UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION
Petitioner

v.

MACROSOLVE, INC.
Patent Owner

Case IPR2014-00140

Patent 7,822,816

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES*

REVIEW OF U.S. PATENT NO. 7,822,816

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,822,816

I.   Introduction

Macrosolve, Inc. ("Patent Owner", hereinafter), the owner of the entire interest in U.S. Patent No. 7,822,816 (the "'816 Patent" hereinafter, Ex. 1) hereby tenders its Preliminary Response to a "Petition for *Inter Partes* Review of U.S. Patent NO. 7,822,816" (Case PR20 14-00 140, the "Petition", hereinafter) which was filed by RPX Corporation (hereinafter, "Requestor" or "Petitioner") and mailed on or about November 11, 2013. As is explained in detail below, the '816 patent is currently being enforced in the Eastern District of Texas. It is believed that one or more parties that would be prohibited by statute from instituting the instant *Inter Partes Review* ("IPR") if it were brought in their own names are operating through RPX to circumvent the statute. As such, the instant Petition should be dismissed or stayed until discovery can be obtained from RPX with respect to the real party or parties in interest in this case. Further, in the alternative, Patent Owner demonstrates below that there is no reasonable likelihood that Petitioner would prevail in establishing anticipation or obviousness of any of the challenged claims.

II.   Background of the Case

Litigation Involving the Subject Patent

The Patent Owner is currently enforcing its patent in the U.S. District Court for the Eastern District of Texas. The lead case is *Macrosolve, Inc., vs. Antenna Software, Inc., et al*, NO. 6:11-cv-287 MHS-KNM. Additionally, the following cases are currently pending: *MacroSolve, Inc. v. Carlson Hotels, Inc*. (6-13-cv-00666, 9/12/2013); *MacroSolve, Inc. v. Five*

Guys Enterprises, LLC (6-13-cv-00671, 9/12/2013);*MacroSolve, Inc. v. Meetup, Inc.* (6-13-cv-00674,9/12/2013); *MacroSolve, Inc. v. Chipotle Mexican Grill, Inc.* (6-13-cv-00667,9/12/2013); *MacroSolve, Inc. v. Discover Financial Services, Inc.* (6-13-cv-00669, 9/12/2013); *MacroSolve, Inc. v. Home Box Office, Inc.* (6-13-cv-00672, 9/12/2013); *MacroSolve, Inc. v. Box, Inc.* (6-13-cv-00665, 9/12/2013); *MacroSolve, Inc. v. Dropbox, Inc.* (6-13-cv- 00670,9/12/2013); *MacroSolve, Inc. v. MediaFire, LLC* (6-13-cv-00673, 9/12/2013); *MacroSolve, Inc. v. GEICO Insurance Agency, Inc.* (6-12-cv-00074,2/17/2012); *MacroSolve, Inc. v. newegg* (6-12-cv-00046,1/30/2012); *MacroSolve, Inc. v. American Airlines, Inc.* (6-11- cv-00685,12/21/2011); *MacroSolve, Inc. v. Antenna Software, Inc.* (6-11-cv-00287,6/6/2011).

The following cases have been litigated and have all been dismissed for one reason or another: *MacroSolve, Inc. v. Comcast Corp.* (6-13-cv-00668, 9/12/2013); *MacroSolve, Inc. v. Wyndham Hotel Group, LLC* (6-13-cv-00675, 9/12/2013); *MacroSolve, Inc. v. RueLaLa, Inc.* (6-13-cv-00206,2/26/2013); *MacroSolve, Inc. v. Nordstrom, Inc.* (6-13-cv-00204,2/26/2013); *MacroSolve, Inc. v. Pandora Media, Inc.* (6-13-cv-00205, 2/26/2013); *MacroSolve, Inc. v. Staples, Inc.* (6-13-cv-00207, 2/26/2013); *MacroSolve, Inc. v. The Kroger Co.*(6-13-cv-00203, 2/25/2013); *MacroSolve, Inc. v. Gilt Groupe Holdings, Inc.* (6-13-cv-00201,2/25/2013); *MacroSolve, Inc. v. GameStop Corp.* (6-13-cv-00200, 2/25/2013); *MacroSolve, Inc. v. Kohl's Department Stores, Inc.* (6-13-cv-00202, 2/25/2013); *MacroSolve, Inc. v. Fandango, Inc.* (6-13-cv-00199,2/25/2013); *MacroSolve, Inc. v. Costco Wholesale Corp.* (6-13-cv-00198,2/25/2013); *MacroSolve, Inc. v. Super Shuttle International Corp.* (6-12-cv-00978, 12/21/2012); *MacroSolve, Inc. v. Walgreen Co.* (6-12-cv-00975,12/21/2012); *MacroSolve, Inc. v. Home Depot USA, Inc.* (6-12-cv-00976, 12/21/2012); *MacroSolve, Inc. v. CVS Pharmacy, Inc.* (6-12-cv-00980,12/21/2012); *MacroSolve, Inc. v. Skymall, Inc.* (6-12-cv-00977, 12/21/2012); *MacroSolve,*

