

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG S. A.¹

Patent Owner

IPR2018-00389

PATENT 8,712,723

PATENT OWNER SUR-REPLY TO PETITIONER'S REPLY

¹ The owner of this patent is Uniloc 2017 LLC.

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I. INTRODUCTION

Uniloc 2017 LLC (“Uniloc” or “Patent Owner”) submits this Sur-Reply to Petitioner’s Reply in IPR2018-00389 (“Reply”) regarding United States Patent No. 8,712,723 (“the ’723 patent” or “EX1001”) filed by Apple, Inc. (“Petitioner”).

II. PETITIONER FAILED TO MEET ITS BURDEN

The Petition has failed to meet its burden in establishing that claims 1-3, 5-7, 10-18 are obvious under 35 U.S.C. § 103 over *Fabio*² and *Pasolini*.³

A. Petitioner Does Not Dispute that the Pasolini Reference it Now Applies Was Already Considered by the USPTO

In its Reply, Petitioner acknowledges that there are two applications filed by inventor Fabio Pasolini on the same day – one that it chooses to refer to as Fabio (Ex. 1006) and the other that it chooses to refer to as Pasolini (Ex 1005). And, in its Reply, Petitioner does not dispute that the USPTO already considered the disclosures in Pasolini (Ex. 1005) and specifically indicated that such a reference fails to disclose the claimed “cadence window.”

² EX1006, U.S. Patent No. 7,698,097

³ EX1005, U.S. Patent No. 7,463,997

Claim Rejections under 35 U.S.C. §102

Claims 1-2, 11-12, and 14-16 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2007/0143068 to Pasolini, et al (hereinafter "Pasolini").

Pasolini discusses a method to detect steps using an accelerometer. Pasolini's system is designed to count steps, based on comparison of an acceleration signal to a threshold. However, Pasolini does not teach or suggest the use of cadence windows, much less the comparison of a motion cycle to a cadence window which is adjusted as the user's motion is detected. Therefore, Applicants respectfully submit that claims 1, 11, and 15, as amended, and the claims that depend on them, are not anticipated by Pasolini.

See EX1002 at pg. 142 of 454 (Emphasis Added).

The Petitioner has no explanation for why it failed to bring this fact to the Board's attention and merely argues instead that the *combination* of "Fabio Pasolini's" two overlapping applications⁴ – Pasolini and Fabio were not before the examiner. However, the intimately related and relevant argument that Pasolini allegedly discloses the required "cadence windows" was specifically considered and rejected by the examiner. The interest of finality weighs against revisiting the deficiencies of Pasolini and whether the cumulative disclosure in Fabio renders obvious what Pasolini admittedly fails to disclose. *See, e.g., Shire LLC v. Amneal Pharm., LLC*, 802 F.3d 1301, 1307 (Fed. Cir. 2015) (holding a patent challenger has "the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more

⁴ A review of these two specifications reveal the overlapping nature.

examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.”); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (upholding claim construction of the district court in limiting the scope of the earlier, already issued patent based on statements offered during prosecution of a related application that issued later).

B. The Applied References Fail to Disclose a “Cadence Window”

Each of the challenged claims requires a “cadence window.” As recognized by the Examiner in the prosecution history of the ‘723 Patent, *Pasolini* (EX1005) fails to disclose such a cadence window. *See* EX1002 at 35-36 (indicating in notice of allowance that prior art fails to disclose the now-challenged claims). Likewise, the other Fabio Pasolini reference, *Fabio* (EX1006)⁵ also fails to disclose anything resembling such a cadence window.

The Petition, as well as the Reply, incorrectly defines the “cadence window” as a “window of time since a last step was counted that is looked at to detect a new step.” *See* Petition at 9-10; Reply at 8, 11. This definition ignores the term “cadence”

⁵ The last name of the inventor is actually Pasolini; however, to maintain consistency with petitioner’s nomenclature, Fabio (the first name) is used. Both EX1005 and EX1006 share the same inventors and have the same filing dates.

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