UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2019-01026

Patent 6,993,049

PATENT OWNER SUR-REPLY TO PETITION

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I. INTRODUCTION

Uniloc 2017 LLC ("Uniloc" or "Patent Owner") submits this Sur-Reply to the Petition filed by Microsoft Corp. ("Petitioner") for *inter partes* review of United States Patent No. Patent 6,993,049 ("the '049 patent" or "EX1001") in IPR2019-01026. For the reasons given in Uniloc's Response (Paper No. 9, "POR") and herein, Petitioner fails to carry its burden of proving unpatentability of the challenged claims of the '049 patent based on the grounds presented in the Petition.

II. PETITIONER IGNORED RELEVANT DEVELOPMENTS IN RELATED MATTERS

Petitioner neglects to bring to the Board's attention that, approximately one month before Petitioner filed its Reply, the Federal Circuit issued an opinion which reversed and remanded a district court's decision finding that the claims of the '049 patent are directed to patent-ineligible subject matter under § 101. *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303, 1305 (Fed. Cir. 2020).

The Federal Circuit opinion provides a helpful discussion of certain claim language also at issue here (*e.g.*, "adding to an inquiry message prior to transmission an additional data field for polling at least one secondary station."). A portion of that discussion is reproduced below:

> Claim 2 of the '049 patent recites a primary station for use in a communication system "wherein means are provided for ... adding to each inquiry message prior to transmission an additional data field for polling at least one secondary station." '049 patent at Claim 2. The additional data field enables a primary station to simultaneously send inquiry messages and poll

> parked secondary stations. *Id*. at Abstract. The claimed invention therefore eliminates or reduces the delay present in conventional systems where the primary station alternates between polling and sending inquiry messages. *See, e.g., id*. at 2:8–15, 6:55–60. Therefore, like the claims in *DDR*, the claimed invention changes the normal operation of the communication system itself to "overcome a problem specifically arising in the realm of computer networks." *See* 773 F.3d at 1257–58. In doing so, the claimed invention, like the improvement in computer memory we held patent eligible in *Visual Memory*, enables the communication system to accommodate additional devices, such as battery-operated secondary stations, without compromising performance. *See* 867 F.3d at 1258–60.

957 F.3d at 1307–08; *see also id*. at 1205 (further expounding on what the court considered to be example patent-eligible improvements).

Notably, the Federal Circuit also expressly rejected LG's argument on appeal that "the claims [of the '049 patent] merely recite the observation that conventional inquiry messages can accommodate conventional polling 'using result-based functional language' *and generic Bluetooth components*." *Id.* (emphasis added).

III. PETITIONER'S REPLY AND ITS ACCOMPANYING BELATED ARGUMENT AND EVIDENCE UNDERSCORES DEFICIENCIES OF THE PETITION

Petitioner's Reply flagrantly disregards the Consolidated Trial Practice Guide and *Hulu*[1] at least by seeking to introduce entirely new Exhibits 1028–1046, which

[1] *Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039, Paper 20, p. 15-16 (Dec. 20, 2019) (Precedential

constitute nearly 20 distinct documents consisting of literally hundreds of pages. To make matters worse, Petitioner's Reply then makes no citation to the vast majority of these untimely-submitted documents, nor does it attempt to explain their respective significance. It is impermissible to incorporate arguments from one document into another, including by unexplained citations to exhibits. 37 CFR § 42.6(3) ("Arguments must not be incorporated by reference from one document into another document."); *PCT Int'l. Inc. v. Amphenol Corp.*, IPR2013-00229, Paper No. 17 at 2 (PTAB Dec. 24, 2013) ("Arguments must not be incorporated by reference from one document into another document. . . Among other things, this rule prevents parties from avoiding page limitations."). The Board should find this new evidence is entitled to no weight at least because it is untimely and it is not adequately addressed within the Reply itself, if at all.

IV. CLAIM CONSTRUCTION

As explained in Patent Owner's Response, the Petition is tainted by a reliance on erroneous claim constructions. Each erroneous construction presents 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), *affd sub nom., Synopsys, Inc. v. Mentor Graphics Corp.*, 669 Fed. Appx. 569 (Fed. Cir. 2016). Because the Petition was filed after November 13, 2018, the Board interprets the claim terms here using "the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b) (2019).

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