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

TABLE OF CONTENTS

PATENT OWNER'S EXHIBIT LIST

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

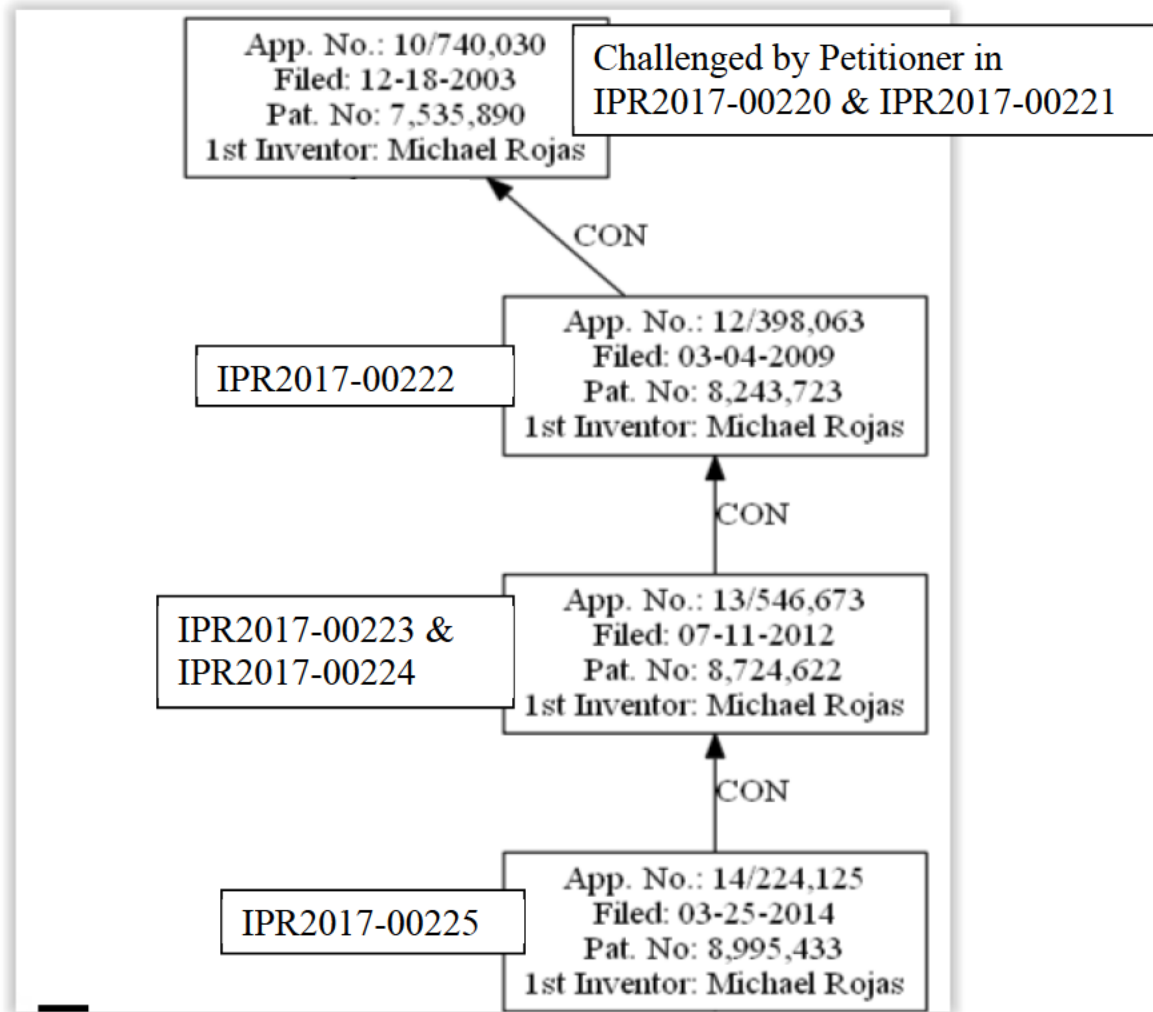Ex. 2002 Deposition Transcript of Leonard Forys ("EX2002").

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.

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.

fastcase®
Smarter legal research.