UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2019-01471
PATENT 6,836,654

PATENT OWNER SUR-REPLY
TO PETITIONER'S REPLY

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EXHIBITS

2001	Memorandum Opinion on Claim Construction, *Uniloc 2017 LLC v. Motorola Mobility, LLC*, 1-18-cv-01841 (consolidated with 1-18-cv-01844), Dkt. 72 (D. Del. Jan. 17, 2020)
2002	Claim Construction Order, *Uniloc 2017 LLC v. Motorola Mobility, LLC*, 1-18-cv-018441 (consolidated with 1-18-cv-01844), Dkt. 75 (D. Del. Jan. 23, 2020)
2003	Claim Construction Memorandum Opinion and Order, *Uniloc 2017 LLC v. Samsung Electronics America, Inc.*, 2-18-cv-00508, Dkt. 61 (E.D. Tex. Jan. 20, 2020)
2004	Order, *Uniloc 2017 LLC v. Samsung Electronics America, Inc.*, 2-18-cv-00508, Dkt. 71 (E.D. Tex. Feb. 26, 2020) (adopting magistrate's claim construction order and overruling objections)
2005	Claim Construction Memorandum Opinion and Order, *Uniloc 2017 LLC v. Google LLC*, 2-18-cv-00493, Dkt. 165 (E.D. Tex. Jan. 20, 2020)
2006	Order, *Uniloc 2017 LLC v. Google LLC*, 2-18-cv-00493, Dkt. 212 (E.D. Tex. Mar. 23, 2020) (adopting magistrate's claim construction order and overruling objections)

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. 6,836,654 ("the '654 patent" or "Ex. 1001") in IPR2019-01471.[1] 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 10–20 of the '654 patent based on the grounds presented in the Petition.

II. CLAIM CONSTRUCTION DISPUTE IS DISPOSITIVE IN FAVOR OF PATENTABILITY

Resolution of the claim construction dispute injected by Petitioner is straightforward and dispositive. If the Board adopts the same claim construction ordered in district court, and addressed in the parties' respective briefing, then the Petition should be denied in its entirety as being impermissibly keyed to the wrong claim construction. *See* Reply 1–3. The disputed claim language is recited in each challenged claim as "verifying a user identification module mounted inside the mobile radiotelephony device is linked to the mobile radiotelephony device." Patent Owner had observed that the Petition advances no obviousness theory under a construction (as adopted in district court) that a "user identification module … linked to the mobile radiotelephony device" means "a user identification module that is the only one that permits normal operation of the device." POR 2. In its Reply,

[1] Per the Board's Decision Granting Institution and Joinder in IPR2020-00701, Apple Inc. and Motorola Mobility LLC have been joined as petitioners to this proceeding. *Apple Inc. et. al. v. Uniloc 2017 LLC*, IPR2020-00701, Paper 14 (PTAB Aug. 12, 2020). All petitioners are referred to herein collectively as Petitioner.

Petitioner challenges the same district court construction as purportedly "not found either in the claims, or the specification." Reply 2.

It is well established that *inter partes* review petitioners cannot prove obviousness through application of an erroneous claim construction. *See, e.g.*, *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) (denying petition as tainted by reliance on an incorrect claim construction); *Vivint, Inc. v. Alarm.com Inc.*, 754 F. App'x 999, 1005 (Fed. Cir. 2018) (vacating and remanding, in part, because Board had adopted and applied certain incorrect claim constructions); *Int'l Bus. Machines Corp. (IBM) v. Iancu*, 759 F. App'x 1002, 1005–06 (Fed. Cir. 2019) (finding that the Board's interpretation of key claim limitations was incorrect resulting in the Board's decisions having errors).

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) (effective November 13, 2018). In addition, "[a]ny prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the inter partes review proceeding will be considered." *Id*.

In its Reply, Petitioner attacks the district court reasoning set forth in its orders filed as Exhibit 2005 (Claim Construction Memorandum Opinion and Order, Uniloc

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