UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBISOFT, INC.,

Petitioner

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,

Patent Owners

IPR2017-01828

PATENT 6,489,974

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

Tables of Contents

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc Luxembourg S.A. ("Patent Owner") submits this Preliminary Response to the Petition for *Inter Partes* Review ("the Petition") of U.S. Patent No. 6,489,974 ("the '974 patent") filed by Ubisoft, Inc. ("Petitioner"). Petitioner fails to establish *prima facie* anticipation under pre-AIA §102(b) by *Inside Macintosh, Volume VI* ("*Inside Macintosh*") (EX1002) of any challenged claim. Significantly, while Petitioner has the burden here, the Petition offers no expert testimony in support of the conclusory factual statements contained therein.

II. THE '974 PATENT

The '974 patent is titled "Buoy Icon Notification of Object Interface Accessibility in Multitasking Computer Environment." Ex. 1001 at [54]. The '974 Patent issued from U.S. Patent Application No. 08/586,149, which is a continuation of U.S. Patent Application No. 08/179,479. Ex. 1001 at [63]. Thus, the effective filing date for the '974 patent is Jan. 10, 1994, *well over two decades ago*. Petitioner appears to agree. Pet. at 2 (identifying the "time of the alleged invention" as January 10, 1994). The '974 patent issued on December 3, 2003 and was originally assigned to the International Business Machines Corporation ("IBM"). Ex. 1001 at [45], [73].

The Petition challenges two independent claims (1 and 12) of the '974 patent, which recite similar limitations but are drafted in different forms (method and means-plus-function, respectively). For the convenience of the Board, claim 12 is copied below:

12. An apparatus for use with a multitasking computer, said computer comprising first and second objects, said apparatus providing notification of a status of said first object on said computer, comprising:

a) means for providing a representation of said first object on a user interface of said computer, with the representation supporting user interaction with said first object on said user interface of said computer;

b) means for executing said first object on said computer;

c) means for enabling said second object so as to support user interaction with said second object on a user interface of said computer while said first object is executing;

d) means for determining when said first object ceases executing while said second object is enabled so as to support user interaction;

e) means for providing a notification on said user interface when said first object ceases executing by suddenly displaying a notification icon on said user interface of said computer while maintaining the representation of the first object, said notification icon being in a location that is separate from the representation of said first object on said user interface.

III. PERSON OF ORDINARY SKILL IN THE ART

The Petition offers no expert testimony in support of its definition for a person of ordinary skill in the art, which Petitioner defines as someone who "would have had at least a bachelor's degree, or equivalent, in electrical engineering, computer engineering, computer science, or a related field or an equivalent number of years of working experience, and one to two years of experience in computer programming."

It is unclear whether Petitioner had intended the requirement of "one to two years of experience in computer programming" to be in addition to "the equivalent number of years of working experience," such that a person of ordinary skill in the art would need to have no less than *six to seven years* of working experience (assuming a bachelor's degree in the fields identified could have been obtained in four to five years). This seems a bit excessive on its face; and Petitioner provides no explanation for why six to seven years of work experience, in addition to a bachelor's degree, would have been necessary. Evidently, Petitioner found the patented technology to be highly technical, which is curious given that Petitioner provides no expert testimony in support of its conclusory allegations.

IV. RELATED MATTERS

The Petition fails to provide at least the required mandatory notices concerning related matters, pursuant to 37 C.F.R. § 42.8(b)(2) and 35 U.S.C. § 312(a)(4). The Board has previously held that "[t]he Petition's failure to comply with 37 C.F.R. § 42.8(b)(2), and thus also 35 U.S.C. § 312(a)(4), could be grounds for denial of the Petition." *See Apple, Inc. v. ContentGuard Holdings, Inc.*, IPR2015-00356, Paper No. 9 (P.T.A.B. June 26, 2015) (Decision Denying Institution of *Inter Partes* Review) (citations omitted). In its decision denying institution, the Board offered the following explanation:

> A petition for an *inter partes* review "may be considered only if," among other things, 'the petition provides such other information as the Director may require by regulation." 35 U.S.C. § 312(a)(4). In that regard, the Director requires a petitioner to include certain

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