UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD
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
IPR2017-02082 PATENT 7,535,890

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



## **Table of Contents**

I.	INTRODUCTION		
II.	THE PETITION SHOULD BE DENIED AS IMPERMISSIBLY REDUNDANT WITH PRIOR INTER PARTES REVIEW PETITIONS		
	A.	The Board Has Recently Confirmed Denial is Appropriate Under These Facts	2
	B.	Petitioners Provide No Rational Justification for the Redundancy	4
	C.	The Cases Petitioners Cite Confirm Denial Is Appropriate Here	5
	D.	The Board's Precedential Factors Support Denial	7
III.		E CONCURRENTLY-FILED PETITIONS INJECT DITIONAL REDUNDANCIES	9
IV.	PETITIONERS FAIL TO NAME ALL REAL PARTIES-IN-INTEREST		
	A.	Evidence of a Coordinated Multi-Petition Strategy	13
	B.	Additional Evidence of Failure to Name Real Parties-In- Interest	16
V.	OV	ERVIEW OF THE '890 PATENT	17
	A.	Effective Filing Date of the '890 Patent	17
	B.	The '890 Patent Describes and Claims Instant Voice Messaging over a Packet-Switched Network	17
VI.	THERE IS NO REASONABLE LIKELIHOOD THAT ANY OF THE CHALLENGED CLAIMS ARE		
		PATENTABLE	19
	A.	Claim Construction	20
	В.	In denying prior petitions, the Board has already considered and rejected the same impermissible conflation of <i>Zydney's</i> voice container and voice message	20
IV	тиі	E SUPREME COURT IS CURRENTLY REVIEWING	20
IV.	THE CONSTITUTIONALITY OF INTER PARTES		
	REV	VIEW	26
V.	CO	CONCLUSION 2	



### **List of Exhibits**

Exhibit No.	Description
2001	Declaration of Dr. Val DiEliius from IPR2017-01523 (under
	which institution was denied reasons directly applicable to the
	instant Petition)
2002	Invalidity Contentions Submitted on March 28, 2017 in the
	underlying consolidated case of Uniloc USA, Inc. v. Samsung
	Electronic America's, Inc., Case No. 2:16-cv-642
2003	Invalidity Contentions Submitted on December 16, 2016 in the
	underlying consolidated case of Uniloc USA, Inc. v. Samsung
	Electronic America's, Inc., Case No. 2:16-cv-642



#### I. INTRODUCTION

Uniloc Luxembourg S.A. (the "Patent Owner") submits this Preliminary Response to Petition IPR2017-2082 for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 7,535,890, System and Method for Instant VoIP Messaging, ("the '890 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.

The Petition should be denied under § 325(d) because the Board has already considered and flatly rejected the merits of the challenges presented in the instant Petition, which are based exclusively on the same *Zydney* reference (International Publication No. WO 01/11824 or "EX1004"). More specifically, Petitioners' codefendants already previously attempted—and failed—to assert *Zydney* as a primary reference (in combination with other references) in challenging the *same* claims of the *same* '890 patent in related matters IPR2017-1523 and IPR2017-1524. The Board's reasoning in rejecting those earlier petitioners applies equally here.

The Board need not even consider the merits of the Petition, however, due to procedural defects. There is sufficient evidence to conclude, based at least on public filings, that Petitioners failed to identify all real parties-in-interest. 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."



## II. THE PETITION SHOULD BE DENIED AS IMPERMISSIBLY REDUNDANT WITH PRIOR INTER PARTES REVIEW PETITIONS

The Board should exercise its discretion under 35 U.S.C. § 325(d) and deny the Petition because it relies on the same art and substantially the same (if not identical) arguments that is already before the Board in no less than *six* IPR proceedings filed collectively by the same group of joint defendants. *See*, *e.g.*, IPR2017-0220, IPR2017-0221, IPR2017-1523, IPR2017-1524, IPR2017-1612, IPR2017-1636, and IPR2017-1802.

## A. The Board Has Recently Confirmed Denial is Appropriate Under These Facts

In IPR2017-01780, the Board recently held that:

"On its face, § 325(d) does not contain any recitation regarding the identity of the party that previously presented the prior art; instead, the language of § 325(d) focuses solely on whether or not a petition relies on "the same or substantially the same prior art or argument previously . . . presented to the Office." 35 U.S.C. § 325(d). This stands in contrast to the estoppel provisions, for example, which only apply when the same petitioner brings a second petition for *inter partes* review."

IPR2017-01780, Paper 8 at 8. Accordingly, the Board concluded that "§ 325(d) is not limited to instances where the petitioner is the party who previously brought the prior art to the Office's attention." *Id*.

There, the Board found it was appropriate to dismiss the petition under § 325(d), where: the asserted art was identical to that presented in previous petitions,



# DOCKET

# Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

### **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

### **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

#### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

