IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MARVELL SEMICONDUCTOR, INC.,

Petitioner,

v.

UNILOC 2017 LLC,

Patent Owner.

_____

Case No. IPR2019-01350

U.S. Patent 7,016,676

_____

PETITIONER'S REPLY

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The challenged claims are rendered obvious by Sherman, which teaches the same technique for alternating between the same wireless standards described in the '676 patent—HIPERLAN/2 and IEEE 802.11a—and by Shellhammer, which teaches alternate access for two standards that Uniloc accuses of infringement in district court—Bluetooth and IEEE 802.11. Ex. 1003 ¶¶242-243. Each reference renders the challenged claims obvious, as explained by Dr. Roy.

In response, Uniloc offers nothing more than attorney argument. Uniloc declined to take Dr. Roy's deposition and offers no expert testimony of its own. The only exhibit submitted by Uniloc (Exhibit 2001) is a non-certified copy of a German PCT application allegedly showing an earlier priority but otherwise having no relevance to the obviousness of the challenged claims. Uniloc's arguments are replete with errors and unsupported by any evidence.

Unable to contest the facts, Uniloc asks the Board to create new law by imposing a "branching process flow" requirement on *Schulhauser*. But the Board has already rejected such a requirement, which would be at odds with the Federal Circuit cases on which *Schulhauser* was based.

Uniloc is wrong on the facts and the law. Petitioner respectfully requests that the Board finds claims 3, 6, 7, and 9 unpatentable.

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I. The '676 Patent Is Not Entitled to a Foreign Priority Claim.

During the prosecution of the '676 patent, the applicant failed to provide a certified copy of the foreign priority application and therefore cannot claim priority to it. Even if an earlier priority date were possible, that would only affect Ground 1 (Sherman) but not Ground 2 (Shellhammer).

A. Uniloc failed to carry its burden of proof.

Uniloc attempts to shift the burden to Petitioner. POR, 7. But "a patentee bears the burden of establishing that its claimed invention is entitled to an earlier priority date …" *See In re Magnum Oil Tools Int'l Ltd*., 829 F.3d 1364, 1376 (Fed. Cir. 2016); *Oasis, Inc. et al. v. T-Mobile USA Inc*. (Appeal No. 2007-1265, decided April 11, 2008). Uniloc has failed to meet its burden, and the record establishes the '676 patent is not entitled to an earlier priority date.

B. The applicant failed to perfect its foreign priority claim.

The Examiner was correct in rejecting the applicant's foreign priority claim because the applicant failed to furnish a certified copy of the foreign priority application (German application No. DE10039532.5) during the prosecution of the '676 patent, as required by 37 C.F.R. 1.55(g)(1) ("The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 ***must, in any event, be filed within the pendency of the application***…") (emphasis added). A certified copy the German application appears nowhere in the prosecution history. *See generally*, Ex. 1002.

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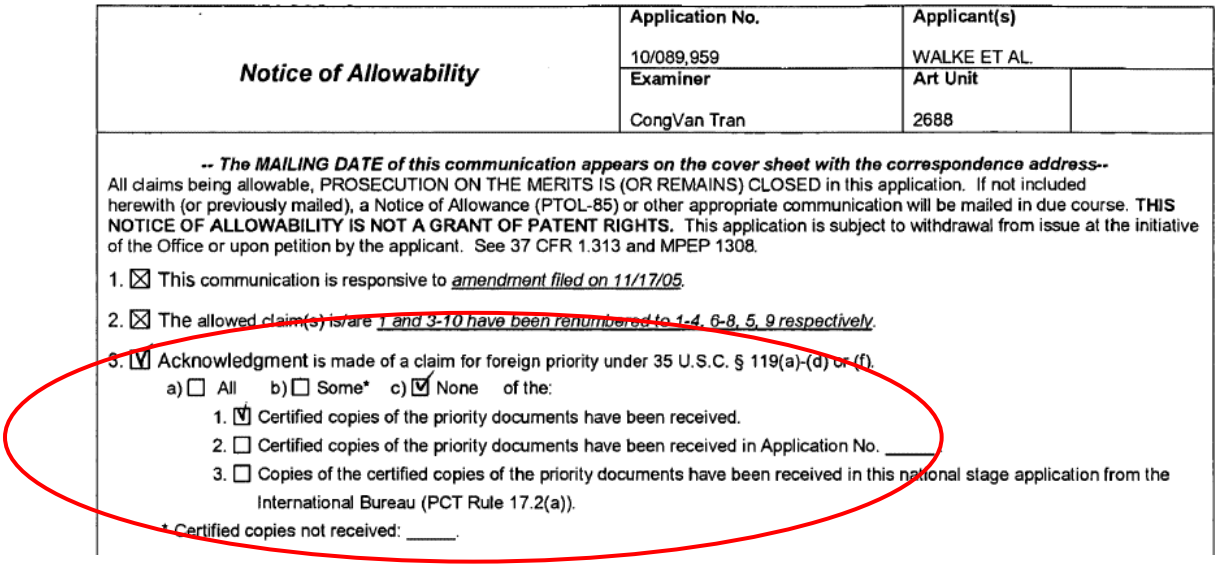
Three documents in the file history confirm that the USPTO did not receive a certified copy. First, the Examiner indicated on the Notice of Allowance that the USPTO had not received any priority documents. *See* Ex. 1002, 0152:



Notice of Allowability	Application No. 10/089,959	Applicant(s) WALKE ET AL.	
	Examiner CongVan Tran	Art Unit 2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *amendment filed on 11/17/05*.
2. ☒ The allowed ~~claim(s) is/are~~ *1 and 3-10 have been renumbered to 1-4, 6-8, 5, 9 respectively*.
3. ☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☑ None of the:
      1. ☑ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Second, the Examiner indicated on a Bibliographic Data Sheet that the application did not meet the conditions in 35 U.S.C. § 119(a)-(d) for a foreign priority claim. *See* Ex. 1002, 0155:

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