

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.¹

Patent Owner

IPR2018-00884

PATENT 8,539,552

PATENT OWNER SUR-REPLY TO PETITIONER'S REPLY

¹ The owner of this patent is Uniloc 2017 LLC.

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List of Exhibits

Exhibit No.	Description
2001	Declaration of William C. Easttom (previously filed)
2002	McGraw-Hill Dictionary of Scientific and Technical Terms, Sixth Edition (previously filed)
2003	Netwon’s Telecom Dictionary, Sixteenth Edition (previously filed)

I. INTRODUCTION

Uniloc 2017 LLC (the “Uniloc” or “Patent Owner”) submits this Sur-Reply to Petitioner’s Reply in IPR2018-00884 (“Reply”) regarding United States Patent No. 8,539,552 (“the ’552 Patent” or “EX1001”) filed by Apple, Inc. (“Petitioner”).

Petitioner erroneously suggests in its Reply that Patent Owner has the burden to present new argument or evidence in its response, else “the Board should again reject Patent Owner’s contentions and cancel the Challenged Claims.” Reply at 1. Petitioner appears to misunderstand that the burden of proof *always* lies with the Petitioner and that a different and more onerous burden applies once the Board institutes trial.

Petitioner also falsely states that Patent Owner’s expert, Dr. Easttom, “was not made available for cross examination.” Reply at 2. Petitioner omits certain key facts in offering a partial summary of events. Indeed, Petitioner omits details from its own exhibits revealing that Patent Owner *had offered* Dr. Easttom for deposition and that, in declining that offer, Petitioner inappropriately blamed Patent Owner.

After the Board issued its order (Paper 12) denying Petitioner’s request to strike Dr. Easttom’s declaration, the parties communicated via email to discuss how to best proceed. When it was clear that a conference call would be more productive, the parties met and conferred via teleconference on March 15, 2019. During that call, counsel for Petitioner committed that it would discuss with its client “whether we could agree to any claim construction to *otherwise avoid the deposition*” (as Petitioner’s counsel admitted in a follow-up email dated March 28, 2019 at filed by Petitioner as Exhibit 1021). EX1021 at 1 (emphasis added).

The exhibits Petitioner submitted in its Reply reveal that Petitioner chose to let *two weeks* lapse from (March 15 to March 28), without providing any update whatsoever as to whether (1) an agreement could be reached on construction or, instead, (2) Petitioner intended to move forward with the deposition.

Patent Owner offered Dr. Easttom for deposition. EX1021 at 1; *cf. Reply* at 2 (“Dr. Easttom was not made available for cross examination”). Patent Owner did so within mere hours of when Petitioner first informed Patent Owner that no agreement could be reached, and that Petitioner intended to proceed with a deposition. EX1021 at 1. Patent Owner offered the *only* day Dr. Easttom himself indicated he would be available for deposition (given that his work schedule would take him out of the country for the time remaining until Petitioner’s already-extended due date).

Petitioner faults Patent Owner for giving only one day’s notice, but this was a problem of Petitioner’s own making. Had Petitioner timely followed up after the call (held on March 15, 2019) to update Patent Owner (as Petitioner had committed to do during the call), Petitioner could have had much more advance notice.

Petitioner’s Reply simply offers no basis for the Board to disregard Dr. Easttom’s declaration or to blame Patent Owner for Petitioner’s unexplained delay. In addition, Petitioner should not be rewarded for falsely stating to the Board that “Dr. Easttom was not made available for cross examination.” Reply at 2.

II. PETITIONER FAILS TO PROVE OBVIOUSNESS

Petitioner has failed to meet its burden of proving obviousness for any of the grounds raised in the Petition.

A. Petitioner cannot prove obvious through application of an erroneous construction of “intercepting a signaling message”

Petitioner attempts to defend the construction *provisionally* adopted in the Board’s Institution Decision by arguing, instead, that “intercepting a signaling message” requires nothing more than merely “receiv[ing] a message and pass[ing] that message on toward its final destination.” Reply at 8. Petitioner’s Reply essentially seeks to rewrite the claimed “intercepting” as *routing*, which is a distinct term of art. Such an interpretation cannot be squared with the evidence of record.

The ’552 patent consistently and repeatedly attributes “intercepting” only to the specific network entity tasked with initiating processes for “control[ing] access to, and invocation of, features and services that may otherwise be delivered to subscribers without the knowledge or authorization of the network.” EX1001 at Abstract; 3:20-25. By design, this occurs in a manner transparent to the end-user client. Indeed, the teachings of the ’552 patent are designed in part to enable carriers and service providers “to deal with *unauthorized* delivery of services by intelligent clients” and to avoid “bypassing by the end user of service agreements or other subscription accounting mechanisms.” *Id.* at 1:38-40, 45-55 (emphasis added). Such enforcement through interception may be necessary “even when the capabilities for the requisite signaling and call control of those services may reside in the end-user clients themselves.” *Id.* at 3:28-30.

It is significant that the ’552 patent expressly distinguishes these teachings from “just *transport* of the services”—i.e., from merely receiving a message and passing it onward. *Id.* at 1:41-44 (emphasis added).

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