

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

IPR2017-1799

PATENT 8,199,747

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

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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

I. INTRODUCTION

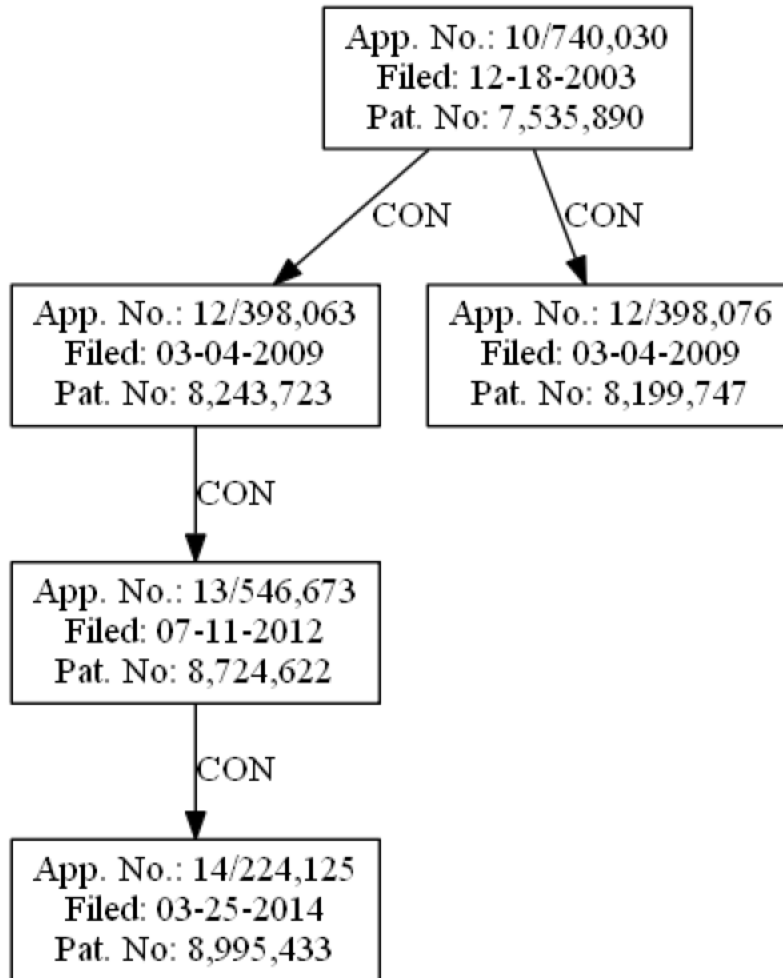
Pursuant to 35 U.S.C. §313 and 37 C.F.R. §42.107(a), Uniloc USA, Inc. and Uniloc Luxembourg S.A. (the “Patent Owner”) submit this Patent Owner’s Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,199,747 B2 (“the ’747 Patent” or “Ex. 1001”) filed by Samsung Electronics America, Inc. (“Petitioner”) in IPR2017-1799.

In view of the reasons presented 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. First, the Petition should be denied as redundant in view of various other IPR challenges that have been filed against the ’747 Patent and other patents in its family, several of which rely on the same references as the instant Petition. Second, Petitioner fails to satisfy the All Elements Rule for each of the five challenged claims. Third, while Petitioner asserts a two-reference obviousness challenge for the five challenged claims, the two references cannot and should not be combined as suggested by the Petition. Petitioner’s approaches invite reversible error and should be rejected outright.

II. RELATED MATTERS

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”).¹ The diagram below how this family of patents is interrelated.



Petitioner has initiated six of the thirty-six IPRs initiated against these five patents, as highlighted below. Eighteen IPR petitions initiated against these five patents predate Petitioner’s six filings.

Petitioner	IPR#	Date	Patent
Apple	IPR2017-0220	14-Nov-16	'890
Apple	IPR2017-0221	14-Nov-16	'890
Apple	IPR2017-0222	14-Nov-16	'723

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