

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC. & INSTAGRAM, LLC

Petitioner

v.

TLI COMMUNICATIONS LLC

Patent Owner

Case IPR2015-00778

Patent 6,038,295

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**PATENT OWNER'S PRELIMINARY RESPONSE TO  
PETITION FOR *INTER PARTES* REVIEW OF  
U.S. PATENT NO. 6,038,295**

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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>).
- Ex. 2002 *Facebook, Inc. v. TLI Communications LLC*, IPR2014-0056, DECISION Denying Institution of *Inter Partes* Review, Paper 14 (P.T.A.B. Sep. 15, 2014).
- Ex. 2003 Supplemental Expert Report of Dr. V. Thomas Rhyne Regarding the Invalidity of the Asserted Claims of U.S. Patent Nos. 6,895,557 and 7,765,482, dated September 14, 2012 (From Summit 6 Litigation).
- Ex. 2004 April 2, 2013 Trial Transcript From the Summit 6 Litigation (Direct and Cross Examination of Dr. Rhyne).
- Ex. 2005 April 3, 2013 Trial Transcript From the Summit 6 Litigation (Cross Examination of Dr. Rhyne).
- Ex. 2006 Expert Report of Dr. V. Thomas Rhyne Regarding the Invalidity of the Asserted Claims of U.S. Patent Nos. 6,895,557 and 7,765,482, dated August 1, 2012 (From Summit 6 Litigation).

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