

UNITED STATES PATENT AND TRADEMARK

OFFICE BEFORE THE PATENT TRIAL AND

APPEAL BOARD

APPLE INC.,

Petitioner

v.

UNILOC LUXEMBOURG S. A.,

Patent Owner

Case IPR2017-01993

U.S. Patent 9,414,199

**PATENT OWNER'S OBJECTIONS TO
EVIDENCE PURSUANT TO 37 C.F.R. § 42.64**

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner respectfully submits the following objections to footnote 3 of Petitioner’s Reply to Patent Owner’s Response and new Exhibit 1018 (U.S. Patent Publication No. 2013/0036165 (“Tseng”)) and Exhibit 1019 (Merriam Webster’s Collegiate Dictionary (10th Ed.1998)), which were submitted on September 4, 2018. *See* Paper 15 and exhibits filed therewith.

1. Objections to footnote 3 and Exhibit 1018 (*Tseng*)

Patent Owner objects to footnote 3 of Petitioner’s Reply and Exhibit 1018 (*Tseng*). Grounds for this objection include: 37 C.F.R. § 42.23(b) (outside scope of response and petition); Trial Practice Guide Update (August 2018) (“new evidence . . . that could have been presented in a prior filing, for example newly cited prior art references intended to ‘gap-fill’”)¹; and 37 C.F.R. § 42.104(b) (belated identification of challenge).

Footnote 3 of Petitioner’s Reply argues that *Tseng*, a reference cited for the first time in Petitioner’s reply, “discloses both a current time window and a future time window.” *See* Paper 15 at 10 (citing Ex. 1018). This newly-cited reference, and Petitioner’s argument that it discloses claim limitations, could and should have been cited in the original petition. Failure to include this argument and reference violates at least 37 C.F.R. § 42.104(b) and is outside the permissible scope of Petitioner’s reply under 37 C.F.R. § 42.23(b) and the Trial Practice Guide Update.²

2. Objections Exhibit 1019.

Patent Owner objects to Exhibit 1019. Grounds for this objection include: 37

¹ *See* https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf.

² Footnote 3 and Exhibit 1018 do nothing to further Petitioner’s prosecution disclaimer

C.F.R. § 42.23(b) (outside scope of response and petition); Trial Practice Guide Update (August 2018) (“new evidence . . . that could have been presented in a prior filing, for example newly cited prior art references intended to ‘gap-fill’”); and 37 C.F.R. § 42.104(b) (belated identification of challenge). Petitioner relies on Exhibit 1019 to support a claim construction argument that it could and should have included in the original Petition.

Date: September 11, 2018 /s/ Brett A. Mangrum
Brett A. Mangrum; Reg. No. 64,783
Ryan Loveless; Reg. No. 51,970
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that the foregoing UPDATED MANDATORY NOTICE OF PATENT OWNER UNDER 37 CFR § 42.8 was served on the Petitioner’s counselors of record by electronic notification, as agreed to by the parties:

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Date: September 11, 2018 /s/ Brett A. Mangrum
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