### 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 RESPONSE TO PETITON FOR *INTER PARTES* REVIEW OF U.S. PATENT 6,038,295



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## **TABLE OF AUTHORITIES**

## **CASES**

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<i>In re Fine</i> , 837 F.2d 1071 (Fed. Cir. 1988)	17, 33, 37
In re Translogic Tech., Inc., 504 F.3d 1249 (Fed. Cir. 2007)	32
In re Wilson, 424 F.2d 1382 (CCPA 1970)	
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)	32
Unigene Labs., Inc. v. Apotex, Inc., 655 F.3d 1352 (Fed. Cir. 2011)	7



### **EXHIBIT LIST**

Ex. 2001 In re TLI Communications LLC Patent Litigation, Case No. 1:14-md-02534 (EDVA), Memorandum Opinion, Feb. 6, 2015.

Ex. 2002 Sharp J-SH04, Wikipedia (July 7, 2014, 11:15 AM), (retrieved from: http://en.wikipedia.org/wiki/J-SH04).

Ex. 2003 Deposition of Kenneth Alan Parlulski, July 28, 2015.

Ex. 2004 Excerpts from Tom Lichty, The Official America Online for Macintosh Membership Kit & Tour Guide (2d ed. 1994), pp. 1-48, 75-163, 479-492, 501-524.

Ex. 2005 Facebook, Inc. et al. v. TLI Communications, LLC, IPR2015-00778,

Decision – Institution of Inter Partes Review, Paper 17 (P.T.A.B.

Aug. 28, 2015).



Ex. 2006 Alexander Schill *et al.*, "Mobility aware Multimedia X.400 e-mail: A Sample Application Based on a Support Platform for Distributed Mobile Computing," Proceedings of IMC 96 Workshop on Information Visualization and Mobile Computing, Zentrum für graphische Datenverarbeitung (Feb. 1996).

Ex. 2007 Heiko Thimm *et al.*, "A Mail-Based Teleservice Architecture for Archiving and Retrieving Dynamically Composable Multimedia Documents," Proceedings of the Conference on Multimedia Transport and Teleservices, MMTT94 (1994).

Ex. 2008 Declaration of Prasant Mohapatra.

Ex. 2009 Prasant Mohapatra curriculum vitae.



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