

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

IPR2017-00225
PATENT 8,995,433

**PATENT OWNER RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. § 42.120**

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PATENT OWNER’S EXHIBIT LIST

Ex. 2001 Declaration of Chuck Easttom in support of Patent Owner Response (“EX2001”).

Ex. 2002 Deposition Transcript of Leonard Forys (“EX2002”).

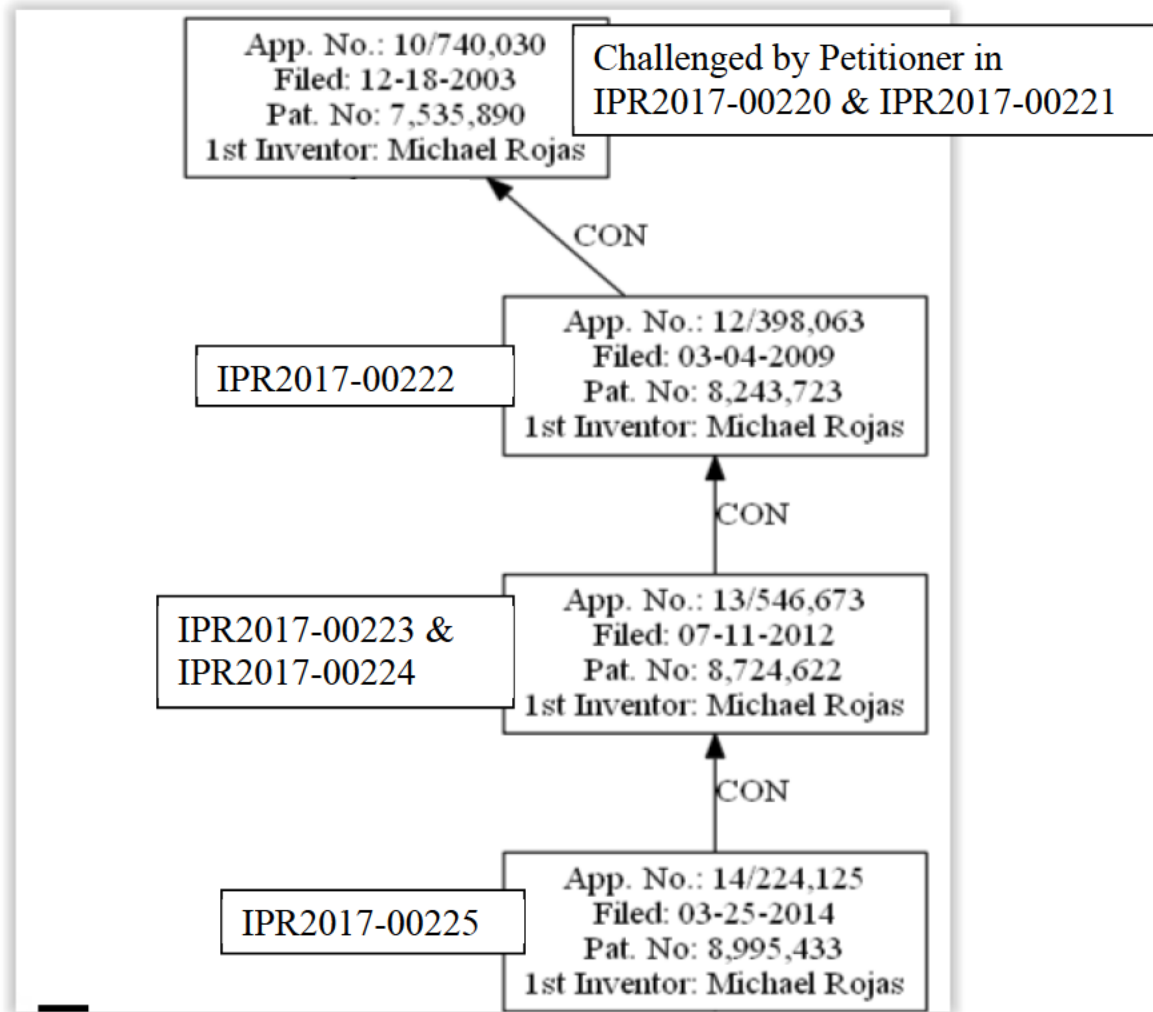
I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc Luxembourg S.A. (“Patent Owner”) submits this Response to the Petition for *Inter Partes* Review (“the Petition”) of U.S. Patent No. 8,995,433 (“the '433 Patent”) filed by Apple, Inc. (“Petitioner”). For the reasons set forth herein, the Petition 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).

II. RELATED MATTERS

As the Board has already recognized, the '433 Patent is the subject of litigation before the U.S. District Court for the Eastern District of Texas, including an action filed against Petitioner (Case No. 2-16-cv-00638).

The '433 Patent is part of a chain of continuation applications, as shown in the family tree below, which also identifies six related petitions filed by Petitioner against this patent family.



III. THE '433 PATENT

A. Priority of the '433 Patent through its Patent Family

The '433 Patent is titled “SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING.” Ex. 1001. The '433 Patent issued from U.S. Patent Application No. 14/244,125, which is a continuation of U.S. Patent No. 8,724,622, 8,243,723, which is a continuation of U.S. Patent No. 7,535,890, filed on Dec. 18, 2003. The '433 Patent issued on March 31, 2015.

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