

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC.,
Petitioner

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner

IPR2017-01257
PATENT 8,199,747

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

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List of Exhibits

Exhibit No.	Description
2001	Declaration of Dr. Val DiEuliis
2002	Excerpts from <u>The American Heritage Dictionary</u> (Houghton Mifflin Co. 3rd Ed. 1992)

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) submit this Preliminary Response to the Petition for *Inter Partes* Review (“Petition” or “Pet.”) of U.S. Patent No. 8,199,747 (“the ’747 Patent”) filed by FACEBOOK, INC. and WHATSAPP INC. (“Petitioner”).

In view of the reasons presented herein, the Petition should be denied in its entirety as failing to meet the threshold burden of proving there is a reasonable likelihood that at least one challenged claim is unpatentable. As a general overview, the Petition asserts a single-reference obviousness challenge against three of the five challenged claims; and the Petition adds an additional reference in a proposed combination for two other challenged claims. The Petition fails to satisfy the All Elements Rule for both the single-reference challenges and the combination challenges. Petitioner impermissibly attempts to fill in missing limitations, at least in part, by offering claim interpretations that are expressly proscribed by the unambiguous claim language. There are also several reasons why the references cannot and should not be combined as suggested by the Petition. The Petition’s approaches invite reversible error and should be rejected outright.

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