR §42.120

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## EXHIBIT LIST

- 2001 Decker, Susan, “Google, NetApp Sidestep Courts to Combat Patent Claims,” Bloomberg L.P., Oct. 13, 2013.
- 2002 Proof of Service on Google Inc., *Stec IP v. Google Inc.*, civil action no. 12-cv-00639 (D. Del.).
- 2003 Unified Patents, Inc., “Unified Patents Challenges Clouding IP Patent Seeks to Push Patent Trolls Out of Cloud Storage,” September 17, 2013.
- 2004 Inter Partes Reexamination Proceeding Control No. 95/001,045, Decision Vacating Filing Date, p. 7-8, August 25, 2008.
- 2005 Unified Patents, Inc., “The Gloves Are Off: Unified Patents Inc. Unveils Its ‘NPE Deterrent’ Strategy.”
- 2006 Excerpt from File Wrapper of U.S. Application 10/452,156.
- 2007 Excerpt from File Wrapper of U.S. Application 09/303,958.
- 2008 Brin, Sergey et al., “Copy Detection Mechanisms for Digital Documents,” ACM International Conference on Management of Data (SIGMOD 1995), May 22-25, 1995, San Jose, California.
- 2009 Declaration of Prasant Mohapatra, Ph.D.
- 2010 Curriculum Vitae of Prasant Mohapatra, Ph.D.
- 2011 Transcript of Deposition of Norman Hutchinson, Ph.D., May 2, 2014.

Pursuant to 37 C.F.R. § 42.120, the Board’s Scheduling Order of March 21, 2014, and the Order concerning Joinder with IPR2014-00306 dated May 20, 2014, Patent Owner, Clouding IP, LLC, submits the following response to the Petitions filed by Unified Patents, Inc. and SAP America Inc. Submitted concurrently herewith is Patent Owner’s Continent Motion to Amend claim 42 under 37 C.F.R. § 42.121.

## 1. Introduction

Trial was instituted with respect to Claims 1, 5-10, 12, 16-21, 23, 24, 30, 37 and 42 of U.S. Patent 6,738,799 (the “’799 Patent”) (*Ex. 1001*). At the outset, it is noted that all the Board has determined to date is that there is a “reasonable likelihood” that Petitioners will prevail as to some grounds for which Petitioners sought review, and it should be remembered that this determination was made in the absence of any rebuttal testimony provided by the Patent Owner.<sup>1</sup> The Board has not determined any claims of the ‘799 Patent to be unpatentable.

As demonstrated below, the Board should enter judgment in favor of the

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<sup>1</sup> Patent Owners are prohibited from introducing rebuttal testimony prior to institution of *inter partes* review proceedings. 37 C.F.R. § 42.107(c).

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