

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. & INSTAGRAM, LLC

Petitioner

v.

TLI COMMUNICATIONS LLC

Patent Owner

Case IPR2015-00778

Patent 6,038,295

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

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	OVERVIEW OF U.S. PATENT 6,038,295	2
III.	CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.104(B)(3).....	5
	A. THE CLASSIFICATION INFORMATION RECITED IN CLAIM 17 IS PRESCRIBABLE BY A USER, IS FOR ALLOCATION TO THE DIGITAL IMAGES, AND CHARACTERIZES THE DIGITAL IMAGES.....	5
	B. THE “TELEPHONE UNIT” INCLUDES A TELEPHONE, AND CLAIM 17 STATES THAT A DIGITAL PICK UP UNIT IS “IN” THE TELEPHONE UNIT.	6
	C. THE “DIGITAL PICK UP UNIT” OPERATES AS A DIGITAL PHOTO CAMERA.	11
IV.	ARGUMENT	12
	A. PETITIONER’S PROPOSED COMBINATION OF REFERENCES FAILS TO SUGGEST A “DIGITAL PICK UP UNIT IN A TELEPHONE UNIT,” AS REQUIRED BY CLAIM 17.	13
	B. PETITIONER’S PROPOSED COMBINATION OF REFERENCES FAILS TO SUGGEST CLASSIFICATION INFORMATION ALLOCATED TO DIGITAL IMAGES, AS REQUIRED BY THE CLAIMS.	23
	C. PETITIONER’S OWN ARGUMENTS DEMONSTRATE THAT CLAIMS 21 AND 22 ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES.	30
V.	CONCLUSION	33

TABLE OF AUTHORITIES

CASES

<i>Alza Corp. v. Mylan Labs., Inc.</i> , 464 F.3d 1286 (Fed. Cir. 2006)	28
<i>CFMT, Inc. v. Yieldup Int’l. Corp.</i> , 349 F.3d 1333 (Fed. Cir. 2003)	28
<i>Hartness Int’l. Inc. v. Simplimatic Engineering Co.</i> , 819 F.2d 1100 (Fed. Cir. 1987)	29
<i>In re Abbott Diabetes Care Inc.</i> , 696 F.3d 1142 (Fed. Cir. 2012)	19, 22
<i>In re Fine</i> , 837 F.2d 1071 (Fed. Cir. 1988)	22
<i>In re Skvorecz</i> , 580 F.3d 1262 (Fed. Cir. 2009)	21
<i>In re Wilson</i> , 424 F.2d 1382 (CCPA 1970).....	28
<i>Unigene Labs., Inc. v. Apotex, Inc.</i> , 655 F.3d 1352 (Fed. Cir. 2011)	28

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).

Ex. 2007 Transcript of Deposition of David Klausner Oct. 28, 2015.

Ex. 2008 Prosecution history of US Pat. 6,038,295.

Ex. 2009 Declaration of Prasant Mohapatra.

Ex. 2010 Curriculum Vitae of Prasant Mohapatra.

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