UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.

Petitioner

v.

TLI COMMUNICATIONS LLC

Patent Owner

Case IPR2015-00283

Patent 6,038,295

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,038,295 (CLAIMS 17-24)



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CASES	
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In re Fine, 837 F.2d 1071 (Fed. Cir. 1988)	18, 31, 33
In re Wilson, 424 F.2d 1382 (CCPA 1970)	7
Unigene Labs., Inc. v. Apotex, Inc., 655 F.3d 1352 (Fed. Cir. 2011)	6
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EXHIBIT LIST

Ex. 2001 Sharp J-SH04, Wikipedia (July 7, 2014, 11:15 AM), (retrieved from: http://en.wikipedia.org/wiki/J-SH04).



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