UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

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IPR2018-00884

PATENT 8,539,552

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PATENT OWNER PRELIMINARY RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. §42.107(a)

Table of Contents

List of Exhibits

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

I.   INTRODUCTION

Uniloc Luxembourg S.A. (the "Uniloc" or "Patent Owner") submits this Preliminary Response to Petition IPR2018-00884 for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 8,539,552 ("the '552 Patent" or "EX1001") filed by Apple, Inc. ("Petitioner"). The instant Petition is procedurally and substantively defective for at least the reasons set forth herein.

II.   THE '552 PATENT

The '552 patent is titled "System and method for network based policy enforcement of intelligent-client features." The '552 patent issued September 17, 2013, from U.S. Patent Application No. 10/671,375 filed September 25, 2003.

The inventors of the '552 patent observed that at the time of the invention, there was an emergence of Internet Protocol (IP) telephony and IP multimedia networks. And to the extent that telephony services and features could be implemented in intelligent clients, the carriers and service provider network's responsibilities included little more than providing data pipes. Therefore, the carrier's and service providers' ability to enforce the authorization of service usage was important. EX1001, 1:14-55. Accordingly, for networks to retain control over the features and services used by subscribers that use intelligent end-user clients, the networks needed to be able to recognize signaling and call control messages and transactions that implemented those features and services within the network. *Id.*, 2:63-3:7.

According to the invention of the '552 Patent, a system and method for using network-based policy enforcement to control access to, and invocation of, features

and services which may otherwise be delivered to subscribers without the knowledge or authorization of the network. An operator of an IP telephony and/or IP multimedia network may enforce authorization or privileges of intelligent end-user clients to utilize or invoke services in the network, even when the capabilities for the requisite signaling and call control of those services may reside in the end-user clients themselves. *Id.*3:20-30. In one embodiment, a policy enforcement point is maintained in the network by elements that are under control of the network operator. This approach lessens and/or eliminates a need for the network operator to police the selection of client devices, and at the same time, allows end users to install nearly any suitable device of their choosing. *Id.*, 3:31-36.

III.   THE LEVEL OF ORDINARY SKILL IN THE ART

The Petition alleges that "[a] person having ordinary skill in the art at the time of the '552 Patent would have been a person having at least a bachelor's degree in electrical engineering, computer science or engineering, or in a related field, with at least 2 years of industry or research experience with packet-based telecommunications systems. Additional industry experience or technical training may offset less formal education, while advanced degrees or additional formal education may offset lesser levels of industry experience." Pet. 6. Given that Petitioner fails to meet its burden of proof in establishing *prima facie* anticipation or obviousness when applying its own definition of a person of ordinary skill in the art ("POSITA"), Patent Owner does not offer a competing definition for POSITA at this preliminary stage, though it reserves the right to do so in the event that trial is instituted.

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

Petitioner has the burden of proof to establish entitlement to relief. 37 C.F.R. §42.108(c) ("review shall not be instituted for a ground of unpatentability unless . . . there is a reasonable likelihood that at least one of the claims challenged . . . is unpatentable"). The Petition should be denied as failing to meet this burden.

The raises the following obviousness challenges under 35 U.S.C. § 103:

Ground	Claims	Reference(s)
1	1-4, 6-10, 12-20, and 22-23	*Kalmanek*[1] and knowledge of a Person of Ordinary Skill in the Art ("POSITA")
2	5 and 11	*Kalmanek* and knowledge of a POSITA and *Shaffer* [2]
3	21, 24, and 25	*Kalmanek* and knowledge of a POSITA and *Strathmeyer* [3]
4	17	*Kalmanek* and knowledge of a POSITA and *Gleichauf*[4]

A. Claim Construction

Patent Owner submits that the Board need not construe any claim term in a particular manner in order to arrive at the conclusion that the Petition is substantively deficient. *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) ("need only be construed to the extent necessary to resolve the controversy"). Nevertheless, Patent Owner addresses those terms for which the

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[1] EX1004, U.S. Patent No. 6,324,279

