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

IPR2017-02085
PATENT 7,535,890

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

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List of Exhibits

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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 IPR2017-2084 for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 8,199,747, System and Method for Instant VoIP Messaging, ("the '747 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 of § 325(d) because the Board has already considered and flatly rejected the merits of the challenges presented in the instant Petition, which are based primarily on the same *Zydney* reference (International Publication No. WO 01/11824 or "EX1004"). More specifically, Petitioners' co-defendants already previously attempted—and failed—to assert *Zydney* as a primary reference (in combination with other references) in challenging the claims of a patent from the same family, U.S. Patent No. 7,535,890, in related matters IPR2017-1523 and IPR2017-1524. Because Petitioners rely on the same *Zydney* reference to challenge claim language that is identical in the challenged claims of the '747 patent as well as the '890 patent, the Board's reasoning in rejecting those earlier petitioners applies equally here.

The Petition should also be denied due to procedural defects. 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. 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 two IPR proceedings filed collectively by the same group of joint defendants. *See*, *e.g.*, IPR2017-1257, and IPR2017-1799.

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.

And as a result, the Board concluded "[t]hus, § 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.*

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