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

IPR2017-00224
PATENT 8,724,622

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

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

Tables of Contents

I. INTRODUCTION 1

II. BACKGROUND OF THE '622 PATENT 3

A. Priority of the '622 Patent through its Patent Family 3

B. Overview of the '622 Patent 4

III. CUMULATIVE AND REDUNDANT CHALLENGES 8

A. Dahod is Cumulative Under 35 U.S.C. § 325(d) 8

B. The Redundant Challenges Are Not Entitled to Consideration 13

1. The Two Petitions Are Horizontally Redundant 14

2. The Petition Contains Many Vertically Redundant Theories 18

C. Petitioner's Abusive Pattern of Redundancy is Improper 21

IV. CLAIM CONSTRUCTION 22

V. CONCLUSION 26

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

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 '224 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 '224 Petition relies on *Dahod* (Ex. 1009), while the co-pending '223 Petition[1] challenging the same claims relies, instead, on *Vuori* (Ex. 1005). While Petitioner identifies certain

[1] *Apple Inc. v. Uniloc Luxembourg S.A.*, No. IPR2017-00223, Petition for *Inter Partes Review* (P.T.A.B. Nov. 14, 2016), Paper No. 2 ("the '223 Petition").

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

substantive strengths of *Dahod* over *Vouri*, Petitioner fails to articulate any relative weakness of *Dahod* based on their respective disclosures. Consequently, the co-pending '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 present '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 admittedly 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). *See Baker Hughes Oilfield Operations, Inc.* v. *Smith International, Inc.*, No. IPR2016-01450 (P.T.A.B. Dec. 22, 2016), Paper 10 at 10-11 (finding the reliance on references previously presented to the Office was not entitled to consideration due to "the failure of Petitioner to address the impact of § 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 below example substantive deficiencies to

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

further illustrate the futility of the present '224 Petition.[2]

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 six consecutively filed petitions (IPR2017-00220 through IPR2017-00225).

[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.

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.