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

IPR2017-00222
PATENT 8,243,723

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

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1. No prima facie case for "associating a sub-set of the nodes with a client" 31

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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") of U.S. Patent No. 8,243,723 ("the '723 Patent") filed by Apple, Inc. ("Petitioner").

Petitioner follows the same impermissible strategy in challenging the '723 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 Board has long held that redundant grounds are not entitled to consideration unless the petitioner provides a sufficient bi-directional explanation of the relative strengths ***and*** weaknesses of the redundant grounds. In the present Petition, Grounds 1-3 rely on *Vuori* (Ex. 1005) as the primary reference, while Grounds 4-5 redundantly challenge the same claims but rely, instead, primarily on *Stubbs* (Ex. 1022).

As explained further below, the Board should deny Grounds 4-5 as horizontally redundant with Grounds 1-3, and thus not entitled to consideration, for

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at least two overarching reasons: (1) Petitioner identifies *Vuori* as having a relative strength, but no relative weakness, with respect to the limitations recited in the challenged independent claims; and (2) Petitioner undercuts the alleged strength of *Stubbs* by suggesting that both *Vuori* and *Stubbs* provide a sufficient description of the general structure and functionality of a packet-switched network. Accordingly, at a minimum, the Board should deny Grounds 4 and 5 (based primarily on *Stubbs*) as horizontally redundant with Grounds 1-3 (based primarily on *Vuori*).

Another disturbing pattern of the six related petitions is that Petitioner does not provide even one explanatory 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

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