Inc. v. Dollar Thrifty Automotive Group, Inc. (6-12-cv-00979,12/21/2012); *MacroSolve, Inc. v .Sears Holdings Management Corp.* (6-12-cv-00916, 12/4/2012); *MacroSolve, Inc. v. Bed Bath & Beyond, Inc.* (6-12-cv-00915, 12/4/2012); *MacroSolve, Inc. v. Starwood Hotels& Resorts Worldwide, Inc.* (6-12- cv-00917,12/4/2012); *MacroSolve, Inc. v. Redbox Automated Retail, LLC* (6-12-cv-00744,10/5/2012); *MacroSolve, Inc. v. American Express Co.* (6-12-cv-00743, 10/5/2012); *MacroSolve, Inc. v. Fareportal, Inc.* (6-12-cv-00416,6/26/2012); *MacroSolve, Inc. v. Target Corp.* (6-12-cv-00418, 6/26/2012); *MacroSolve, Inc. v. LQ Management LLC* (6-12-cv-00417,6/26/2012); *MacroSolve, Inc. v. Kayak Software Corp.* (6-12-cv-00388, 6/19/2012); *MacroSolve, Inc. v. Cumulus Media, Inc.* (6-12-cv-00389,6/19/2012); *MacroSolve, Inc. v. Jet Blue Airways Corp.* (6-12- cv-00387, 6/19/2012); *MacroSolve, Inc. v. JP Morgan Chase & Co.* (6-12-cv-00384,6/18/2012); *MacroSolve, Inc. v. LinkedIn Corp.* (6-12-cv-00385, 6/18/2012); *MacroSolve, Inc. v. MovieTickets.com, Inc.* (6-12-cv-00194, 3/23/2012); *MacroSolve, Inc. v. Bank of America Corp.* (6-12-cv-00193, 3/23/2012); *MacroSolve, Inc. v. AOL Inc.* (6-12-cv-00091,2/27/2012); *MacroSolve, Inc. v. Inter-Continental Hotels Corp.* (6-12-cv-00092, 2/27/2012); *MacroSolve, Inc. v .Marriott International, Inc.* (6-12-cv-00076,2/17/2012); *MacroSolve, Inc. v. Wal-Mart Stores, Inc.* (6-12-cv-00047, 1/30/2012); *MacroSolve, Inc. v. Facebook, Inc.* (6-12-cv-00044,1/30/2012); *MacroSolve, Inc. v. Hyatt Corp.* (6-12-cv-00045, 1/30/2012); *MacroSolve, Inc. v. YELP! INC.* (6-12-cv-00048, 1/30/2012); *MacroSolve, Inc. v. Hotels.com, L.P.* (6-11-cv-00690, 12/21/2011); *MacroSolve, Inc. v. Priceline.com Inc.* (6-11-cv-00691, 12/21/2011);*MacroSolve, Inc. v. Hipmunk, Inc.* (6-11-cv-00689, 12/21/2011); *MacroSolve, Inc. v. United Air Lines, Inc.* (6-11-cv-00694, 12/21/2011); *MacroSolve, Inc. v. Continental Airlines, Inc.* (6-11-cv-00687,12/21/2011); *MacroSolve, Inc. v. Avis Rent A Car System, LLC* (6-11-cv-00686,12/21/2011); *MacroSolve, Inc. v.Travelocity.com LP* (6-11-cv-

00693, 12/21/2011); *MacroSolve, Inc. v. Southwest Airlines Co.* (6-11-cv-00692, 12/21/2011); *MacroSolve, Inc. v. The Hertz Corp.* (6-11-cv-00688, 12/21/2011); *MacroSolve, Inc. v. Whoop, Inc.* (6-11-cv-00523, 10/3/2011); *MacroSolve, Inc. v. AT&T Inc.* (6-11-cv-00490, 9/15/2011); *MacroSolve, Inc. v. Canvas Solutions, Inc.* (6-11-cv-00194,4/18/2011);and *MacroSolve, Inc. v. Brazos Technology Corp.* (6-11-cv-00101,3/4/2011).

Ex Parte Reexamination

The '816 Patent is also the subject of *Ex Parte* Reexamination No. 90/012,829 filed April 3, 2013 by GEICO ("Reexamination"). A non-final Office action rejecting all claims was mailed in the reexamination on September 13, 2013. A response was filed by Patent Owner on or about November 13, 2013.

Pending Patent Application

A continuation application of the instant patent is currently pending in the U.S. Patent Office, to wit, App. No. 12/910,706. Currently, all claims in this application stand as rejected. A final rejection was mailed to Patent Owner/Applicant on or about April 9, 2013. A notice of appeal was filed on October 9, 2013.

III.   Summary of Arguments and Action Requested

The instant *IPR* should be dismissed pending receipt of discovery in the Eastern District of Texas, which discovery is intended to determine the real parties of interest associated with the filing of the instant Petition. The '816 patent has been in litigation with numerous parties for over one year and there is concern that one or more of the parties in that litigation are using the Requestor as a surrogate to bring an IPR that they would be prohibited by statute (35 U.S.C. §

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