

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.¹

Patent Owner

IPR2018-00282

PATENT 7,092,671

PATENT OWNER RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. §42.120

¹ The owner of this patent is Uniloc 2017 LLC.

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I. INTRODUCTION

Uniloc Luxembourg S.A. (the “Uniloc” or “Patent Owner”) submits this Response to Petition IPR2018-00282 for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 7,092,671 (“the ’671 patent” or “EX1001”) filed by Apple, Inc. (“Petitioner”). The Petition should be denied as procedurally and substantively defective for at least the reasons set forth herein.

II. THE ’671 PATENT

The ’671 patent is titled “Method and System for Wirelessly Autodialing a Telephone Number From a Record Stored On a Personal Information Device.” The ’671 patent issued August 15, 2006, from U.S. Patent Application No. 09/727,727 filed November 30, 2000 and originally assigned 3Com Corporation (3Com).

The inventors of the ’671 patent observed that while cellphones shared many attributes with personal information devices, at the time of the invention, cellphones typically had substantially fewer applications and users found them much more difficult to use when entering data such as names and phone numbers than personal information devices. EX1001, 1:46–53. And because of those limitations at the time, cellphones were more typically used just for communication rather than personal information management. *Id.*, 1:54–57. The inventors at 3Com came up with an innovative solution which allowed the applications executed on a user’s personal information device to access the user’s telephone and automatically dial numbers stored in the application program. *Id.* 2:11–22.

According to the preferred embodiment disclosed in the ’671 Patent, the telephone is equipped with a wireless port for short-range wireless data transfer.

Similarly, the personal information device is equipped with a wireless port for short-range wireless data transfer. *Id.*, 2:41–45. The personal information device establishes a wireless communication with the telephone. *Id.* The personal information device is configured to control the telephone via the wireless communications such that the telephone dials a telephone number stored on the personal information device. *Id.*, 2:45–48.

The telephone number can be dialed in response to the user interacting with application executing on the personal information device. *Id.*, 2:48–54. The application can be a contact management or address management program. The user can interact with the program, select a contact, address, phone number, or the like, through a user interface of the personal information device, and have this number automatically dialed by the telephone. In this manner, the user’s personal information device seamlessly interacts with the user’s telephone to dial numbers and establish phone calls, without requiring the user to access controls of the telephone. *Id.*

III. LEVEL OF ORDINARY SKILL IN THE ART

To prevail on its theory of obviousness, Petitioner has the burden to prove that “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made *to a person having ordinary skill in the art to which said subject matter pertains.*” 35 U.S.C. § 103. Consistent with that statutory framework, and as reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (“KSR”), the factual inquiries for determining obviousness under 35

U.S.C. § 103 are enunciated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) as follows:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) *Resolving the level of ordinary skill in the pertinent art.*

See also MPEP § 2141 (quoting the same). Rule 42.22(a)(2) states that the petition *itself* must contain a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence”

Under this controlling authority, the Petition does not set forth the requisite analysis necessary to prove obviousness at least because (among other deficiencies) it fails to provide or expressly rely upon any definition for the level of ordinary skill in the pertinent art. Further, the Petition fails to explain how its analysis conforms to that required perspective (i.e., a perspective that the Petition itself fails to define).

This fatal deficiency is not something that the Board can cure *sua sponte*. The Federal Circuit has repeatedly admonished the Board against adopting arguments not raised in the Petition itself. *See, e.g., Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co. KG*, 856 F.3d 1019, 1027 (Fed. Cir. 2017) (citing *In re Magnum Oil Tools Int’l, Ltd*, 829 F.3d 1364, 1377, 1380 (Fed. Cir. 2016) and *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1351 (Fed. Cir. 2016)). This is true even where the argument “could have been included in a properly-drafted petition.” *Rovalma*, 856 F.3d at 1027 (quoting and discussing *Magnum Oil*, 928 F.3d at 1377).

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