

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2020-00038

PATENT 6,868,079

PATENT OWNER PRELIMINARY RESPONSE TO PETITION

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I. INTRODUCTION

Uniloc 2017 LLC (the “Uniloc” or “Patent Owner”) submits this Preliminary Response to Petition IPR2020-00038 for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 6,868,079 (“the ’079 patent” or “EX1001”) filed by Motorola Mobility LLC (“Petitioner”). The instant Petition is procedurally and substantively defective for at least the reasons set forth herein.

As discussed in detail below in Section VI.C, the sole claim challenged here, claim 17, provides for an improvement in wireless communication between a base station and secondary stations, and in particular in connection with requests from secondary stations for allocation of additional slots to send data to the base station. In the method of claim 17, a secondary station, after sending to the base station a request for an allocation of additional time slots, rather than waiting for an acknowledgment, re-transmits the request for the allocation in consecutive allocated time slots without waiting for an acknowledgement. The Petitioner relies, as to both Ground 1 and Ground 2, on the Kay reference for this teaching. Kay does not teach re-transmission in consecutive allocated slots, however, and insufficient reason is given for modifying Merakos to re-transmit in consecutive allocated slots. Accordingly, the prior art cited by the Petitioner fails to provide a basis for institution of *Inter Partes* Review here, and for this reason, as well as the other reasons set forth below, institution should be denied.

II. THE '079 PATENT

The '079 patent is titled “Radio communication system with request re-transmission until acknowledged.” The '079 patent issued March 15, 2005, from U.S. Patent Application No. 09/455,124 filed December 6, 1999, which claims priority to United Kingdom Patent Application No. GB9827182, filed December 10, 1998.

The inventors of the '079 patent observed that in radio communication systems at the time, it was generally required to be able to exchange signaling messages between a Mobile Station (MS) and a Base Station (BS). Downlink signaling (from BS to MS) was usually realized by using a physical broadcast channel of the BS to address any MS in its coverage area. Since only one transmitter (the BS) uses this broadcast channel there is no access problem. EX1001, 1:17-23.

However, uplink signaling (from MS to BS) required more detailed considerations. If the MS already had an uplink channel assigned to it, for voice or data services, this signaling could be achieved by piggybacking, in which the signaling messages are attached to data packets being sent from the MS to the BS. But if there was no uplink channel assigned to the MS, piggybacking is not possible. In this case it would be desirable to have a fast uplink signaling mechanism be available for the establishment, or re-establishment, of a new uplink channel. EX1001, 1:24-33.

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