

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

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IPR2017-1797

PATENT 8,724,622

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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>
<b>2001</b>	Declaration of William C. Easttom II
<b>2002</b>	U.S. Pat. No. 7,372,826 ( <i>Dahod</i> )
<b>2003</b>	U.S. Pat. App. Pub. No 2004/0128356 ( <i>Bernstein</i> )
<b>2004</b>	Invalidity Contentions Submitted on December 16, 2016 in the underlying consolidated case of <i>Uniloc USA, Inc. v. Samsung Electronic America’s, Inc.</i> , Case No. 2:16-cv-642

## I. INTRODUCTION

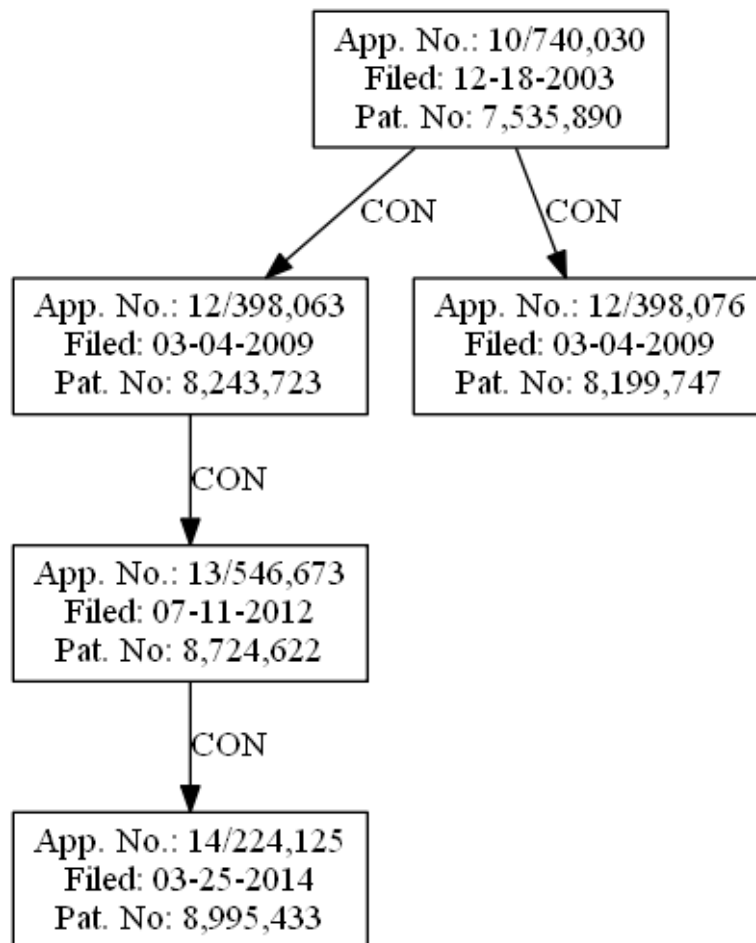
Uniloc Luxembourg S.A. (the “Patent Owner”) submits this Owner’s Preliminary Response to Petition IPR2017-1797 for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,724,622 B2, System and Method for Instant VoIP Messaging, (“the ’622 Patent” or “EX1001”) filed by Samsung Electronics America, Inc. (“Petitioner”).

Petitioner argues that Claims 3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34–35, 38–39 would have been rendered obvious to a person having ordinary skill in the art (a “PHOSITA”) in 2003 in view of a user interface patent, U.S. Pat. No. 8,150,922 to Chris Michael *Griffin* et al. (“*Griffin*,” EX1005) and International Pat. App. Pub. No. WO 01/11824 A2 to Herbert *Zydney* et al. (“*Zydney*,” EX1006).

The Board should deny IPR2017-1797 in its entirety. First, the petition, references, and grounds stated, are duplicative and redundant over IPR2017-1667. Second, Petitioner fails to satisfy the All Elements Rule. Instead, 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. The user interface patent to *Griffin* does not describe or enable instant voice messaging. In addition, the references cannot and should not be combined as the Petition suggests.

## II. RELATED MATTERS

The '622 Patent is in a family of patents including United States Patent Nos. 7,535,890 (“the '890 Patent”); 8,243,723 (“the '723 Patent”); 8,199,747 (“the '747 Patent”); and 8,995,433 (“the '433 Patent”).<sup>1</sup> The diagram below how this family of patents is interrelated.



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<sup>1</sup> All five related patents derive from United States Patent Application No. 10/740,030 and are referred to collectively as members of the '622 Patent's “family.”

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