

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

IPR2017-01799

PATENT 8,199,747

PATENT OWNER RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. § 42.120

Table of Contents

I.	INTRODUCTION	1
II.	RELATED MATTERS	1
III.	THE '747 PATENT	2
	A. Effective Filing Date of the '747 Patent	2
	B. Overview of the '747 Patent	3
IV.	PERSON OF ORDINARY SKILL IN THE ART	4
V.	PROCEDURAL BACKGROUND	5
VI.	CLAIM CONSTRUCTION	5
VII.	THE PETITION FAILS TO PROVE CLAIM 2 IS OBVIOUS	8
	A. <i>Griffin</i> admittedly fails to disclose “the list of nodes including a connectivity status of each node, said connectivity status being available and unavailable”	9
	B. <i>Zydney</i> does not cure <i>Griffin</i> 's admitted deficiencies concerning “the list of nodes including a connectivity status of each node, said connectivity status being available and unavailable ...”	14
	C. No proof that <i>Griffin</i> can be modified to map onto “nodes within the packet-switched network”	19
VIII.	DEPENDENT CLAIM 12 IS NOT OBVIOUS	22
IX.	THE BOARD PREVIOUSLY FOUND THE PETITION FAILS TO ESTABLISH OBVIOUSNESS OF CLAIMS 1, 3, AND 13	22
	A. The Board correctly found the challenge of claim 1 is deficient	22
	B. The Board correctly found the challenge of claim 3 is deficient	26
X.	THE PROPOSED MODIFICATION OF <i>GRIFFIN</i> DOES NOT DISCLOSE THE ALLEGEDLY REQUIRED “REAL-TIME” ASPECT OF THE CLAIMED “INSTANT VOICE MESSAGE”	30
XI.	CONCLUSION	33

List of Exhibits

Exhibit No.	Description
2001	Declaration of William C. Easttom II
2002	U.S. Pat. App. Pub. No. 2004/0128356 (“ <i>Bernstein</i> ”)
2003	Excerpts from <u>The American Heritage Dictionary</u> (Houghton Mifflin Co. 3rd Ed. 1992)
2004	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
2007	Deposition Transcript of Dr. Haas ¹
2008	Dr. Haas’ tabbed and annotated copy of his declaration submitted as Ex. 1001 in IPR2017-01799 ²

¹ As of the filing date of this Response, and due to the fact that Dr. Haas was offered for deposition only one week before the due date for the filing of this Response, a non-certified copy of the deposition transcript has been filed as Exhibit 2007. Pursuant to agreement between the parties, entered into during a conference call with the Board, Exhibit 2007 will be updated with a certified copy as soon as one becomes available.

² A certified copy of Exhibit 2008 has not yet been made available as of the filing date of this Response. Patent Owner will update the record with a copy of Exhibit 2008 as soon as it is made available.

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.120, Uniloc Luxembourg S.A. (the “Patent Owner”) submits this Patent Owner’s Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,199,747 B2 (“the ‘747 patent” or “EX1001”) filed by Samsung Electronics America, Inc. (“Petitioner”) in IPR2017-01799.

The Petition challenges claims 1–3, 12, and 13 of the ’747 patent under 35 U.S.C. § 103 over *Griffin* (EX1005) in view of *Zydney* (EX1006). The Petition should be denied in its entirety as failing to prove obviousness. In this matter and in related matters, the Board has already considered arguments presented in the Petition and found them insufficient to prove unpatentability.

II. RELATED MATTERS

In related matter IPR2017-01800, the Board noted in its original Institution Decision the importance of “maintain[ing] consistency across proceedings” and further noted “we are guided here by our analysis in the concurrently filed Decision on Institution concerning Case IPR2017-01799, concerning U.S. Patent No. 8,199,747, which is related to the ’723 patent and includes” challenged claims that recite certain limitations analogous to those at issue here. *See* IPR2017-01800, Paper 8 at 22. As will be shown, the Board’s findings in related matters IPR2017-01257 and IPR2017-02085 are also particularly instructive here and further confirm the Petition should be denied in its entirety.³

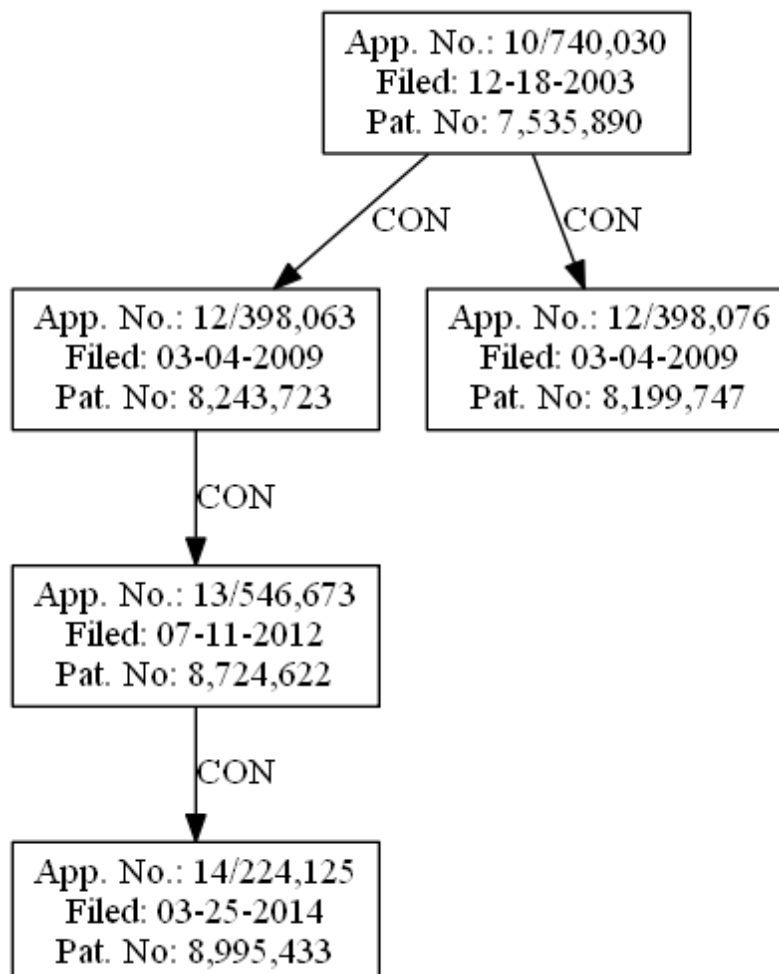
³ The Petition appears to provide a comprehensive list of *inter partes* review proceedings concerning this family of patents.

III. THE '747 PATENT

Effective Filing Date of the '747 Patent

The '747 patent is titled "System and Method for Instant VoIP Messaging." The '747 patent issued June 12, 2012 from United States Patent Application No. 12/398,076, which is a Continuation of Application No. 10/740,030, filed on Dec. 18, 2003, now Pat. No. 7,535,890.

The '747 patent is in a family of patents including United States Patent Nos. 7,535,890 ("the '890 Patent"); 8,243,723 ("the '723 Patent"); 8,724,622 ("the '622 Patent"); and 8,995,433 ("the '433 Patent"). The diagram below shows how this family of patents is interrelated.



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.