[2] EX1005, U.S. Patent No. 7,023,839

[3] EX1006, U.S. Patent Pub. No. 2001/0026548

[4] EX1007, U.S. Patent No. 7,412,598

Petitioner proposes constructions. As explained below, Petitioner bases its patentability challenges on erroneous constructions, which provides an independent and fully-dispositive basis to deny the Petition in its entirety. *See Mentor Graphics Corp., v. Synopsys, Inc.*, IPR2014-00287, 2015 WL 3637569, (Paper 31) at *11 (P.T.A.B. June 11, 2015), *aff'd sub nom. Synopsys, Inc. v. Mentor Graphics Corp.*, 669 Fed. Appx. 569 (Fed. Cir. 2016) (finding Petitioner's claim construction unreasonable in light of the specification, and therefore, denying Petition as tainted by reliance on an incorrect claim construction).

1. "intercepting" a message

Petitioner seeks to improperly broaden and misconstrue the term "intercepting" a signaling message to mean merely "receiving" a message. Pet. 8-9. The term "intercepting" cannot include simply "receiving" a signaling message because it is against the intrinsic evidence and it is against the understanding of a POSITA.

First, as the Petition itself points out, the specification expressly distinguishes between "received" and "intercepted" messages: "Initially, signaling and call control messages are *received **or** intercepted* by the policy enforcement point." EX1001, 8:56-58 (emphasis added). Therefore, the patentee knew the difference and articulated the difference between "receiving" and "intercepting" a message, and the specification itself teaches against equating the two.

Additionally, the claims themselves expressly differentiates a device "intercepting" a message and the "intended recipient" of that message. For

example, Claim 1 recites "a network entity *intercepting* a signaling message associated with a call *between a sender device* of the message and *an intended recipient device of the message*" EX1001, 19:62-64 (emphasis added). If "intercepting" a message merely meant "receiving" a message, then the claim language above would be wholly redundant, because the "intended recipient" by definition would receive the message.

Furthermore, unlike in independent Claims 1, 6, 18, and 23, independent Claim 24 specifically uses the term "receiving" instead of the term "intercepting". *See* EX1001, claim 24, 22:47-48 ("a proxy server for *receiving* a request from the border element…") (emphasis added). Thus further confirming that the patentee not only knew the different between "intercepting" and "receiving", but that the terms have different meanings and are not synonyms or interchangeable.

Second, as Mr. Easstom testifies, a POSITA would understand that the entity *intercepting* a message would not be one of the intended recipients of that message. EX2001 ¶¶ 8-9. In other words, a POSITA would understand that the device that is *intercepting* a message would be a third party to the intended recipients of that message. *Id.* And as the Petition itself admits, Petitioner specifically seeks to improperly broaden the definition of the term "intercepting" here to include a "gate controller" device, that is specifically the intended recipient of that message. *See* Pet. 24-25 ("*Kalmanek* explains that the BTI initiates a transaction *with* the gate controller via the SETUP message. … Applying this construction, *Kalmanek* teaches that the setup message is intercepted by the gate controller.") (emphasis added).

Petitioner's proposed construction improperly seeks to broaden and misconstrue the term "intercepting" a message to include and be synonymous with being the intended and targeted recipient of that message. Petitioner's proposed construction should be rejected because it is against the intrinsic evidence and it is against the understanding of the meaning of the term to a POSITA.

2. "sender device," "recipient device," and "device profile"

At this preliminary stage, Patent Owner submits that the Board need not construe any claim term, including the terms "sender device," "recipient device," and "device profile", in a particular manner in order to arrive at the conclusion that the Petition is substantively deficient. *Wellman*, 642 F.3d at 1361. Therefore at this preliminary stage, Patent Owner does not submit a competing definition, however, in the event that trial is instituted, Patent Owner reserves the right to object to Petitioner's proposed construction and provide Patent Owner's proposed construction.

B. *Kalmanek* Does Not Disclose "a network entity <u>intercepting</u> a signaling message associated with a call between a sender device of the message and an intended recipient device of the message"

1. Independent Claim 1

As discussed above in Section IV.A.1, Petitioner's proposed claim construction of the term "intercepting" a message is improper, specifically that "intercepting" a message cannot include being the intended, targeted recipient of that message. Further, such a proposed construction goes against the intrinsic evidence and against the understanding of the meaning of the term to a POSITA.

