UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner

v.

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

IPR2017-00221
PATENT 7,535,890

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

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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" or "the '221 Petition") of U.S. Patent No. 7,535,890 ("the '890 Patent") filed by Apple, Inc. ("Petitioner"). The Board should deny the Petition in its entirety because of procedural and substantive defects.

Petitioner follows the same impermissible strategy in challenging the '890 Patent that it uses in each one of the six concurrently-filed petitions (IPR2017-00220 through IPR2017-00225), which collectively challenge a total of sixty-five (65) claims of four related patents. Petitioner consistently presents at least a pair of redundant obviousness theories for every challenged claim. As an apparent afterthought, Petitioner then offers an illusory justification that is applicable, if at all, to only a mere fraction of those redundant challenges.

The present '221 Petition differs from a co-pending petition (IPR2017-00220[1]) only in that the present '221 Petition relies primarily on the *Malik* reference (Ex. 1007) (even though *Malik* appears on the face of the '890 Patent as a reference cited by the Examiner during prosecution). The '220 Petition challenges the same claims and relies, instead, primarily on *Vuori* (Ex. 1005). Petitioner's alleged justification

[1] *Apple Inc. v. Uniloc Luxembourg S.A.*, No. IPR2017-00220, Petition for *Inter Partes Review* (P.T.A.B. Nov. 14, 2016), Paper 2 ("the '220 Petition").

for filing two redundant petitions, at best, applies to only three of the twenty-nine claims redundantly challenged in each petition. Because Petitioner at least tacitly concedes that the co-pending '220 Petition is substantively stronger than the present '221 Petition for the vast majority of claims, it is anticipated that the Board will find the redundant challenges in the present '221 Petition based on *Malik* are not entitled to consideration.

Another disturbing pattern of the six related petitions is that Petitioner does not provide even one explanatory claim chart for any of the redundant obviousness theories asserted against sixty-five (65) patent claims in total. To make matters worse, each petition primarily relies on ambiguous and unexplained citations to the art, without providing an accompanying explanation or argument as to why the reference(s) render(s) obvious the limitation in question. *Cf. In Fontaine Engineered Prods., Inc. v. Raildecks*, (2009), Inc., No. IPR2013-00360 (P.T.A.B. Dec. 13, 2013), Paper 9 (denying a petition for IPR brought on obviousness grounds because the petitioner's claim charts only cited to disclosure of the alleged invalidating reference without any accompanying explanation or argument as to why the reference discloses or teaches the recited element).

The declaration attached to each of the six petitions is of no moment because it simply parrots back the same citations and the same unexplained and conclusory statements presented in the corresponding petition. *Cf. In Kinetic Technologies, Inc.*

v. Skyworks Solutions, Inc., No. IPR2014-00529 (P.T.A.B. Sept. 23, 2014), Paper 8 (denying the petition because the expert's declaration did not provide any facts or data to support the underlying opinion of obviousness, but rather was substantially identical to the conclusory arguments of the petition).

In addition to the procedural defects identified herein, Petitioner fails to articulate a cognizable obviousness theory for various claim limitations, including those involving recipient selection and a packet-switched network(s). The Petition, therefore, fails "specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4). In view of the procedural and substantive defects identified 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.[2]

II. BACKGROUND OF THE '890 PATENT

A. Prosecution History of the '890 Patent

The '890 Patent is titled "SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING." Ex. 1001 at [54]. The '890 Patent issued from U.S. Patent Application No. 10/740,030, which has a filing date of December 18, 2003. The

[2] Should the Board institute proceedings in this matter, Patent Owner does not concede the legitimacy of any arguments in the Petition that are not specifically addressed herein. Patent Owner expressly reserves the right to rebut any such arguments in its Patent Owner Response.

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