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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IPR2017-1800

PATENT 8,243,723

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

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## 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*") |

# I. INTRODUCTION

Uniloc Luxembourg S.A. (the "Patent Owner") submits this Owner's Preliminary Response to Petition IPR2017-1800 for *Inter Partes* Review ("Pet. at \_" or "Petition") of United States Patent No. 8,243,723 B2, System and Method for Instant VoIP Messaging, ("the '723 Patent" or "EX1001") filed by Samsung Electronics America, Inc. ("Petitioner").

Petitioner argues that Claims 1–3 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 to *Griffin*, EX1005, and an application for patent to *Zydney*, EX1006.

The Board should deny IPR2017-1800 in its entirety. First, the petition, references, and grounds stated, are duplicative and redundant over IPR2017-1365. 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 instant voice messaging or packet-switched networks. In addition, the references cannot and should not be combined as the Petitioner suggests.

# II. RELATED MATTERS

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).[1] The diagram below how this family of

patents is interrelated.



```
                    ┌─────────────────────────┐
                    │  App. No.: 10/740,030   │
                    │  Filed: 12-18-2003      │
                    │  Pat. No: 7,535,890     │
                    └─────────────────────────┘
                      CON               CON
          ┌─────────────────────────┐  ┌─────────────────────────┐
          │  App. No.: 12/398,063   │  │  App. No.: 12/398,076   │
          │  Filed: 03-04-2009      │  │  Filed: 03-04-2009      │
          │  Pat. No: 8,243,723     │  │  Pat. No: 8,199,747     │
          └─────────────────────────┘  └─────────────────────────┘
                      CON
          ┌─────────────────────────┐
          │  App. No.: 13/546,673   │
          │  Filed: 07-11-2012      │
          │  Pat. No: 8,724,622     │
          └─────────────────────────┘
                      CON
          ┌─────────────────────────┐
          │  App. No.: 14/224,125   │
          │  Filed: 03-25-2014      │
          │  Pat. No: 8,995,433     │
          └─────────────────────────┘
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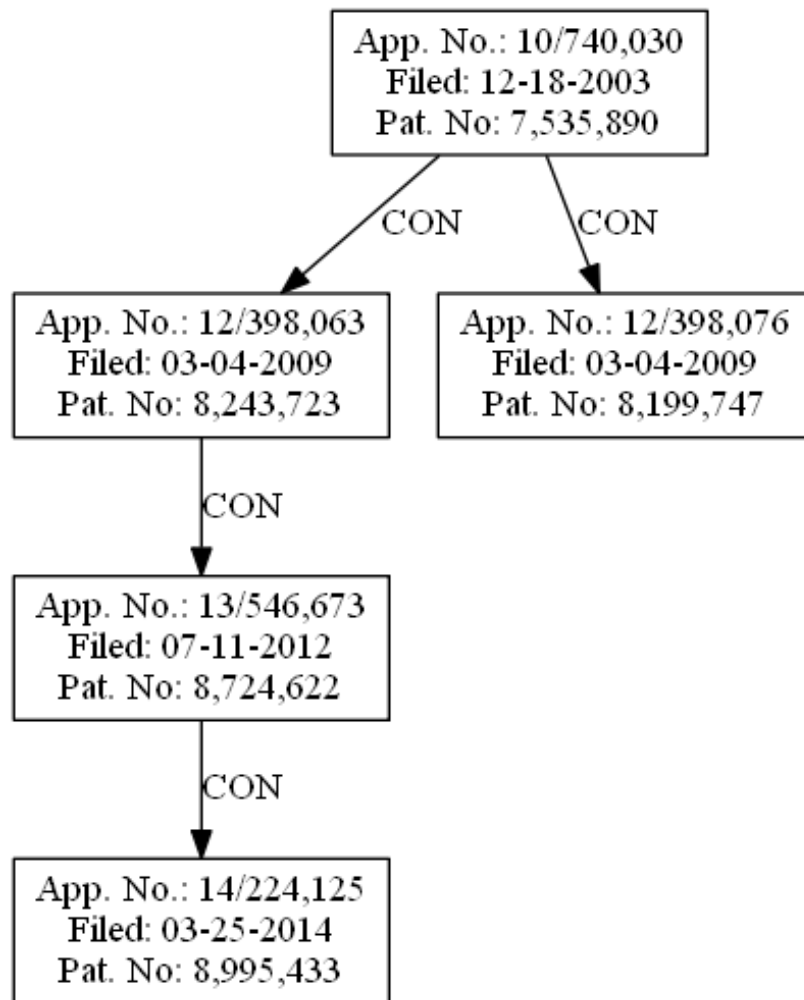
[1] All five related patents derive from United States Patent Application No. 10/740,030 and are referred to collectively as members of the '723 Patent's "family."

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