As shown below Petitioner bases its patentability challenges on this erroneous construction, and therefore the Petition should be denied in its entirety. *See Mentor Graphics Corp.*, IPR2014-00287, 2015 WL 3637569, (Paper 31) at *11 *aff'd sub nom. Synopsys, Inc.*, 669 Fed. Appx. 569 (finding Petitioner's claim construction unreasonable in light of the specification, and therefore, denying Petition as tainted by reliance on an incorrect claim construction).

For this limitation, the Petition argues that "*Kalmanek* teaches that **the gate controllers *intercept* signaling messages, such as *a call setup message.*" Pet. 23 (emphasis added). However, as the Petition itself plainly shows the "gate controllers" of *Kalmanek* do not *intercept* the call setup message, instead the "gate controllers" are the intended recipients of the call setup messages:

> "Kalmanek explains that the BTI initiates a transaction
>
> *with* **the gate controller** via the SETUP message.
>
> Kalmanek (EX1004) at 21:1-15."

Pet. 24.

> "In other words, **upon *receiving*** a setup request message
>
> from a calling party, **the gate controller** can authenticate
>
> the identity of the calling party and authorize the service
>
> sought by the calling party."

Pet. 25 (quoting *Kalmanek*) (emphasis added).

> "At step 330, the originating TIU 170 sends a setup
>
> message *to* **the originating gate controller** 110."

Id. (quoting *Kalmanek*) (emphasis added).

That the "gate controllers" of *Kalmanek* are in fact the intended recipients and targets of the setup message, and therefore do not *intercept* the setup message is further confirmed by Figure 3 of *Kalmanek*:

FIG. 3
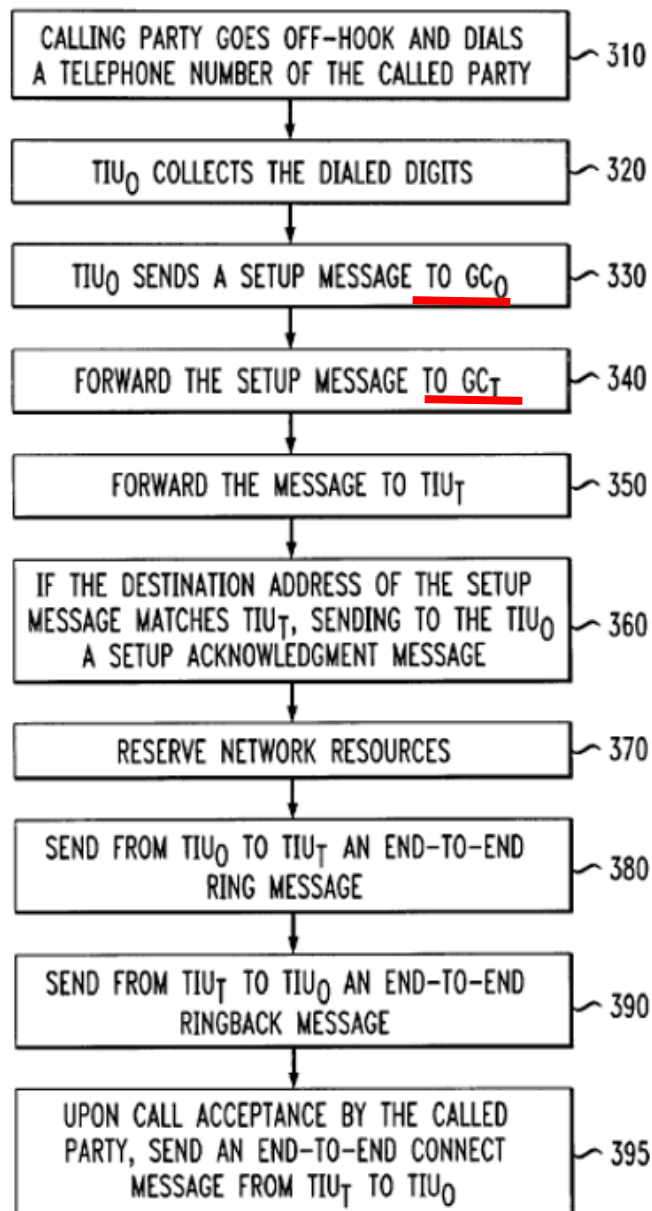
EX1004, Fig. 3 (red underlining added).

