

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

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I. INTRODUCTION

Pursuant to 35 U.S.C. §313 and 37 C.F.R. §42.107(a), Uniloc USA, Inc. and Uniloc Luxembourg S.A. (the “Patent Owner” or “Uniloc”) submit Uniloc’s Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 9,414,199 (“the ’199 patent” or “Ex. 1001”) filed by Apple Inc. (“Petitioner”) in IPR2017-1993.

In view of the reasons presented herein, the Petition should be denied in its entirety as failing to meet the threshold burden of proving there is a reasonable likelihood that at least one challenged claim is unpatentable. As a procedural deficiency, the Petition should be denied as presenting a virtually limitless number of possible redundant challenges against claims 1-5, without providing the requisite justification for such redundancy.

Notwithstanding the redundancies in the Petition, and because the Board has yet to decide which grounds it intends to dismiss as impermissibly redundant, Uniloc addresses each redundant ground and provides specific examples of how Petitioner failed to establish that it is more likely than not that it would prevail with respect to at least one of the challenged ’199 Patent claims. Accordingly, Uniloc respectfully requests that the Board decline institution of trial on claims 1–5 of the ’199 Patent.

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, 48–49.¹ 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

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

device by offering an alternative trip the user can take rather than the trip typically taken in the current context.” *Id.*

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.

IV. THE PETITION IS IMPERMISSIBLY REDUNDANT

The Board has repeatedly held that multiple grounds for unpatentability for the same claim will not be considered unless the petition itself explains the relative

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