

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC., WHATSAPP INC.,  
Petitioner

v.

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

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IPR2017-01365  
PATENT 8,243,723

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

Table of Contents

I.	INTRODUCTION	1
II.	THE '723 PATENT	1
	A. Effective Filing Date of the '723 Patent	1
	B. Overview of the '723 Patent	2
III.	RELATED MATTERS	4
IV.	NO REASONABLE LIKELIHOOD THAT AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE	4
	A. Claim Construction	5
	1. "Signal"	6
	2. "Node"	7
	B. Independent Claim 1 is Not Obvious Over Zydney in View of Appelman	9
	a. No prima facie obviousness for "associating a sub-set of the nodes with a client" and "transmitting a signal to a client including a list of the recorded connectivity status for each of the nodes in the sub-set corresponding to the client"	10
	2. No prima facie obviousness for "transmitting a signal to a client"	13
	3. The Petition's asserted combination of Zydney and Appelman would render Zydney unsatisfactory for an intended purpose explicitly stated in Zydney	15
	C. Claim 2 is Not Obvious	18
	1. Zydney does not disclose or suggest "wherein the instant voice message includes one or more files attached to an audio file"	19

2.	Zydney teaches away from “wherein the instant voice message includes one or more files attached to an audio file”	20
D.	Claim 3 is Not Obvious	21
V.	CONCLUSION	23

List of Exhibits

<b>Exhibit No.</b>	<b>Description</b>
<b>2001</b>	Declaration of Dr. Val DiEuliis
<b>2002</b>	Excerpts from <u>The American Heritage Dictionary</u> (Houghton Mifflin Co. 3rd Ed. 1992)
<b>2003</b>	Excerpts from <u>McGraw-Hill Dictionary of Scientific and Technical Terms</u> (McGraw-Hill, Inc. 5th ed. 1994)

## 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 (“the Petition” or “Pet.”) of U.S. Patent No. 8,243,723 (“the ’723 Patent”) filed by FACEBOOK, INC. and WHATSAPP INC. (“Petitioner”).

In view of the reasons presented herein, the Board should deny the Petition in its entirety for failing to show a reasonable likelihood that at least one challenged claim is unpatentable. As a general overview, the Petition asserts a dual-reference obviousness challenge against three challenged claims. These challenges fail to satisfy the All Elements Rule. 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 the Petition suggests. The Petition’s approaches invite reversible error and should be rejected outright.

## II. THE ’723 PATENT

### A. Effective Filing Date of the ’723 Patent

The ’723 Patent is titled “SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING.” EX1001. The ’723 Patent issued from U.S. Patent Application No.

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