As shown in Figure 3 of *Kalmanek*, above, the setup message is sent specifically and directly *to* the "gate controllers". Therefore, as shown over and over again by *Kalmanek* itself, the "gate controllers" do not and cannot "intercept" a setup message because the "gate controllers" are in fact the targeted and intended recipients of the setup message.

Finally, further acknowledging that the claim language itself differentiates a device "intercepting" a message from the "intended recipient", Petitioner argues that the "intended recipient" is the "callee". Pet. 24. While Patent Owner disagrees that this term requires construction, even under Petitioner's own construction, the claim language makes clear the "intended recipient" and the "intercepting" device are not the same. Because as discussed above in Section IV.B.1, if "intercepting" a message merely meant "receiving" a message, then the claim language would be wholly redundant, because the "intended recipient" by definition would receive the message. In other words, the claim language specifically shows that the device "intercepting" of a message cannot be the "intended recipient" of that message.

Petitioner bases its patentability challenges on the erroneous construction that being directly targeted as the intended recipient of a setup message can also mean "intercepting" that message. As previously discussed in Section IV.A.1, above, Petitioner's proposed construction is improper and against the intrinsic evidence and against the understanding of a POSITA. Therefore, for at least this reason alone, the Petition should be denied in its entirety. *See Mentor Graphics Corp.*, IPR2014-00287, 2015 WL 3637569, (Paper 31) at *11 *aff'd sub nom.*

Synopsys, Inc., 669 Fed. Appx. 569

2. Independent Claims 6, 18, and 23

For the corresponding limitation of "intercepting" a message in each of independent claims 6, 18, and 23, Petitioner relies exclusively on its discussion of claim 1:

- Discussing Claim 6:

  - *See* Pet. 43 ("To the extent that there is any difference in scope between claim 1[A] and claim 6[A], the mapping for claim 1[A] establishes that Kalmanek teaches a network intercepting a message, wherein the message is also a signaling message for a call.");

- Discussing Claim 18:

  - *See* Pet. 52 ("See mapping for Claim 1[A]…");

- Discussing claim 23:

  - *See* Pet. 56 ("Claim 23[E] lists a series of steps performed by the program logic, including intercepting a message, associating the message with a service, determining if an end device is authorized to invoke the service, etc. For each of the steps, see mapping for claims 1[A]-1[E] and claims 6[A]-6[E].");

Therefore, for the same reasons discussed in Section IV.B.1, above, the Petition's challenge against independent Claims 6, 18, and 23 also fail.

C. *Kalmanek* Does Not Disclose "a signaling message"

1.   Independent Claim 1

Petitioner argues that *Kalmanek* discloses this limitation in two instances, "codec specification and caller-ID". *See* Pet. 26. However, both examples fail to show the required "signaling messages" of the claim language. Throughout the Petition, including in both of Petitioner's examples here, the Petition relies on *Kalmanek*'s "setup" or "GATESETUP" messages as allegedly being the required "signaling message". But because *Kalmanek*'s "setup" and/or "GATESETUP" messages are not sent by the sender to the "intended recipient device", which is the callee, as required by the previously discussed limitation (*see* Section IV.B), the Petition fails.

The claim language requires that the required "signaling message" be between a sender and intended recipient. For example, Claim 1 recites "a network entity intercepting **a signaling message** associated with a call ***between a sender device*** **of the message and** *an intended recipient device of the message*" EX1001, 19:62-64 (emphasis added). A plain reading of the claim language shows that the "signaling message" must be between the caller and the callee. And this plain understanding of the claim language is supported by Petitioner's own proposed claim construction that "intended recipient" must mean "callee". *See* Pet. 24 ("A POSITA would further recognize that **the "intended recipient device" of a call setup signaling message is the device associated with the callee.**") (emphasis added).

