UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

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IPR2017-2041

U.S. PATENT NO. 8,239,852

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PATENT OWNER PRELIMINARY RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. § 42.107(a)

Table of Contents

List of Exhibits

Exhibit No.	Description
2001	U.S. Patent No. 6,467,088 to alSafadi
2002	U.S. Patent Publication No. 2009/0037337, listing Baitalmal as inventor
2003	U.S. Patent No. 6,880,086 to Kidder
2004	Opening Claim Construction Brief in U.S. District Court Case No 2:17-cv-258 between Petitioner and Patent Owner

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. 8,239,852 ("the '852 patent" or "Ex. 1001") filed by Apple Inc. ("Petitioner") in IPR2017-2041.

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 at least *five* redundant challenges of Claims 1-8 and 16-18 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 '852 Patent claims. As a non-limiting example described in more detail below, the Petition fails the all-elements-rule in not addressing every feature of the claim.

Accordingly, Uniloc respectfully requests that the Board decline institution of trial on Claims 1-8 and 16-18 of the '852 Patent.

II. THE '852 PATENT

A. Effective Filing Date of the '852 Patent

The '852 patent is titled "Remote Update of Computer Based on Physical Device Recognition." The '852 Patent issued on August 7, 2012 from United States Patent Application No. 12/818,906, which claims priority to provisional Application No. 61/220,092, filed on June 24, 2009. The Petition does not dispute the effective filing date of the '852 patent is June 24, 2009.

B. Overview of the '852 Patent

The '852 Patent discloses various embodiments for remote updating of software. The '852 discloses, in a client-server system, a specialized software program stored on the client device that generates a unique device identifier for the client device, which is derived from multiple machine parameters readable on the client device. The unique device identifier when transmitted to the server along with the unique software identifier allows the server to determine, among other things, whether the client device is licensed to receive an upgrade for the application identifier. *See, e.g.*, Ex.1002 (Prosecution History), pp. 994.[1]

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

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