

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC., MOTOROLA MOBILITY LLC, HUAWEI DEVICE CO.,  
LTD., HUAWEI DEVICE USA, INC., HUAWEI INVESTMENT & HOLDING  
CO., LTD., HUAWEI TECHNOLOGIES CO., LTD., AND HUAWEI DEVICE  
(DONGGUAN) CO., LTD.

Petitioners

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

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IPR2017-02080  
PATENT 8,724,622

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

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**List of Exhibits**

<b>Exhibit No.</b>	<b>Description</b>
<b>2001</b>	Declaration of William C. Easttom II
<b>2002</b>	Invalidity Contentions Submitted on March 28, 2017 in the underlying consolidated case of <i>Uniloc USA, Inc. v. Samsung Electronic America’s, Inc.</i> , Case No. 2:16-cv-642
<b>2003</b>	Invalidity Contentions Submitted on December 16, 2016 in the underlying consolidated case of <i>Uniloc USA, Inc. v. Samsung Electronic America’s, Inc.</i> , Case No. 2:16-cv-642

## I. INTRODUCTION

Uniloc Luxembourg S.A. (the “Patent Owner”) submits this Preliminary Response to Petition IPR2017-1797 for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,724,622 B2, System and Method for Instant VoIP Messaging, (“the ’622 Patent” or “EX1001”) filed by Google Inc. Motorola Mobility LLC, Huawei Device Co., Ltd., Huawei Device USA, Inc., Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. (“Petitioners”). The instant Petition is procedurally and substantive defective for at least the reasons set forth herein.

Under 35 U.S.C. § 312(a)(4), “[a] petition filed under section 311 may be considered *only if* ... the petition provides such other information as the Director may require by regulation.” There is sufficient evidence to conclude, based on public filings, and even at this preliminary stage, that Petitioners failed to identify all real parties-in-interest. The Petition is further procedurally defective in that it is redundant with both earlier-filed petitions *and* is itself internally redundant, thereby invoking the discretion of § 325(d).

Even if the Board were to overlook the numerous procedural defects of the Petition and consider its substantive merits, the Petition should be denied in its entirety because it fails to meet the threshold burden of proving that there is a reasonable likelihood that even one challenged claim is unpatentable. Petitioners argue that claims 3-23 are unpatentable primarily in view of International Publication No. WO 01/11824 (“*Zydney*” or “EX1005”), which is a reference the

Board has already extensively considered in addressing this family of patents. As explained in prior Responses, which Petitioners had the benefit of reviewing, *Zydney* (either alone or in combination) fails to satisfy the All Elements Rule. Indeed, the instant Petitioners submit unreasonable arguments which are directly contradicted by concessions offered by their co-defendants in earlier-filed petitions. Accordingly, there is ample reason to deny the Petition in its entirety.

## **II. PETITIONERS FAIL TO NAME ALL REAL PARTIES-IN-INTEREST**

The '622 Patent is in a family of patents including United States Patent Nos. 7,535,890 (“the '890 Patent”); 8,243,723 (“the '723 Patent”); 8,199,747 (“the '747 Patent”); and 8,995,433 (“the '433 Patent”).<sup>1</sup> The diagram below how this family of patents is interrelated.

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<sup>1</sup> All five related patents derive from United States Patent Application No. 10/740,030 and are referred to collectively as members of the '622 Patent’s “family.”

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