However, as admitted repeatedly in the Petition, *Kalmanek*'s setup or GATESETUP messages are not messages sent between caller and callee. For

example, the Petition, citing to *Kalmanek*, recites: "At step 330, the originating TIU 170 <u>sends a setup message to the originating gate controller</u> 110." Pet 25. (*quoting Kalmanek*) (*emphasis added*); And "<u>Kalmanek teaches the GATESETUP</u> <u>message sent from the gate controller to the edge router</u>." Pet. 28 (emphasis added); And "[a]s explained by Kalmanek at 56:18-24 and FIG. 23, <u>the GC_T sends</u> <u>a SETUP message to BTI_T</u>" Pet. 30 (emphasis added).

Therefore, as required by the claim language, and as admitted by Petitioner's own proposed claim construction, *Kalmanek*'s setup and/or GATESETUP messages are not sent to the callee device, and thus cannot be the required "signaling messages". For this reason alone, the Petition fails.

2. Independent Claims 6, 18, 23, and 24

For the corresponding limitation of a "signaling message" in each of independent claims 6, 18, 23, and 24, Petitioner relies exclusively on its discussion of claim 1:

- Discussing Claim 6:
  - *See* Pet. 43 ("To the extent that there is any difference in scope between claim 1[A] and claim 6[A], the mapping for claim 1[A] establishes that Kalmanek teaches a network intercepting a message, wherein the message is also a signaling message for a call.");
  - *See also* Pet. 44 ("*See* mapping for claim 1[B]")
- Discussing Claim 18:
  - *See* Pet. 52 ("See mapping for Claim 1[A]…");

- Discussing Claim 23:

    o *See* Pet. 56 ("Claim 23[E] lists a series of steps performed by the program logic, including intercepting a message, associating the message with a service, determining if an end device is authorized to invoke the service, etc. For each of the steps, see mapping for claims 1[A]-1[E] and claims 6[A]-6[E].");

- Discussing Claim 24:

    o *See* Pet. 61 ("As discussed above for claim 1[A], the Kalmanek gate controller in combination with the network edge device serve as a network entity intercepting signaling messages.")

Therefore, for the same reasons discussed in Section IV.C.1, above, the Petition's challenge against independent Claims 6, 18, 23, and 24 also fail.

D.   *Kalmanek* Does Not Disclose "the network entity making a determination of whether either the sender device or the intended recipient device is authorized to invoke the type of <u>service indicated in the signaling message</u> based in part on a device profile maintained in part on a remote enforcement point"

1.   Independent Claim 1

The claim language requires that the services are "indicated *in the signaling message*". The Petition relies on two alleged "services" of *Kalmanek*, the so-called caller ID and codec specification "services". As discussed above in Section IV.C, the SETUP message of *Kalmanek* cannot be the required "signaling message", and for at least that reason alone, the Petition fails. However, the SETUP message of *Kalmanek* further fails to disclose the alleged "services" in the SETUP message.

Caller ID [blocking]

The Petition tacitly admits that the SETUP message of *Kalmanek* does not disclose "caller-id blocking" by claiming, without support, that "A POSITA would understand that 'caller-id blocking' ***could be included*** in the originating SETUP message…" Pet. 35 (emphasis added). Petitioner purports to cite to its expert for support, however, its expert provides nothing more than the identical conclusory statement. That is insufficient.

"In appropriate circumstances, a single prior art reference can render a claim obvious. However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion." *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000), *aff'd*, 659 F.3d 1109 (Fed. Cir. 2011). The obviousness analysis must focus on the knowledge and motivations of the skilled artisan at the time of the invention. *InTouch Techs., Inc. v. VGO Commc'ns, Inc.,* 751 F.3d 1327, 1348 (Fed. Cir. 2014). In a case of obviousness, there must be an explanation of why a person of ordinary skill in the art would modify the prior art references to create the claimed invention. *Cutsforth, Inc. v. MotivePower, Inc*., 636 Fed. Appx. 575, 577–78 (Fed. Cir. 2016) *citing In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir.2000); *In re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

Here, Petitioner merely speculates that the SETUP message of *Kalmanek*

could contain "caller-id blocking", but neither Petitioner nor its expert provides any of the required evidence or explanation as to *why* a person of ordinary skill in the art at the time of the invention would modify *Kalmanek* as such. *SIBIA*, 225 F.3d at1356; *InTouch Techs*., 751 F.3d at1348; *In re Kotzab*, 217 F.3d at 1371; *In re Rouffet*, 149 F.3d at 1359. If Petitioner was allowed to simply present as evidence mere speculation about anything that *could have been* invented by *Kalmanek*, then indeed, *Kalmanek* "could" contain every invention past, present, and future.

