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

Table of Exhibits for Patent Owner Preliminary Response

Exhibit	Description
Ex. 2001	Declaration of Dr. Val DiEuliis
Ex. 2002	*Ubisoft, Inc. et al. v. Uniloc USA, Inc. et al.*, 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

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