

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC. AND SQUARE ENIX, INC.,
Petitioners

v.

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

IPR2017-01291
PATENT 6,728,766

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

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I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.120, Uniloc Luxembourg S.A. (“Patent Owner”) submits this 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 provides no support of the conclusory statements contained therein. The Petition contains little more than quotations of the challenged claim language, followed by unexplained citations to the only cited reference, thereby leaving the Board and the Patent Owner to guess as to how the quoted disclosure allegedly anticipates the claim language in question. The dangers of the improper and prejudicial guesswork of Petitioner is revealed at least twice in the Board’s Institution Decision (IPR2017-01291, Paper No. 9). First, in instituting trial on Claims 1 and 3 of the ’766 Patent, the Board confirmed that a client device sends *Olsen*’s request, yet the Board made a “preliminary inference” that the request *might* be “from a user” as required by the claim language. And second, the Institution Decision improperly puts the burden on Patent Owner to show that *Olsen* specifically excludes the request for “license availability” and not just a request for a license as required by the claim language.

In the first instance, the record shows, as the Board confirms, that the request sent in *Olsen* is by the client device itself, and there is no contrary argument in the

Petition other than a single conclusory sentence. The Board’s “preliminary inference” that the request might, instead, be “from a user” is not supported by the reference and is refuted by Petitioner’s own admissions. To the extent the Board’s “preliminary inference” is based on the doctrine of inherency (an argument not advanced in the Petition), inherent anticipation is improper and inapplicable here, where the Petition does not even argue, much less attempt to prove, that the “preliminary inference” is *necessarily present*, as opposed to merely possible or probable.

In the second instance, the burden is on Petitioner to prove *Olsen* anticipates the “license availability” limitation. The Petition has not and cannot meet this burden simply by overlooking the relevant claim language. Nevertheless, the Institution Decision states that it is the Board’s opinion that the Patent Owner has failed to show that the Petition may not show anticipation by deviating from the express claim language. There can be no question, particularly in view of recent controlling authority, that the burden to prove unpatentability always rests with the Petition. Moreover, the intrinsic evidence and express claim language differentiates a user’s “license availability” from merely a client device requesting a license.

In view of the reasons presented herein, Patent Owner respectfully submits that the Petition fails to meet its burden to prove unpatentability. Consequently, all challenges against the ’766 patent should be dismissed.

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 server) so that “the entire process [can] be controlled from a single point for an entire managed network environment.” *Id.* In certain embodiments, a server may determine license availability and provide application programs on-demand to an authorized

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