Moreover, *Kalmanek* itself states that "caller-id blocking" is an inherent feature of the gate controllers in the *Kalmanek* system, and therefore "caller-id blocking" is not part of the SETUP message of *Kalmanek*. *See* EX1004, 7:19-21 ("Service features that depend on the privacy of the calling information, such as caller-ID blocking, are implemented by the gate controllers.")

For sake of completeness, in section "Claim 1[B]" of the Petition, Petitioner points to an "alternative" for "Caller ID/Calling Name Delivery". *See* Pet. 31. First, caller ID is not the "caller-id blocking" alleged by Petitioner in section "Claim 1[C]" of the Petition. Therefore, it is unclear how the disparate "caller ID" discussions throughout the Petition relates to one another. Second, the passage quoted by the Petition in its section "Claim 1[B]" only further confirms that no "caller ID" or "caller-ID blocking" "services" are included in the SETUP message

of *Kalmanek*. Instead, the passage further confirms that it is wholly in the control

of the gate controllers in the system of *Kalmanek*, and that the only thing that

would appear in the SETUP message is name of the caller (i.e., the *result* of caller-

ID, not an indication of the alleged *service*, as required by the claim language). *See*

Pet. 31.

Codec Specification

The Petition also alleges a "codec specification service" disclosed by

Kalmanek. Pet. 36-38. However, the term "codec" never even appears once in

Kalmanek. And "CODEC" was a commonly understood term of art at the time of

the invention, one that the inventors of *Kalmanek* would have known. EX2001, ¶

44. Further, the Petition itself appears confused as to what it refers to as a "codec",

instead the Petition points to what is referred to as the "CODING parameter" and

bandwidth management of *Kalmanek*. Pet. 37.

First, the "CODING parameter" of *Kalmanek* is defined by *Kalmanek* as

how the message originator encapsulates its message:

> CODING specifies a list of possible encapsulations and coding methods that the originator will perform. Each parameter is at least three items separated by commas, where the first item specifies a message size, the second item gives the interval between packets, the third item gives the coding algorithm, and fourth and later items (optional) give additional parameters specific to the coder.

EX1004, 25:54-60.

The above definition provided by *Kalmanek* shows that its CODING

parameter is merely message originator encapsulation. EX2001, ¶¶ 45-46.

Next, neither does the "BANDWIDTH" parameter of *Kalmanek* disclose a

codec:

> BANDWIDTH specifies the maximum bandwidth that may be requested through this gate. Although the parameter includes the coding style, it is not used by the gate. ROLE specifies whether the Edge Router is the originator or terminating side of this conversation. This has importance only if the backbone reservation is bidirectional, and only one of the Edge Routers need do the reservation.

EX1004, 35:6-12 (highlighting added).

As the passage above shows, the "BANDWIDTH" parameter of *Kalmanek*

makes no mention of a codec, only a *coding style*, which refers back to the

message origination encapsulation.

Therefore, because neither the "CODING parameter" or bandwidth

management of *Kalmanek* discloses any "codec specification service", *Kalmanek*

cannot, and does not disclose an indication of a "codec specification service" in its

SETUP message.

