

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner

v.

UNILOC LUXEMBOURG, S.A.  
Patent Owner

---

IPR2017-1993  
PATENT 9,414,199

---

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

**Table of Contents**

<b>I.</b>	<b>INTRODUCTION</b>	<b>1</b>
<b>II.</b>	<b>THE '199 PATENT</b>	<b>1</b>
	A. Effective Filing Date of the '199 Patent	1
	B. Overview of the '199 Patent	2
<b>V.</b>	<b>THE PETITION FAILS TO PROVE OBVIOUSNESS</b>	<b>3</b>
	A. Claim Construction	4
	1. “predetermined likelihood”	4
	2. “within the predetermined maximum amount of time”	6
	B. No <i>prima facie</i> obviousness for “predicting whether the user device will be at any one or more predetermined locations within the predetermined maximum amount of time with at least the predetermined likelihood”	14
	1. <i>Blegen</i> is deficient	15
	2. <i>Monteverde’s</i> so-called “offer period” is deficient	17
	3. <i>Charlebois</i> is deficient	19
	4. <i>Gillies</i> does not cure <i>Charlebois’s</i> conceded deficiencies	23
	5. Patent Owner offers no substantive response to <i>Froloff</i>	27
	C. No <i>Prima Facie</i> Obviousness for Dependent Claims 2–5	28
<b>VIII.</b>	<b>CONCLUSION</b>	<b>29</b>

## I. INTRODUCTION

Pursuant to 37 C.F.R. §42.120, Uniloc USA, Inc. and Uniloc Luxembourg S.A. (the “Patent Owner” or “Uniloc”) submit Uniloc’s Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 9,414,199 (“the ’199 patent” or “EX1001”) filed by Apple Inc. (“Petitioner”) in IPR2017-1993.

The Petition should be denied because it applies an erroneous claim construction and fails to satisfy the All Elements Rule. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317 n.1 (Fed. Cir. 1998) (holding every element and limitation must be met by a component in the qualifying reference); *Mentor Graphics Corp., v. Synopsys, Inc.*, IPR2014-00287, 2015 WL 3637569, (Paper 31) at \*11 (P.T.A.B. June 11, 2015), *aff’d sub nom. Synopsys, Inc. v. Mentor Graphics Corp.*, 669 Fed. Appx. 569 (Fed. Cir. 2016) (denying Petition as tainted by reliance on an incorrect claim construction).

## II. THE ’199 PATENT

### A. Effective Filing Date of the ’199 Patent

The ’199 patent is titled “Predictive Delivery of Information Based on Device History.” The ’199 patent issued on August 9, 2016 from United States Patent Application No. 14/188,063, which claims priority under 35 U.S.C. § 119 to provisional Application No. 61/774,305, filed on March 7, 2013. The Petition does not dispute the effective filing date of the ’199 patent is March 7, 2013.

## **B. Overview of the '199 Patent**

The '199 Patent discloses various embodiments for location-based services and methods for delivery of information to a user device based a variety of factors including, for example, the present location of the device and the location history of the device. *See, e.g.*, EX1002 (Prosecution History), pp. 20, 48–49.<sup>1</sup> In certain preferred embodiments, a server gathers locational information from a user device over time to collect location histories of the device and to periodically predict future locations of the device. For example, a server may be programmed to determine that there is at least a minimum likelihood that a user device will be at one of several locations within a maximum amount of time. The server may be further programed to perform certain actions in response to such a predicative determination. An example of such actions is sending a promotion or advertisement to the user device (*e.g.*, as an SMS message).

During prosecution, when successfully convincing the Board to overturn an Examiner's prior finding of unpatentability, Applicant highlighted several technical advantages of the claimed invention over "conventional location-based services." EX1002, p. 49. One such advantage included the ability to present information to a user device in a manner that "can actually influence the future location of the user device by offering an alternative trip the user can take rather than the trip typically taken in the current context." *Id.*

---

<sup>1</sup> All citations to Exhibit 1002 ("EX1002") are made to the page numbering in the footer added by Petitioner.

The '199 patent issued with one independent claim, copied below for the convenience of the Board:

1. A method for delivering information to two or more user devices, the method comprising:

retrieving the information from one or more data records that associate the information with one or more predetermined locations, a predetermined maximum amount of time, a predetermined likelihood, and one or more predetermined actions; and

for each of the two or more user devices:

predicting whether the user device will be at any of the one or more predetermined locations within the predetermined maximum amount of time with at least the predetermined likelihood; and

in response to the predicting that the user device will be at any of the one or more predetermined locations within the predetermined maximum amount of time with at least the predetermined likelihood, performing the one or more predetermined actions;

wherein at least one of the actions includes delivering the information to the user device.

## **V. THE PETITION FAILS TO PROVE OBVIOUSNESS**

Petitioners have the burden of proof to establish they are entitled to their requested relief. 37 C.F.R. § 42.108(c). To satisfy this burden under a theory of obviousness, Petitioners “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).

Petitioners have not met this burden.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.