

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

---

IPR2017-00223  
PATENT 8,724,622

---

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

Tables of Contents

<b>I.</b>	<b>INTRODUCTION</b>	<b>1</b>
<b>II.</b>	<b>BACKGROUND OF THE '622 PATENT</b>	<b>3</b>
	A. Priority of the '622 Patent through its Patent Family	3
	B. Overview of the '622 Patent	4
<b>III.</b>	<b>TWO CUMULATIVE AND REDUNDANT PETITIONS</b>	<b>8</b>
	A. The Redundant Challenges Are Not Entitled to Consideration	8
	1. The '223 and '224 Petitions Are Horizontally Redundant	9
	2. Petitioner Compounds Its Error with Vertical Redundancies	14
	B. Petitioner's Abusive Pattern of Redundancy is Improper	17
	C. Petitioner Repeatedly Presents Vacuous Grounds	18
<b>IV.</b>	<b>NO REASONABLE LIKELIHOOD THAT AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE</b>	<b>19</b>
	A. Claim Construction	20
	B. The Proposed Vuori-SMSS Combination Does Not Render Independent Claim 3 Obvious	24
	1. Overview of Applicable Law	24
	2. No prima facie case for "a messaging system communicating with a plurality of instant voice message client systems via the network interface [connected to the packet switched network]"	25
	3. No prima facie case for "the instant voice message [received from one of the plurality of instant voice message client systems] includes an object field including a digitized audio file"	29
	4. Grounds 2 and 3 Only Challenge Claims Which Depend From Nonobvious Independent Claim 3	34
	C. Vuori Does Not Render Independent Claim 38 Obvious	34
	1. No prima facie case for "a network interface coupled to the client device and connecting the client device to a packet-switched network"	35
	2. No prima facie case for "a messaging system for transmitting the instant voice message over the packet-switched network via the network interface [coupled to the client device]"	37

## 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 '223 Petition”) of U.S. Patent No. 8,724,622 (“the '622 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 '622 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 each redundancy. The present '223 Petition relies on *Vuori* (Ex. 1005) as the primary reference, while the co-pending '224 Petition<sup>1</sup> redundantly challenging the same claims relies, instead, on *Dahod* (Ex.

---

<sup>1</sup> *Apple Inc. v. Uniloc Luxembourg S.A.*, No. IPR2017-00224, Petition for *Inter Partes* Review (P.T.A.B. Nov. 14, 2016), Paper No. 2 (“the '224 Petition”).

1009). Petitioner fails to articulate any substantive strength of *Vuori* over *Dahod* based on their respective disclosures and, consequently, the present '223 Petition (primarily based on *Vuori*) should be rejected as impermissibly redundant.

Once the Board resolves the acknowledged redundancy issue, the Board should then exercise its discretion under 35 U.S.C. § 325(d) to reject the co-pending '224 Petition (based on *Dahod*) as failing to present any new, non-cumulative evidence over what was already considered by the Examiner during prosecution. Petitioner does even not attempt to defend against application of § 325(d). Rather, Petitioner overtly asks the Board to second-guess the Examiner's findings on the alleged basis that "the Examiner apparently did not understand" the *Dahod* reference, though the Examiner admittedly had primarily considered and relied upon that reference throughout prosecution. The present facts clearly invoke § 325(d).

Because of the fully dispositive procedural issues, the Board need not and should not reach the substantive merits of either the '223 or '224 Petitions. Nevertheless, Patent Owner identifies herein example instances where the present '223 Petition overlooks various claim limitations 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).<sup>2</sup>

---

<sup>2</sup> 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

## II. BACKGROUND OF THE '622 PATENT

### A. Priority of the '622 Patent through its Patent Family

The '622 Patent is titled “SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING.” Ex. 1001. The '622 Patent issued from U.S. Patent Application No. 13/546,673, which is a continuation of U.S. Patent No. 8,243,723, which is a continuation of U.S. Patent No. 7,535,890, filed on Dec. 18, 2003. The '622 Patent issued on May 13, 2014.

Below is a picture of the family tree for the four patents Petitioner challenges in a series of five consecutively filed petitions (IPR2017-00220 through IPR2017-00225).

---

arguments in its Patent Owner Response.

# 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.