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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IPR2017-1801

PATENT 8,995,433

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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	U.S. Pat. App. Pub. No. 2004/0128356 ("*Bernstein*")

II.   INTRODUCTION

Patent Owner, Uniloc Luxembourg S.A., submits this Owner's Response to Petitioner Samsung Electronics America, Inc.'s Petition for *Inter Partes* Review ("Petition" or "Pet. at _") of United States Patent No. 8,995,433 B2 ("the '433 Patent" or "EX1001") challenging Claims 1-5, 7-12, 14-17, 25, and 26 for obviousness.

The Petition should be denied in its entirety. Petitioner fails to meet its burden of proving that even one challenged claim is unpatentable. Specifically, the Petition fails to satisfy the All Elements Rule and also fails to show that even one challenged claim would have been obvious in view of the asserted references when the claimed subject matter is taken as a whole at the time the application was filed.
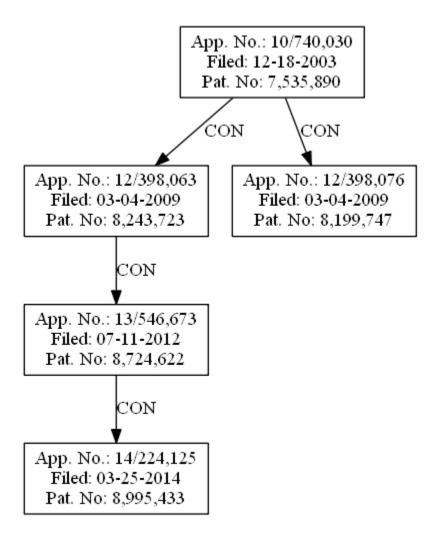
III. THE '433 PATENT DESCRIBES INSTANT VOICE MESSAGING OVER A PACKET-SWITCHED NETWORK.

A. Effective Filing Date of the '433 Patent

The '433 Patent is in a family of patents including United States Patent Nos.

8,199,747 (the '747 Patent); 7,535,890 (the '890 Patent); 8,243,723 (the '723

Patent); and 8,724,622 (the '622 Patent). The diagram below charts how this

family of patents is interrelated.

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            ┌─────────────────────────────┐
            │  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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The '433 Patent is titled "System and Method for Instant VoIP Messaging."

The '433 Patent issued March 31, 2015 from United States Patent Application

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