

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.

SAP AMERICA INC.

Petitioners

v.

CLOUDING IP, LLC

Patent Owner

Case IPR2013-000586

Case IPR2014-00306

Patent 6,738,799

PATENT OWNER'S REPLY TO PETITIONERS' OPPOSITION  
TO PATENT OWNERS' CONTINGENT MOTION TO  
AMEND U.S. PATENT NO. 6,738,799  
UNDER 35 USC § 316 AND 37 CFR § 42.121

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## TABLE OF AUTHORITIES

### CASES

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<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	2

## EXHIBIT LIST

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- 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.
- 2012 Transcript of Deposition of Norman Hutchinson, Ph.D., July 25, 2014.

## **Patentability Of Proposed Claim 47 Over *Harlan*.**

Petitioners contend that proposed claim 47 is somehow obvious in view of U.S. Patent 6,076,084 to Harlan (“*Harlan*”) when considered in combination with either *Williams* or *Balcha*. Opp. at p. 12. In making this assertion, Petitioners offer no explanation of how these combined teachings of these references would satisfy all elements of proposed claim 47, nor do they offer any reasoned explanation of why a person of ordinary skill in the art would make such a combination. While Dr. Hutchinson’s remarks that a person of ordinary skill in the art may “look to efficient techniques” for dividing blocks into subblocks, *Ex. 1018* at ¶ 14, efficient techniques are not synonymous with optimal techniques, as claimed. *Ex. 1019* at 48:21 – 49:8.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l*

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