

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC. AND SQUARE ENIX, INC.,
Petitioner

v.

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

IPR2017-01291
PATENT 6,728,766

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

Tables of Contents

I.	INTRODUCTION	1
II.	THE '766 PATENT	2
A.	Effective Filing Date	2
B.	Overview of the '766 Patent	2
III.	THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD THAT AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE	4
A.	Claim Construction	4
1.	“means for maintaining license management policy information for a plurality of application programs at a license management server, the license management policy information including at least one of a user identity based policy, an administrator policy override definition or a user policy override definition” (Claim 7)	5
2.	“means for receiving at the license management server a request for a license availability of a selected one of a plurality of application programs from a user at a client” (Claim 7)	6
3.	“means for determining the license availability for the selected one of the plurality of application programs for the user based on the maintained license management policy information” (Claim 7)	9
4.	“means for providing an unavailability indication to the client responsive to the selection if the license availability indicates that a license is not available for the user or an availability indication if the licensed availability indicates that a license is available for the user” (Claim 7)	10
B.	No Prima Facie Anticipation for “receiving at the license management server a request for a license availability of a	

selected one of the plurality of application programs from a user at a client”	11
C. No Prima Facie Anticipation for “determining the license availability for the selected one of the plurality of application programs for the user based on the maintained license”	15
D. Additional Deficiencies in the Means-Plus-Function Analysis	19
E. No Prima Facie Anticipation for the Dependent Claims	21
V. CONCLUSION	21

Table of Exhibits for Patent Owner Preliminary Response

<u>Exhibit</u>	<u>Description</u>
Ex. 2001	Declaration of Dr. Val DiEuliis
Ex. 2002	<i>Ubisoft, Inc. et al. v. Uniloc USA, Inc. et al.</i> , Case No. 2:16-cv-00393-RWS (lead case), Petitioner’s Responsive Claim Construction Brief, Dkt. No. 150.

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”) of U.S. Patent No. 6,728,766 (“the '766 Patent”) filed by Ubisoft, Inc. and Square Enix, Inc. (“Petitioner”).

The Petition is facially deficient for several reasons. The Petition contains little more than quotations of the challenged claim language, followed by unexplained citations to the only cited reference (EX1001), thereby impermissibly expecting the Board and the Patent Owner to only guess as to how the quoted disclosure allegedly anticipates the claim language in question. Even worse, the Petition provides no expert declaration in support of the conclusory attorney arguments contained therein. Consequently, the opinions on dispositive issues in the attached declaration of Dr. Val DiEuliis (EX2001) are uncontroverted.

The Petition also relies on claim construction positions Petitioner has since repudiated in unequivocal statements made before the district court in co-pending litigation involving the same parties. To be clear, Petitioner’s contradictory claim construction arguments made in court cannot be rescued by invoking the Broadest Reasonable Interpretation (“BRI”) standard applied before the Board. The applicable claim construction standards converge on the specific claim construction issues injected by the Petition, as explained further below.

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.

II. THE '766 PATENT

A. Effective Filing Date

The '766 Patent is titled “Methods, Systems and Computer Program Products for Distribution of Application Programs to a Target Station on a Network.” EX1001 at [54]. The '766 issued from U.S. Patent Application No. 09/829,854, which is a divisional of U.S. Patent Application No. 09/211,529 (now U.S. Patent No. 6,324,578). EX1001 at [62]. Thus, the effective filing date for the '766 Patent is December 14, 1998, which is the filing date of its parent application. The '766 Patent issued on April 27, 2004 and was originally assigned to the International Business Machines Corporation (“IBM”). EX1001 at [73].

B. Overview of the '766 Patent

The '766 Patent relates to managing license-compliant use of application programs within a heterogeneous computer network environment. EX1001, 1:21-23; 3:24-36; 5:37-6:9. Preferred embodiments centralize license management for authorized users, who may access application programs from various client stations across the managed network over time, to ensure compliance with certain license restrictions. License policy information is centrally maintained (*e.g.*, at a central

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.