UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG, S.A.[1]
Patent Owner

IPR2017-1993
PATENT 9,414,199

PATENT OWNER RESPONSE SUR-REPLY
PURSUANT TO BOARD'S ORDER (PAPER 18)

[1] The owner of this patent is Uniloc 2017 LLC.

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I. INTRODUCTION

Pursuant to the Board's Order (Paper 18), Uniloc 2017 LLC (the "Patent Owner" or "Uniloc") submit Uniloc's Sur-Reply in the *inter partes* review (case no. IPR2017-01993) of United States Patent No. 9,414,199 ("the '199 patent" or "EX1001") filed by Apple Inc. ("Petitioner").

The Board stated in its Order that "a sur-reply would be an appropriate vehicle to respond to the arguments regarding prosecution disclaimer and the Tseng reference as requested by Patent Owner."

II. Petitioner fails to show that the only proposed construction for "within the predetermined maximum amount of time" improperly imports limitations and excludes an embodiment

The parties dispute the proper construction of the phrase "… within the predetermined maximum amount of time." As set forth in Uniloc's Response, "[o]ne having ordinary skill in the art, having reviewed the specification, would readily recognize that the plain and ordinary meaning is a predetermined maximum quantity of time (*e.g.*, a predetermined number of days, hours, minutes, and/or seconds, etc.) starting from when the "predicting" calculation is executed." Resp. (Paper 14) at 6–14. Neither the Petition nor its attached declaration proposes and defends any competing construction.[2] In its Reply, Petitioner provides no supplemental

[2] Petitioner and its declarant offer certain arguments, in the alternative, in the event that "a predetermined maximum amount of time is interpreted narrowly to indicate a time period calculated from the current time to the predicted arrival time." *See*, *e.g.*, Pet. at 68 and 70; EX1003 ¶ 209. Neither Petitioner nor its declarant defend such a construction nor explain whether or why it is too narrow. Only Patent Owner has addressed the merits of Petitioner's construction. *See* Resp. 11 n.9.

declaration and again makes no attempt to propose and defend a competing construction. Rather, Petitioner newly relies on attorney argument to attack Uniloc's construction as allegedly inconsistent with certain intrinsic evidence. Petitioner is wrong.

First, the Reply newly offers (through attorney argument only)[3] a misinterpretation of the '199 patent's description of its "current context" set forth under the section heading "Summary of the Invention." Rep. 5–6 (citing EX1001, 1:52–64). According to Petitioner, the cited description of the "current context" allegedly discloses two distinct embodiments, which Petitioner differentiates as "(1) a time duration starting from the current time and (2) a time window in the future." *Id*. Petitioner acknowledges what it identifies as the *first* embodiment is consistent with the proposed construction. *Id*. It is only what Petitioner alleges is a distinct and *second* embodiment that is purportedly excluded by the proposed construction. *Id*.

Petitioner overlooks that the full breadth of cited passage expressly pertains to what the '199 patent consistently refers to as its "current context." The cited paragraph introduces the concept as follows: "[t]o make a prediction regarding future locations of the user device, the server considers the user device's location history *in a current context*." *Id.*, 1:47–50 (emphasis added). The description then unambiguously states that "[o]ne part of the current context is the current day and

[3] Contrary to what Petitioner suggests, its declarant did not testify that the cited passage discloses two distinct embodiments, only one of which applies a time duration starting from the current time. *Compare* Rep. 5–6 *with* EX1003 ¶ 44.

the current time." *Id.*, 1:49–50. This definitive aspect, therefore, expressly applies to all predictions in the "current context."

This definitive description is then followed by "an example" (in the singular) expressly offered "[t]o appreciate this [current] context." *Id.*, 1:50. The example includes the following description quoted (in part) by Petitioner:

> Consider that a new department store has opened at a given location. The manager of the department store can request that anyone that is at least 50% likely to visit a store considered to be in competition of the department store within one hour should be sent a promotional code entitling that person to a discount. To do so, the manager can specify locations of all competing stores within a five-mile radius of the given location as the one or more predetermined locations. In addition, the manager can specify 50% as the predetermined minimum likelihood and one hour as the predetermined maximum amount of time. The manager can also specify days and times at which the actions are applicable, e.g., only during hours at which the new department store is open.

Id., 1:51–64. This description of a "current context," where the predetermined maximum amount of time is "within one hour" of when the predicting calculation is executed, expressly invokes the corresponding "within" claim language.

Petitioner cites no testimony of its declarant (because there is none) allegedly supporting the attorney argument that the last sentence of the above block quotation applies something other than the disclosed predetermined maximum amount of time of "within one hour." *Id*. That last sentence simply recognizes "actions," such as making a predictive calculation or sending a promotional advertisement, may not be applicable when the manager's store is not currently open.

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