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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IPR2017-01800

PATENT 8,243,723

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PATENT OWNER RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. §42.120

Table of Contents

List of Exhibits

Exhibit No.	Description
2001	Declaration of William C. Easttom II
2002	Invalidity Contentions Submitted on December 16, 2016 in the underlying consolidated case of *Uniloc USA, Inc. v. Samsung Electronic America's, Inc.*, Case No. 2:16-cv-642
2003	Excerpts from the *American Heritage Dictionary of the English Language* (Third Edition, 1992)
2004	Excerpts from the Merriam Webster's Collegiate Dictionary (10th Ed.) (1997)
2005	File History: Notice of Allowance for Application Leading to the '723 Patent.
2006	U.S. Pat. App. Pub. No 2004/0128356 ("*Bernstein*")
2007	Deposition Transcript of Dr. Haas[1]
2008	Dr. Haas' tabbed and annotated copy of his declaration submitted as Ex. 1001 in IPR2017-01800[2]
2009	Supplemental Declaration of William C. Easttom II

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[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. 8,243,723 ("the '723 Patent" or "EX1001") filed by Samsung Electronics America, Inc. ("Petitioner") in IPR2017-01800.

The Petition challenges claims 1–3 of the '723 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

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. Paper 8 at 22. As will be shown, the Board's findings in related matters IPR2017-01257 and IPR2017-01365 are also particularly instructive here and further confirm the Petition should be denied in its entirety.[3]

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

III.   THE '723 PATENT

A.   Effective Filing Date of the '723 Patent

The '723 Patent is titled "System and Method for Instant VoIP Messaging." The '723 Patent issued August 14, 2012 from United States Patent Application No. 12/398,063, which is a Continuation of Application No. 10/740,030, filed on Dec. 18, 2003, now Pat. No. 7,535,890.

The '723 Patent is in a family of patents including United States Patent Nos. 8,199,747 (the '747 Patent); 7,535,890 (the '890 Patent); 8,724,622 (the '622 Patent); and 8,995,433 (the '433 Patent). The diagram below charts how this family of patents is interrelated.

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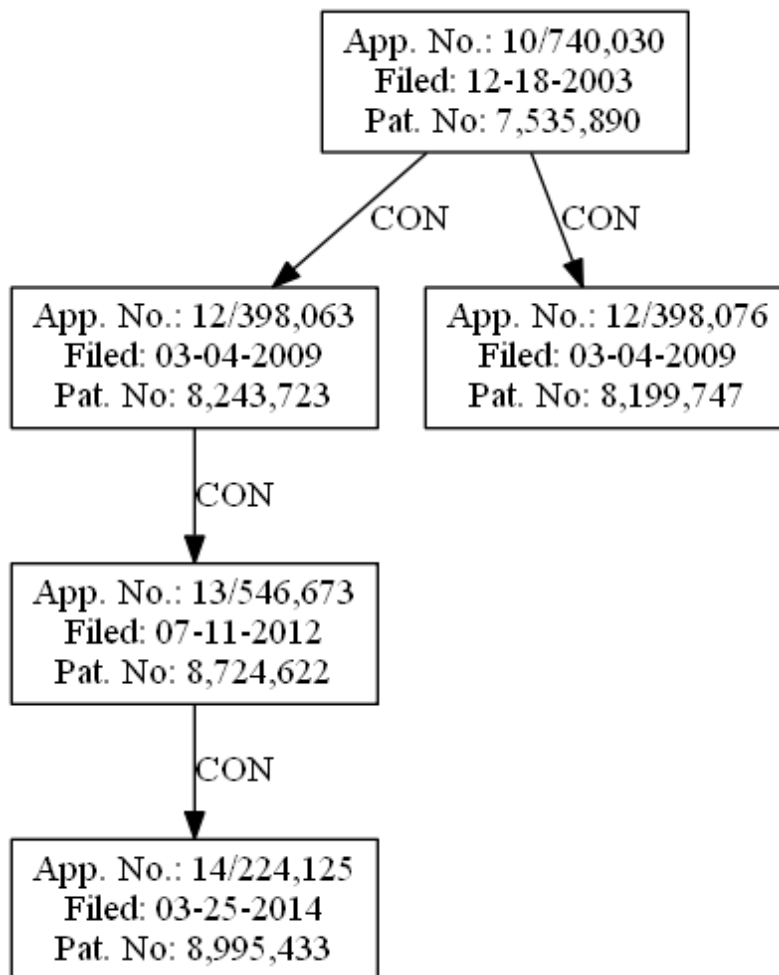
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