

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS INC.

Petitioner

v.

VILOX TECHNOLOGIES, LLC.

Patent Owner

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Case IPR2018-00044

Patent No. 7,302,423

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DECLARATION OF WESLEY W. CHU, PH.D.

October 22, 2018

## I. INTRODUCTION

1. I prepared this Declaration at the request of Vilox Technologies, LLC stating my opinions as an independent expert regarding issues raised in the matter of Petition IPR2018-00044 (“*Petition*”), the April 19, 2018 Decision on Institution of *Inter Partes* Review (“*Decision*”), Petitioner’s Reply to Patent Owner’s Response (“*Petitioner’s Reply*”), and Petitioner’s Opposition to Patent Owner’s Motion to Amend (“*Opposition*”).

2. In preparation for this Declaration, I also studied Exhibit 1013, Declaration of Dr. Philip Greenspun (Greenspun-MtA), Exhibit 1014, U.S. Patent 6,452,597 to Goldberg (*Goldberg*), Petitioner’s Opposition (*Opposition*), and Petitioner’s Reply (*Petitioner’s Reply*). I also reviewed Exhibits 1001 – 1010 provided by Petitioner as well as Exhibit 2021, Declaration of Dr. Joseph L. De Bellis, Exhibit 2022 and 2029; Declarations of Missy De Bellis; Exhibit 2025, Figure 10 of the ‘423 Patent; Exhibit 2015, Deposition Transcript of Dr. Philip Greenspun; and all Exhibits and other documents referenced in Exhibit 2017, Declaration of Dr. Wesley W. Chu.

3. In preparing this Declaration I also relied on my knowledge and experience gained through 56 years as an engineer, professor, and consultant.

4. I am being compensated for this work, and my compensation is not dependent on the outcome of this matter.

## II. QUALIFICATIONS AND PROFESSIONAL EXPERIENCE

5. My experience is detailed in my previous Declaration, Exhibit 2021. My Curriculum Vitae is provided as Exhibit 2002.

## III. OPPOSITION TO MOTION TO AMEND

6. The *Opposition* states that the '423 Patent does not provide written description support for the proposed amended claim 24 limitation (limitation [24.5])“displaying a truncated portion of *each entry in the selected database field.*” The *Opposition* alleges that what is disclosed is “instead, a subset of the entries ... and not *each entry.*” Opp., p. 1-2.

7. The *Opposition* notes that “Patent Owner asserts limitation [24.5] is supported by the '423 patent from column 8, line 48 to column 9, 2, and at column 9 at lines 20-24.” Opp., p. 2.

8. The *Opposition* makes similar allegations with respect to proposed amended claim 25, specifically limitation [25.8]. Opp., pp. 5-6

9. Proposed amended claims 24 and 25 are directed to truncating entries in search results, with the final, truncated list or display of entries including a portion of each truncated entry. The claims recite truncation limitations based on determining a number of characters in each original entry and then truncating the entry. The *Opposition* goes to great length to alleged that the cited portions of the

'423 Patent "do not provide the requisite written description support for the amended limitation" of "displaying a truncated portion of each entry in the selected database field." Opp., pp 2-3. The *Opposition* then cites a section of the disclosure that shows truncation of six city names to three entries. Opp., p 3. The *Opposition* concludes that truncating the six city names should produce six truncated entries, and that, accordingly, the "disclosure," by showing only three entries, namely "Arm, New, Riv" fails to support the claim limitations. Opp., pp 3-4. But the *Opposition* goes on to acknowledge that the disclosure shows "truncation of entries to collapse the number of entries into a *smaller* or *lower* number, such that the smaller or lower number of entries can be displayed on a terminal screen" and that "the purpose of 'truncation' in the '423 Patent is to reduce a number of lines in a result list so as to collapse the list *vertically* by reducing the number of characters in returned entries to common characters." Opp., pp 4-5.

10. A PHOSITA would understand that in proposed amended claims 24 and 25, the claimed truncation reduces characters and will result in collapsing the result list vertically so that the result list may be displayed on the terminal. Thus, the cities Armandia and Armonk, in the disclosed example, become "Arm," thereby reducing the number of lines by one. However, "a truncated portion [in the example, "Arm"] of each entry in the selected database field is displayed," as recited in proposed

amended claims 24 and 25. Nowhere do the proposed amended claims 24 and 25 recite that each entry, once truncated, must be displayed, as the Petitioner apparently assumes. That is, as a PHOSITA would understand, neither proposed amended claim 24 nor 25 recites or requires “displaying each truncated entry.” Doing so would be contrary to the disclosure of the ‘423 Patent, as Petitioner acknowledges. *Opp.*, pp. 2-3. The claim limitation of “a truncated portion of each entry in the selected database field is displayed” is clearly supported in the section of the disclosure cited in the *Opposition*. Thus, a PHOSITA, viewing the disclosure and each of proposed amended claims 24 and 25, would understand that truncation of Armandia and Armonk to three characters and displaying “Arm” on the terminal meets the limitation of “a truncated portion of each entry in the selected database field is displayed” – “Arm” being a truncated portion of Armandia and Armonk.

**11.** Proposed amended claims 26 and 27 add to their base claim 25 the limitations “all entries from the selected data field are displayed on a single page of a terminal.” Claims 26 and 27 also recite “the specified limit is determined dynamically, based on a characteristic of the terminal.” However, this limitation was already present in claim 6, the original claim from which claims 26 and 27 are derived. In attacking proposed amended claims 26 and 27 for alleged lack of support, the *Opposition*

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