UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG, S.A.
Patent Owner

IPR2017-2202
U.S. PATENT NO. 8,239,852

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

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List of Exhibits

Exhibit No.	Description
2001	U.S. Patent No. 6,467,088 to alSafadi
2002	U.S. Patent Publication No. 2009/0037337, listing Baitalmal as inventor
2003	U.S. Patent No. 6,880,086 to Kidder

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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" or "Uniloc") submit Uniloc's Preliminary Response to the Petition for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 8,239,852 ("the '852 patent" or "Ex. 1001") filed by Apple Inc. ("Petitioner") in IPR2017-2202.

The Petition should be denied under §§ 315(e)(1) and 325(d) because Petitioner had previously filed a substantially similar petition in IPR2017-2041, challenging the ***same patent*** and the ***same claims***; and of the five asserted references in the instant Petition, ***three*** of the references and corresponding arguments are recycled from IPR2017-2041.

Notwithstanding the redundancy presented by the instant Petition, and because the Board has yet to rule on the earlier-filed petition (IPR2017-2041) and procedural defects of the Petition identified herein, Uniloc addresses each ground in the instant Petition and provides specific examples of how Petitioner failed to establish that it is more likely than not that it would prevail with respect to at least one of the challenged '852 patent claims. As described in more detail below, the Petition fails the All Elements Rules in failing to address every feature of the challenged claims.

Accordingly, Uniloc respectfully requests that the Board decline institution of trial on Claims 1-8 and 16-18 of the '852 Patent.

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II. THE PETITION SHOULD BE DENIED AS ESTOPPED UNDER § 315(e)(1) BY APPLE'S PRIOR PETITION

Under § 315(e)(1), estoppel will apply to grounds "the petitioner raised or reasonably could have raised during [IPR2017-2041]" previously filed by the same Petitioner. Citing the Federal Circuit's decision in *Shaw*,[1] the patent-savvy Eastern District of Texas (the same district of the related litigations identified in the Petition) recently interpreted this estoppel provision as applying to anything that was or could have been raised in a petition, except for art that actually was raised and then rejected by the Board for purely procedural reasons, such as redundancy. *See Biscotti Inc. v. Microsoft Corp.*, Case No. 2:13-CV-01015-JRG-RSP, 2017 WL 2526231, at *7 (E.D. Tex. May 11, 2017).

Here, the instant Petition challenges the ***same*** claims and relies on much of the ***same*** arguments that the ***same*** Petitioner raised in its earlier-filed petition in IPR2017-2041. More specifically, the instant Petition presents identical arguments based on at least the following same three references cited in IPR2017-2041: *Villela*, *Shakkarwar*, and *Hughes*. Indeed, the only difference between these two petitions is that the instant Petition relies on two cumulative references (*Richardson* and *Demeyer*) in place of certain references cited in IPR2017-2041.

As non-limiting examples, the below screenshots show ***identical arguments*** made in both petitions:

[1] *Shaw Indus. Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016).

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