

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

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**List of Exhibits**

Exhibit No.	Description
<b>2001</b>	Declaration of William C. Easttom II
<b>2002</b>	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
<b>2003</b>	U.S. Pat. App. Pub. No. 2004/0128356 (“ <i>Bernstein</i> ”)

## I. INTRODUCTION

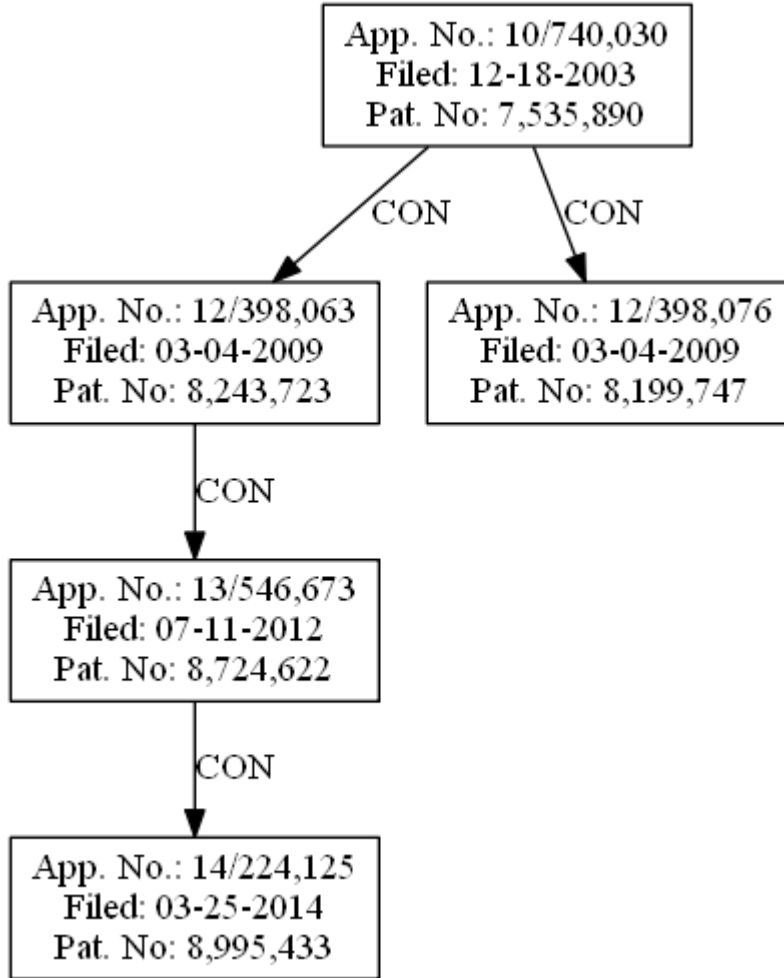
Patent Owner, Uniloc Luxembourg S.A., submits this Owner's Preliminary Response to Petitioner Samsung Electronics America, Inc.'s Petition for *Inter Partes* Review ("Petition" or "Pet. at \_") of United States Patent No. 8,995,433 B2 ("the '433 Patent" or "EX1001") challenging Claims 1-5, 7-12, 14-17,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

The Petition should be denied in its entirety. First, the Petition relies on grounds that should be denied review providentially because they are horizontally or vertically redundant over grounds already before the Board in other Petitions. Second, Petitioner fails to meet its threshold burden of proving that there is a reasonable likelihood 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.

## II. RELATED MATTERS

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).<sup>1</sup> 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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