UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owners

IPR2017-00220
PATENT 7,535,890

PATENT OWNER PRELIMINARY RESPONSE TO PETITION PURSUANT TO 37 C.F.R. § 42.107(a)

Tables of Contents

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc Luxembourg S.A. ("Patent Owner") submits this Preliminary Response to the Petition for *Inter Partes* Review ("the Petition" or "the '220 Petition") of U.S. Patent No. 7,535,890 ("the '890 Patent") filed by Apple, Inc. ("Petitioner"). The Board should deny the Petition in its entirety because of procedural and substantive defects.

Petitioner follows the same impermissible strategy in challenging the '890 Patent that it uses in each one of the six concurrently-filed petitions (IPR2017-00220 through IPR2017-00225), which collectively challenge a total of sixty-five (65) claims of four related patents. Petitioner consistently presents at least a pair of redundant obviousness theories for every challenged claim. As an apparent afterthought, Petitioner then offers an illusory justification that is applicable, if at all, to only a mere fraction of those redundant challenges.

The present '220 Petition, for example, primarily relies on the *Vuori* reference (Ex. 1005), while the co-pending petition (IPR2017-00221[1]) redundantly challenges the same claims and relies, instead, primarily on *Malik* (Ex. 1007). Petitioner's alleged justification for its redundancy, at best, applies to only three of the twenty-nine claims redundantly challenged in both the '220 and '221 Petitions. Because

[1] *Apple Inc. v. Uniloc Luxembourg S.A.*, No. IPR2017-00221, Petition for *Inter Partes Review* (P.T.A.B. Nov. 14, 2016), Paper 2 ("the '221 Petition").

Petitioner at least tacitly concedes that the present '220 Petition is substantively stronger than the co-pending '221 Petition for the vast majority of claims, it is anticipated that the Board will find the redundant challenges based on *Malik* are not entitled to consideration.

Another disturbing pattern of the six related petitions is that Petitioner does not bother to provide even one claim chart for any of the redundant obviousness theories asserted against sixty-five (65) patent claims in total. To make matters worse, each petition primarily relies on ambiguous and unexplained citations to the art, without providing an accompanying explanation or argument as to why the reference(s) render(s) obvious the limitation in question. *Cf. In Fontaine Engineered Prods., Inc. v. Raildecks*, (2009), Inc., No. IPR2013-00360 (P.T.A.B. Dec. 13, 2013), Paper 9 (denying a petition for IPR brought on obviousness grounds because the petitioner's claim charts only cited to disclosure of the alleged invalidating reference without any accompanying explanation or argument as to why the reference discloses or teaches the recited element).

The declaration attached to each of the six petitions is of no moment because it simply parrots back the same citations and the same unexplained and conclusory statements presented in the corresponding petition. *Cf. In Kinetic Technologies, Inc. v. Skyworks Solutions, Inc.*, No. IPR2014-00529 (P.T.A.B. Sept. 23, 2014), Paper 8 (denying the petition because the expert's declaration did not provide any facts or

data to support the underlying opinion of obviousness, but rather was substantially identical to the conclusory arguments of the petition).

In addition to the procedural defects identified herein, Patent Owner further identifies two overarching substantive defects. First, Petitioner overlooks various claim limitations, including those involving a packet-switched network(s), and thus fails to "specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4). Second, Petitioner applies impermissible hindsight reasoning in a futile attempt to consolidate disparate and expressly-distinguished teachings of *Vuori*, the primary asserted reference.

In view of the reasons presented herein, the Petition should be denied in its entirety as failing to meet the threshold burden of proving there is a reasonable likelihood that at least one challenged claim is unpatentable.[2]

II. BACKGROUND OF THE '890 PATENT

A. Priority and Patent Family of the '890 Patent

The '890 Patent is titled "SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING." Ex. 1001 at [54]. The '890 Patent issued from U.S. Patent

[2] Should the Board institute proceedings in this matter, Patent Owner does not concede the legitimacy of any arguments in the Petition that are not specifically addressed herein. Patent Owner expressly reserves the right to rebut any such arguments in its Patent Owner Response.

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