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

IPR2017-00225
PATENT 8,995,433

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

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Tables of Contents

I. **INTRODUCTION** **1**

II. **BACKGROUND OF THE '433 PATENT** **3**

A. Priority of the '433 Patent through its Patent Family 3

B. Overview of the '433 Patent 4

III. **THE PETITION PRESENTS UNJUSTIFIED REDUNDANCIES** **8**

A. The Redundant Challenges Are Not Entitled to Consideration 8

1. Petitioner Presents a Pair of Horizontally Redundant Grounds Against Each Challenged Claim 9

2. Petitioner Also Presents Vertically Redundant Theories 12

B. Väänänen is Cumulative with the Prosecution Record 15

C. Petitioner's Abusive Pattern of Redundancy is Improper 17

IV. **NO REASONABLE LIKELIHOOD THAT AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE** **19**

A. Claim Construction 20

1. "displays at least one of the plurality of instant voice messages" 20

2. "the instant voice messaging application includes a message database storing the instant voice message" 21

B. Overview of Applicable Law 23

C. No Prima Facie Obviousness for Grounds 1 through 3 25

1. No prima facie case for "the instant voice messaging application includes a message database storing the instant voice message" 25

2. No Motivation to Combine Abburi with Holtzberg 28

3. Grounds 1, 2, and 3 Fail to Present a Prima Facie Case of Obviousness for Even One Challenged Claim 30

D. Grounds 4 and 5 Present Redundant and Cumulative Challenges 30

1. Two Independent and Fully Dispositive Procedural Defects 30

2. No prima facie case for "the instant voice messaging application includes a message database storing the instant voice message" 31

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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") of U.S. Patent No. 8,995,433 ("the '433 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 '433 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 Board has long held that redundant grounds are not entitled to consideration unless the petitioner provides a sufficient bi-directional explanation of the relative strengths ***and*** weaknesses of each redundant ground. In the present Petition, Grounds 1-3 rely on *Abburi* (Ex. 1005) as the primary reference, while Grounds 4-5 redundantly challenge the same claims but rely, instead, primarily on *Väänänen* (Ex. 1006).

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At least with respect to independent Claim 1, Petitioner makes no attempt to articulate any substantive strength of *Väänänen* over *Abburi* based on their respective disclosures; and Petitioner offers only an illusory justification for its redundant challenge against independent Claim 6 (the only other independent claim challenged in the Petition). Moreover, the cited *Väänänen* reference is cumulative with what the Examiner had expressly considered during prosecution of this patent family. Accordingly, the Board should find Grounds 4 and 5 are impermissibly redundant and cumulative and thus not entitled to consideration.

Notwithstanding the redundancies in the Petition, and because the Board has yet to decide which grounds it intends to dismiss as impermissibly redundant, Patent Owner identifies herein example instances where each ground of the Petition overlooks various claim limitations and thus fails to "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). For the reasons disclosed 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.[1]

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[1] 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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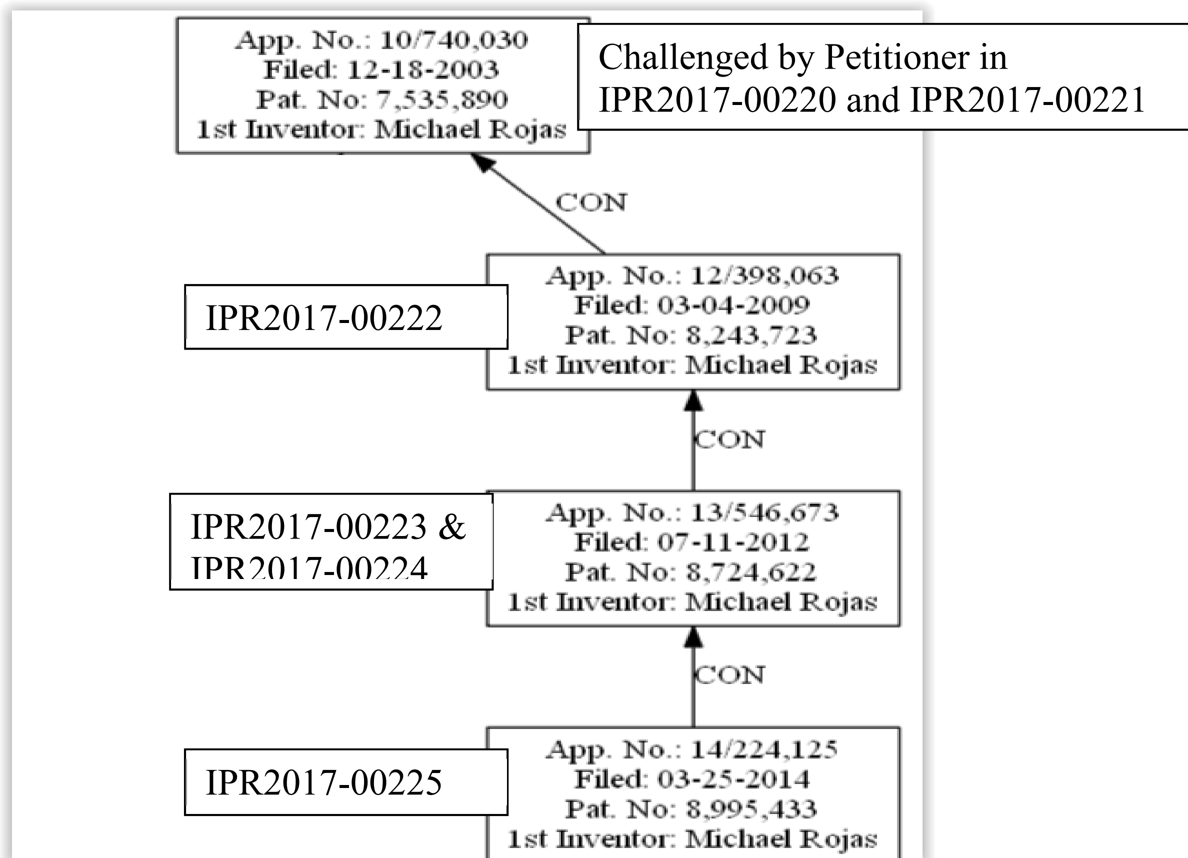
II. BACKGROUND OF THE '433 PATENT

A. Priority of the '433 Patent through its Patent Family

The '433 Patent is titled "SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING." Ex. 1001. The '433 Patent issued from U.S. Patent Application No. 14/244,125, which is a continuation of U.S. Patent No. 8,724,622, 8,243,723, which is a continuation of U.S. Patent No. 7,535,890, filed on Dec. 18, 2003. The '433 Patent issued on March 31, 2015.

Below is a picture of the family tree for the four patents Petitioner challenges in a series of six consecutively filed petitions (IPR2017-00220 through IPR2017-00225).



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