

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC USA, INC.,
Patent Owner.

Case IPR2017-02080
Patent No. 8,724,622

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

I. THE PETITION IS NOT REDUNDANT UNDER 35 U.S.C. §§ 314(a) OR 325(d), AND PETITIONER HAS A DUE PROCESS INTEREST

Patent Owner (“PO”) cites a pair of recent Board decisions that gained significance only after the instant Petition was filed. *See General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 (PTAB Sept. 6, 2017) (designated “precedential” after the instant Petition was filed); *TCL Corp. v. Lexington Luminance LLC*, IPR2017-01780, Paper No. 8 (PTAB Jan. 2, 2018) (decided after the instant Petition was filed). Petitioner (“Google”) already explained how it “is not duplicative or substantially similar to earlier IPR petitions against the ’622 patent” (Petition, 7), but Google now addresses these decisions.

The *General Plastic* factors 1-7 do not weigh in favor of an exercise of “discretion” that would deprive Google of its only opportunity to seek IPR. *General Plastic*, pp. 9-10. Factor 1 weighs heavily in favor of Google because this is the first and only petition that Google—the only Petitioner in this case (*infra* Section II)—has filed against claims 3-23 of the ’622 patent. Previous petitions were all filed by different parties. Additionally, Google’s Petition challenges a different subset of claims than any previous petition. None of the earlier-filed petitions challenged at least claim 9 of the ’622 patent, a fact that “weigh[s] overwhelmingly against a discretionary denial.” *Weatherford Int’l, LLC v. Packers Plus Energy Servs., Inc.*, IPR2017-01232, Paper No. 10 at 9-10 (PTAB Oct. 17, 2017). Factors 2, 4, and 5 (relating to the timing and substance of a

follow-on petition) do not tip the balance against institution because this Petition is not a follow-on petition (e.g., Google has not previously been party to any earlier petition where it “could have raised” the grounds cited here). In addition, with respect to Factor 5, Google expeditiously filed its Petition less than 6-months after Patent Owner served its complaint on Google. Factor 3 weighs in favor of institution because the Board’s prior denials of institution in IPR2017-00223 and IPR2017-00224 involved different prior art and different issues. Neither of those cases involved Zydney nor the grounds relied upon in this petition, and in fact, IPR2017-00224 was denied on a procedural issue that never provided a substantive “roadmap” for the instant Petition. Finally, factors 6 and 7 “do not weigh significantly for or against” exercising discretion to deny institution, as held by the Board under similar facts. *Fisher & Paykel Healthcare Ltd. v. ResMed Ltd.*, IPR2017-01789, Paper No. 7 at 15 (PTAB Jan. 25, 2018).

With respect to *TCL*, the facts here differ, rendering the case inapposite. The PO’s preliminary response ignores the fact that (1) Zydney was not previously before the Examiner in a reexamination, (2) the Board has not previously considered how Zydney applies to at least claim 9, and (3) the present Petition cites different prior art combinations never cited in the earlier IPRs. The Board has recognized that when, as here, a “case presents a different Petitioner challenging claims that have not been challenged previously,” that “those facts weigh

overwhelmingly against a discretionary denial of [a] proceeding.” *Weatherford Int’l*, IPR2017-01232, Paper No. 10 at pp. 9-10; *see also Unified Patents Inc. v. Silver State Intellectual Tech., Inc.*, IPR2017-01198, Paper No. 6 at pp. 20-21 (PTAB Sept. 28, 2017).

In sum, this Petition bears none of the hallmarks of a typical “follow-on Petition” under *General Plastic* or *TCL*. Google has a due process interest to be heard on the merits, and the Board should not wrongly deprive Google of such interest based on 35 U.S.C. §§ 314(a) or 325(d).

II. LG ELECTRONICS IS NOT A REAL PARTY-IN-INTEREST (RPI)

PO has raised false allegations that Google did not list all RPIs—new contentions that Petitioner could not have previously addressed. Contrary to PO’s incorrect assumptions, Google is the sole “Petitioner” here. The Motorola and Huawei entities were properly listed as RPIs, but they are not “co-petitioners.” All of PO’s arguments based on “co-Petitioners” were made without any evidence and are flatly wrong.

Also, PO’s allegation that “joint-defendant LG Electronics” should be named as a RPI is wrong. LG Electronics provided neither funding nor control over the Petition, had no opportunity to review/provide input during preparation of the Petition, and is simply unrelated to this case. PO also ignores that litigation activities among co-defendants “are not suggestive of control” or an RPI

relationship. *Intel Corp. v. Alacritech, Inc.*, IPR2017-01410, Pap. 8 at 15 (PTAB Nov. 21, 2017).

Finally, even if PO's false assumptions were true, they would not lead to dismissal because the RPI listing can be corrected. *Proppant Express v. Oren Tech.*, IPR2017-01917, Pap. 8 at 2-3 (PTAB Jan. 8, 2018) ("real parties in interest can be corrected"); *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, Pap. 38 at 4-5 (PTAB Mar. 4, 2016) (Precedential) (§ 312(a) not jurisdictional).

III. OTHER BOARD DECISIONS BASED ON ZYDNEY DO NOT COMPEL DENIAL OF INSTITUTION HERE

PO's "substantive" arguments are premised on the denial of institution in IPR2017-01257, which was a petition filed by a different party involving different issues in different claims of a different patent. The cited decision was published after Google filed this Petition, and PO's arguments based on this decision introduce new issues that Google could not have addressed earlier.

First, the issue that led to denial of institution in IPR2017-01257 is substantively different from any issue in this petition. The issue in IPR2017-01257 was whether the petitioner there (Facebook) had adequately demonstrated that the prior art teaches "recording [an] instant voice message in an audio file and attaching one or more files to the audio file," as recited in claim 1 of U.S. Pat. 8,199,747. Critically, none of the claims of the '622 patent recite this language. In

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