

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 Owner

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Case IPR2017-01428  
PATENT 8,995,433

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

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List of Exhibits

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                                                                                       |
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| <b>2001</b>        | Declaration of Dr. Val DiEuliis                                                                                                                                                                                                                                                                                                                                                          |
| <b>2002</b>        | “‘App’ voted 2010 word of the year by the American Dialect Society (UPDATED)”, American Dialect Society (Jan. 8, 2011), available at <a href="http://www.americandialect.org/app-voted-2010-word-of-the-year-by-the-american-dialect-society-updated">http://www.americandialect.org/app-voted-2010-word-of-the-year-by-the-american-dialect-society-updated</a> (printed Aug. 23, 2017) |

## 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. (the “Patent Owner”) submit this Owner’s Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,995,433 B2 (“the ’433 Patent” or “EX1101”) filed by Facebook, Inc. and WhatsApp Inc. (“Petitioner”).

In the Petition,<sup>1</sup> Petitioner argues that Claims 9–12, 14–17, 25, and 26 of the ’433 Patent would have been obvious. Claim 9 is the sole claim in independent format; all other claims challenged in the Petition depend from Claim 9 directly or indirectly.

Specifically, Petitioner asserts a non-enabling, never issued patent application, *Zydney* (EX1103), against all ten claims. As Ground 1, Petitioner argues that Claims 9, 12, 14, 17, 25, and 26 would have been obvious over *Zydney* alone. As Ground 2, Petitioner argues that Claims 11, 15, and 16 would have been obvious over *Zydney* in view of a passage from the *Greenlaw* textbook (EX1110). As Ground 3, Petitioner argues that Claim 10 would have been obvious over *Zydney* in view of a definition from the *Newton* dictionary (EX1106).

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<sup>1</sup> Petitioner also filed a Petition in IPR2017-1427, challenging Claims 1–8 of the ’433 Patent. Except for two and a half pages that describe the *Greenlaw* and *Newton* secondary references, the first approximately 31 pages of the two petitions are substantially the same.

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