2. Independent Claims 6, 18, 23, and 24

For the corresponding limitation of a "the network entity making a

determination of whether either the sender device or the intended recipient device is

authorized to invoke the type of service indicated in the signaling message based in

part on a device profile maintained in part on a remote enforcement point" in each of independent claims 6, 18, 23, and 24, Petitioner relies exclusively on its discussion of claim 1:

- Discussing Claim 6:
  - *See* Pet. 44 ("Claim 6[C] is substantially similar in scope to claim 1[C]. … Therefore, see claim 1[C] for the teachings in Kalmanek.");

- Discussing Claim 18:
  - *See* Pet. 52 ("See mapping for claims 1[C] and 1[D].");

- Discussing Claim 23:
  - *See* Pet. 56 ("Claim 23[E] lists a series of steps performed by the program logic, including intercepting a message, associating the message with a service, determining if an end device is authorized to invoke the service, etc. For each of the steps, see mapping for claims 1[A]-1[E] and claims 6[A]-6[E].");

- Discussing Claim 24:
  - *See* Pet. 62 ("See mapping for claim 1[B]."; and "See mapping for claims 1[C] and 1[E].")

Therefore, for the same reasons discussed in Section IV.D.1, above, the

Petition's challenge against independent Claims 6, 18, 23, and 24 also fail.

E. ***Kalmanek* Does Not Disclose "the network entity filtering the signaling message based on the determination such that the signaling message is transmitted to the intended recipient device if**

either the sender device or the intended recipient device is authorized to invoke <u>the type of service indicated in the signaling message</u>"

1. Independent Claim 1

For this limitation, the Petition relies solely on the alleged "caller-id blocking" "service". *See* Pet. 40. First, Petitioner makes no mention of the alleged "codec specification service" that it discussed in previous limitations, therefore, Petitioner concedes that its alleged "codec specification service" cannot and does not render obvious any of the challenged claims.

Second, as discussed above in Section IV.C, the SETUP message of *Kalmanek* cannot be the required "signaling message", and for at least that reason alone, the Petition fails.

Third, as discussed above in Section IV.D, *Kalmanek* itself states that the "caller-ID blocking" discussed in *Kalmanek* is implemented by its gate controllers, and therefore SETUP message of *Kalmanek* does not contain an indication of the alleged "caller-id blocking" service, as would be required by the claim language.

Thus, for at least the reasons recited above, *Kalmanek* cannot, and does not disclose "the network entity filtering the signaling message based on the determination such that the signaling message is transmitted to the intended recipient device if either the sender device or the intended recipient device is authorized to invoke <u>the type of service indicated in the signaling message</u>", as required by the claim language.

2.   Independent Claims 6, 18, 23, and 24

For the corresponding limitation of a "the network entity making a determination of whether either the sender device or the intended recipient device is authorized to invoke the type of <u>service indicated in the signaling message</u> based in part on a device profile maintained in part on a remote enforcement point" in each of independent claims 6, 18, 23, and 24, Petitioner relies exclusively on its discussion of claim 1:

- Discussing Claim 6:

    o *See* Pet. 45-46 ("Claim 6[E] is substantially similar in scope to claim 1[E].. … For further detail, see the discussion of *Kalmanek* at claim 1[E].");

- Discussing Claim 18:

    o *See* Pet. 53 ("*See* mapping for claim 1[E].");

- Discussing Claim 23:

    o *See* Pet. 56 ("Claim 23[E] lists a series of steps performed by the program logic, including intercepting a message, associating the message with a service, determining if an end device is authorized to invoke the service, etc. For each of the steps, see mapping for claims 1[A]-1[E] and claims 6[A]-6[E].");

- Discussing Claim 24:

    o *See* Pet. 62 ("See mapping for claim 1[B]."; and "See mapping for claims 1[C] and 1[E].", and "See mapping for claim 1[E].")

Therefore, for the same reasons discussed in Section IV.E.1, above, the

Petition's challenge against independent Claims 6, 18, 23, and 24 also fail.

F. The Petition Redundantly Challenges Claim 17

The Petition redundantly challenges Claim 17, without providing any alleged justification for such inefficient redundancies. As the Board has previously explained, "multiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration." *See Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper 7 (P.T.A.B. Oct. 25, 2012). Such redundancies place a significant burden on both the Board and the patent owner, causing unnecessary delay, compounding costs to all parties involved, and compromising the ability to complete review within the statutory deadline. *Id.*; 37 C.F.R. § 42.1(b); *see also* 37 C.F.R. § 42.108. As such, analyzing the petition and eliminating redundant grounds streamlines the proceeding. *Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at 4-5 (P.T.A.B. June 11, 2013); *Liberty Mut.*, CBM2012-00003, Paper 7 at 2.

