

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner

Case IPR2018-00387
Patent No. 7,653,508

PETITIONER'S REPLY

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PETITIONER'S UPDATED EXHIBIT LIST

January 2, 2019

Ex.1001	U.S. Patent No. 7,653,508
Ex.1002	Prosecution History of U.S. Patent No. 7,653,508
Ex.1003	Declaration of Joe Paradiso, Ph.D, under 37 C.F.R. § 1.68
Ex.1004	Curriculum Vitae of Joe Paradiso
Ex.1005	U.S. Patent No. 7,463,997 to Fabio Pasolini et al. ("Pasolini")
Ex.1006	U.S. Patent No. 7,698,097 to Fabio Pasolini et al. ("Fabio")
Ex.1007	Reserved
Ex.1008	Reserved
Ex.1009	Reserved
Ex.1010	Reserved
Ex.1011	Reserved
Ex.1012	Prosecution History of U.S. Patent No. 8,712,723

I. Introduction

The Petition and supporting evidence provide detailed reasons why Pasolini alone or in combination with Fabio renders the challenged claims of the '508 patent obvious. Patent Owner's arguments all fail because they rely on irrelevant mischaracterizations of the prosecution history of a related case (*see* Response, pp.3-4), incorrectly argue that the proposed claim constructions are overly narrow (*see* Response, pp.4-10), and mischaracterize both Fabio's teachings regarding its validation interval (*see* Response, pp.1-21) and Pasolini's teachings regarding using a 3-axis accelerometer and determining the axis most influenced by gravity (*see* Response, pp.21-29). Petitioner shows below how Patent Owner's arguments are both incorrect and unsupported, and should thus be rejected.

II. Pasolini was not applied to the claims of the '508 patent during prosecution.

The Petition challenges the claims of the '508 patent using either Pasolini alone or Pasolini in combination with Fabio. Pasolini was applied by the Examiner during prosecution of U.S. Patent No. 8,712,723 ("the '723 patent"), a descendant of the '508 patent, but Pasolini was never applied to the claims of the '508 patent. Further, even references considered during prosecution are not necessarily disqualified from *inter partes* review proceedings. *See, e.g., Praxair Distribution, Inc. v. INO Therapeutics LLC*, IPR2015-00889, Paper 14, at 10 (PTAB Sept. 22, 2015) ("[a]bsent a showing of 'substantially the same ... arguments' ... and

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