

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LG ELECTRONICS, INC.,  
Petitioner

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner

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IPR2017-02087  
PATENT 8,995,433

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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 Dr. Val DiEuliis
<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
<b>2004</b>	“‘App’ voted 2010 word of the year by the American Dialect Society (UPDATED)", American Dialect Society (Jan. 8, 2011), available at <a href="http://www.americandialect.org/app-voted-2010-word-of-the-year-by-the-american-dialect-society-updated">http://www.americandialect.org/app-voted-2010-word-of-the-year-by-the-american-dialect-society-updated</a> (printed Aug. 23, 2017).

## I. INTRODUCTION

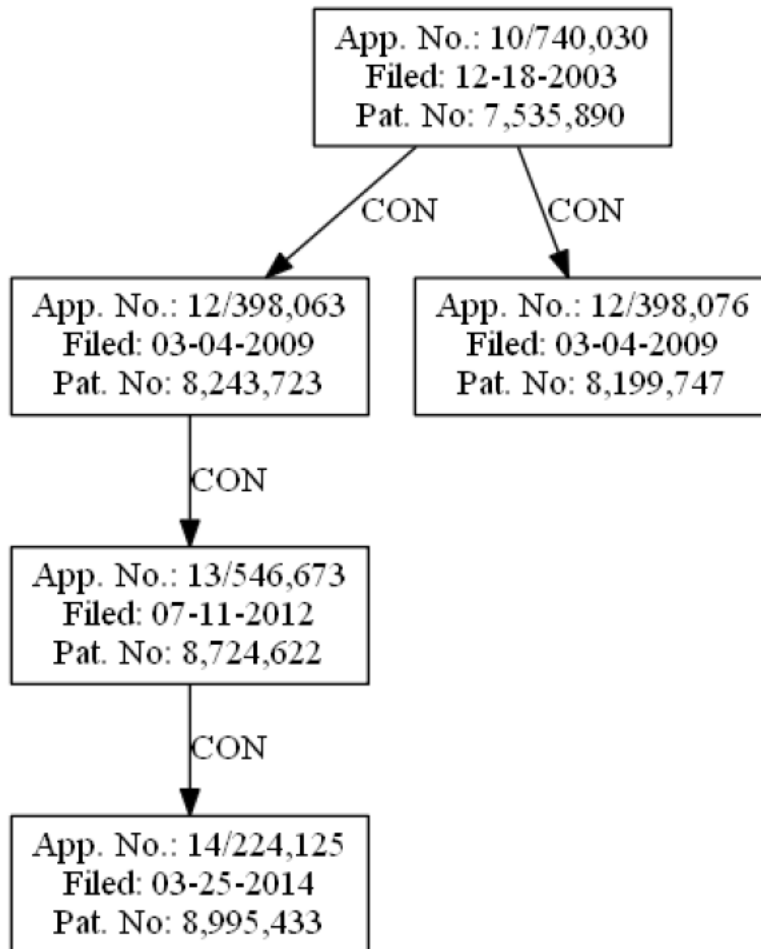
Pursuant to 35 U.S.C. §313 and 37 C.F.R. §42.107(a), Uniloc USA, Inc. and Uniloc Luxembourg S.A. (the “Patent Owner”) submit this Owner’s Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of U.S. Patent No. 8,995,433 (“the ’433 Patent” or “EX1001”) filed by LG Electronics, Inc. (“Petitioner” or “LGE”). Petitioner moves to join the proceeding in IPR2017-1427. Joinder is not warranted, however, because the instant Petition is procedurally and substantively 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.” The instant Petition fails to satisfy the mandatory notice provisions set forth in Rule 42.8. At a minimum, Petitioner fails to provide notice of all related administrative matters. In addition, there is also sufficient evidence to conclude, based on public filings, and even at this preliminary stage, that Petitioner failed to identify all real parties-in-interest.

Even if the Board were to overlook the numerous procedural defects of the Petition and reach 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. Patent Owner has seized the opportunity, as is its right, to expand and further explain the positions originally set forth in its preliminary Response to the petition in IPR2017-1427, a related matter. Denial is warranted for the *multiple* and *independent* procedural and substantive defects of the Petition identified herein.

**II. PETITIONER DOES NOT SATISFY THE MANDATORY NOTICE REQUIREMENTS**

The '433 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 8,724,622 (“the '622 patent”), as shown in the diagram below.



Petitioner has filed three of the thirty-six IPRs filed against this related family of patents, as highlighted below. As shown in the table below, most of the IPR petitions filed against these related patents predate the present Petition.

Petitioner	IPR#	Date	Patent
Apple	IPR2017-0220	14-Nov-16	'890

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