The Petition presents grounds that are vertically redundant with respect to each other. Vertical redundancy "involves a plurality of prior art applied both in partial combination and in full combination. In the former case, fewer references than the entire combination are sufficient to render a claim obvious, and in the latter case the entire combination is relied on to render the same claim obvious." *Liberty Mut.*, CBM2012-00003, Paper 7 at 3. In such instances where reliance on

a combination and separate reliance on a portion thereof are both alleged to sufficiently present a *prima facie* case of invalidity, "[t]here must be an explanation of why the reliance in part may be the stronger assertion as applied in certain instances **and** why the reliance in whole may also be the stronger assertion in other instances." *Id*. (emphasis in original).

If one of the alternative grounds is better from all perspectives, then the Board should only consider the stronger ground and not burden the Patent Owner and the Board with the weaker ground. Further, if there is no difference in the grounds, the Petitioner should only assert one of the grounds. *Id*. at 12. "Only if the Petitioner reasonably articulates why each ground has strength *and weakness* relative to the other should both grounds be asserted for consideration." *Id*. (emphasis added).

Petitioner makes no effort to justify its vertically redundant theories by explaining why "the reliance in part [e.g., on the primary reference alone] may be the stronger assertion as applied in certain instances and why the reliance in whole [e.g., the full combination of identified references] may also be the stronger assertion in other instances." *Id*. Rather, for Ground 1, Petitioner alleges that "it would have been obvious for the system of Kalmanek to be modified such that it would present an offer to invoke unauthorized services to a requesting user." Pet. 51. And for Ground 4, Petitioner merely offers another reference, *Gleichauf*, without any explanation for its redundancy with Ground 1. Pet. 65-67.

The Board in *Eizo Corp. v. Barco N.V.*[5] flatly rejected a similar attempt to hedge bets and unnecessarily multiply the work of both the Board and the Patent Owner. The Board there found insufficient the petitioner's "conclusory assertion" that "[t]o the extent [the first prior art reference] may not explicitly teach" the limitation, the second prior art reference "explicitly teaches this limitation." The Board explained that "such an assertion fails to resolve the exact differences sought to be derived from" the second prior art reference. *Id*.

The Board's precedential authority on these procedural issues is clear. Here, Petitioner impermissibly seeks the benefit of different bites at the apple, without providing a bi-directional explanation of the relative strengths and weaknesses of each redundantly offered ground. If Petitioner believes the obviousness challenges are necessary to addresses certain weaknesses of the challenge based on *Kalmanek* as a single-reference obviousness combination, Petitioner is obligated to articulate those weaknesses in the Petition itself. Because Petitioner chose to not offer such concessions, presumably for strategic reasons, the Board need not and should not consider the merits of the redundant challenges based on obviousness.

G. The Petition Fails As To The Challenged Dependent Claims

Because the Petition fails as to each of the independent Claims 1, 6, 18, 23, and 24, as described above in Sections IV.A, IV.B, and IV.C, and because each of the challenged dependent claims, Claims 2-5, 7-11, 12-17, 19-21, 22, and 25, depend

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[5] IPR2014-00358, Paper 11 (P.T.A.B. July 23, 2014)

from one of the challenged independent claims, the Petition should be denied in its entirety. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

V.   CONCLUSION

For at least the reasons set forth above, Uniloc respectfully requests that the Board deny all challenges in the instant Petition.[6]

Date: July 20, 2018   Respectfully submitted,

By: /s/ Brett A. Mangrum

Brett A. Mangrum; Reg. No. 64,783

Attorney for Patent Owner

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[6] Patent Owner does not concede, and specifically denies, that there is any legitimacy to any arguments in the instant Petition that are not specifically addressed herein.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), we certify that this Preliminary Response to Petition complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because it contains fewer than the limit of 14,000 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Date: July 20, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), we certify that we served an electronic copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a) along with any accompanying exhibits via the Patent Review Processing System (PRPS) to Petitioner's counsel at the following addresses identified in the Petition's consent to electronic service:

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