UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A. [1]

Patent Owner

IPR2018-00361

PATENT 6,216,158

PATENT OWNER RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. §42.120

---

[1] The owner of this patent is Uniloc 2017 LLC.

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

Table of Contents

I. INTRODUCTION 1

II. THE '158 PATENT 1

III. RELATED PROCEEDINGS 2

IV. LEVEL OF ORDINARY SKILL IN THE ART 3

V. THE REDUNDANT CHALLENGE IN GROUND 2 IS PROCEDUARLLY AND SUBSTANTIVELY DEFICIENT 3

VI. PETITIONER DOES NOT PROVE A REASONABLE LIKELIHOOD OF UNPATENTABILITY FOR ANY CHALLENGED CLAIM 5

A. Claim Construction 6

1. "palm sized computer" 6

2. "means for accessing a description of a service" 7

3. "means for downloading the program code" 8

4. "means for executing at least a portion of the program code" 9

5. "means for sending control commands to the service in response to the means for executing" 10

B. Ground 1 Should be Denied 12

1. The Cited References that Rely on "Jini" Do not Qualify as Prior Art 12

2. Multiple Ground 2 References are Not Enabling 13

3. The Ground 2 references do not disclose "accessing a description of the service from a directory of services, the description of the service including at least a reference to program

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

code for controlling the service" (Claim 1).....15

4. The Ground 2 references do not disclose "accessing a directory of services, a service in the directory of services corresponding to the program, the description of the service including at least a reference to program code for controlling the service" (Claim 8) or "means for accessing a description of a service, the description of the service including at least a reference to program code for controlling a service" (Claim 20) 17

5. The Ground 2 references do not disclose "downloading the program code to the palm sized computer" (Claim 1) or "loading the program code," (Claim 8), "loading the program code onto the palm sized computer" (Claim 9) or "means for downloading the program code" (Claim 20).....18

The Ground 2 references 21

6. do not disclose "the palm sized computer executing at least a portion of the program code; and sending control commands to the service from the palm sized computer in response to the executing, wherein the service controls an application that cannot be executed on the palm sized computer." (Claim 1).....21

7. The Ground 2 references do not disclose a "method of controlling a program on a network device from a palm sized computer, the computer is not capable of executing the program by itself…" (Claim 8) and means for sending control commands to the service in response to the means for executing, wherein the service controls an application that cannot be executed on the means for executing (Claim 20) 24

8. The Petition fails to show a POSA would have

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

combined *Jini-QS* (EX1005), and *Arnold* (EX1006), and *McCandless* (EX1007) 25

a) The proposed combination fails because a POSA would not have looked to *Jini-QS* (EX1005) or *McCandless* (EX1007) as teaching references 25

b) The proposed combination further fails because *Jini-QS* itself does not support making the proposed combination 26

c) The proposed combination further fails because *Arnold* and the RMI Protocol do not support making the proposed combination 28

9. Ground 1 should further be denied because all other challenged claims of Ground 1 depend from Claim 1 or Claim 8 29

C. Ground 2 Should be Denied 29

1. The Ground 2 references do not disclose "accessing a description of the service from a directory of services, the description of the service including at least a reference to program code for controlling the service" (Claim 1) 29

2. The Ground 2 references do not disclose "accessing a directory of services, a service in the directory of services corresponding to the program, the description of the service including at least a reference to program code for controlling the service" (Claim 8) 34

3. The Ground 2 references fail to disclose "wherein the service controls an application that cannot be executed on the palm sized computer" (Claim 1) 34

4. The Ground 2 references fail to disclose a "method of controlling a program on a network

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

device from a palm sized computer, the computer is not capable of executing the program by itself…" (Claim 8).....35

5. The Petition fails to show a POSA would have combined the Ground 2 references of *Riggins* (EX1008) and *Devarakonda* (EX1009).....36

a) There is no evidence that *Riggins* (EX1008)'s teachings of web browser applets could be implemented in a PDA.....37

b) The proposed combination fails because *Riggins* (EX1008) teaches away from the passing reference PDA of *Devarakonda* (EX1009).....39

c) The Petition lacks the required factual inquiry into reasons for the proposed combination and lacks explanation as to how or why the references would be combined.....41

6. Ground 2 should be denied because all other challenged claims of Ground 2 depend from Claim 1 or Claim 8.....44

VII. THE CONSTITUTIONALITY OF *INTER PARTES* REVIEW IS THE SUBJECT OF A PENDING APPEAL.....44

VIII. CONCLUSION.....45

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.