UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, LLC,

Petitioner,

v.

UNILOC USA, INC. AND UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-00221
U.S. Patent 7,535,890

DECLARATION OF WILLIAM C EASTTOM II

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

I. INTRODUCTION 1

II. BACKGROUND AND QUALIFICATIONS 2

III. LEGAL STANARDS USED IN MY ANALYSIS 2

A. Obviousness 3

B. Priority Date 4

C. Person of Ordinary Skill in the Art 4

D. Broadest Reasonable Interpretation 6

IV. OVERVIEW OF THE ’890 PATENT 6

V. CLAIM CONSTRUCTION 10

A. “local network” and “external network” 10

B. “recipient” 12

VI. VALIDITY ANALYSIS 13

A. No obviousness for a “local network” and a distinct “external network” arranged as claimed (independent Claims 14, 28, 51, and 62) 13

1. Malik uses a homogenous network design in both Figures 2 and 3 15

2. Malik disparages Figure 2 as “prior art” lacking certain capabilities of Figure 3 16

3. Väänänen does not supply the missing elements 19

4. Additional Structural Distinctions of Claim 28 20

B. No obviousness for “the client selecting one or more recipients” (independent Claims 1, 14, 28, 40, 51, and 62, dependent Claims 15 and 29) 21

1. Malik teaches away from the proposed modifications 22

2. Malik does not “suggest” the sending-user’s client selecting recipient devices for instant voice messages 24

C. No obviousness for “transmitting the selected recipients” (independent Claims 1, 14, 28, 40, 51, and 62, dependent Claims 15 and 29) 26

VII. CONCLUSION 27

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

I, Chuck Easttom, hereby declare as follows:

I. INTRODUCTION

1. My name is William Charles Easttom II (Chuck Easttom) and I have been retained by Uniloc, USA, Inc., and Uniloc Luxembourg S.A. ("Uniloc" or the "Patent Owner") to provide my expert opinions regarding U.S. Patent No. 7,535,890 (the "'890 patent"). In particular, I have been asked to opine on whether claims 1, 2, 3,4, 5, 6, 14, 15,17, 18, 19, 20, 28, 29, 31, 33, 34, 40, 42, 43, 51, 52, 53, 54, 62, 63, 64, 65 and 68 (the "challenged claims") of the '890 patent would have been obvious to a person of ordinary skill in the art (POSA) at the time the inventions described in the '890 patent were conceived. Based on my review of the prior art then available, my understanding of the relevant of the relevant requirements of patent law, and my decades of experience in the field of computer science including communications systems, it is my opinion that the challenged claims would not have been obvious in light of the references cited in the Petition. I note that in addition to the Petition and its accompanying exhibits, in formulating my opinions I further considered the Deposition Transcript of Dr. Leonard Forys (filed as Ex. 2002).

2. I am being compensated for my time at my standard consulting rate of $300 per hour. I am also being reimbursed for expenses that I incur

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

during the course of this work. Apart from that, I have no financial interest in Uniloc. My compensation is not contingent upon the results of my study or the substance of my opinions.

II. BACKGROUND AND QUALIFICATIONS

3. In my 25 years of computer industry experience I have had extensive experience in communications systems, including data networks in general that have messaging capabilities. I hold 40 industry certifications, which include (among others) extensive certifications in server-based communication systems. I have authored 20 computer science books, several of which deal with communications topics including messaging. I also am named inventor on seven patents.

4. A more detailed description of my professional qualifications, including a list of publications, teaching, and professional activities, is contained in my curriculum vitae, a copy of which is attached hereto as Appendix A.

III. LEGAL STANARDS USED IN MY ANALYSIS

5. Although I am not an attorney and I do not offer any legal opinions in this proceeding, I have been informed of and relied on certain legal principles in reaching the opinions set forth in this Declaration.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

A. Obviousness

6. I understand that a patent claim is invalid if the differences between the subject matter and the prior art are such that the subject matter as a whole would have been obvious to a POSA at the time of the alleged invention. I further understand that an obviousness analysis involves a review of the scope and content of the asserted prior art, the differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art, and objective indicia of non-obviousness such as long-felt need, industry praise for the invention, and skepticism of others in the field.

7. I have been informed that if a single limitation of a claim is absent from the cited prior art, the claim cannot be considered obvious.

8. I have further been informed that it is improper to combine references where the references teach away from a proposed combination; and that the following factors are among those relevant in considering whether prior art teaches away:

- whether a POSA, upon reading the reference would be led in a direction divergent from the path that was taken by the applicant;
- whether the prior art criticizes, discredits, or otherwise discourages investigation into the claimed invention;

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.