

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 RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. § 42.120

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I. INTRODUCTION

Uniloc 2017 LLC (the “Uniloc” or “Patent Owner”) submits this Response to Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 6,868,079 (“the ’079 patent” or “Ex. 1001”) filed by Motorola Mobility LLC (“Petitioner”) in IPR2020-00038.

In view of the reasons presented herein, the Petition should be denied in its entirety, as Petitioner has failed to meet its burden of showing that any challenged claim is unpatentable. 35 U.S.C. § 316(e). While the Board instituted trial here, as the Court of Appeals has stated:

[T]here is a significant difference between a petitioner’s burden to establish a “reasonable likelihood of success” at institution, and actually proving invalidity by a preponderance of the evidence at trial. *Compare* 35 U.S.C. § 314(a) (standard for institution of *inter partes* review), with 35 U.S.C. § 316(e) (burden of proving invalidity during *inter partes* review).

Trivascular, Inc. v. Samuels, 812 F.3d 1056, 1068 (Fed. Cir. 2016). Petitioner has failed to meet its burden of proving any proposition of invalidity, as to any claim, by a preponderance of the evidence. 35 U.S.C. §316 (e).

The sole claim challenged here, claim 17, reflects teachings in the ’079 patent directed to technical improvements involving requests from secondary stations for allocation of additional slots to communicate with a 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, 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. Among other deficiencies, Petitioner at least fails to establish, by a preponderance of evidence, that Kay renders obvious limitation direction to re-transmission in consecutive allocated slots; and Petitioner also fails to prove sufficient motivation to modify Merakos to re-transmit in consecutive allocated slots. For at least these reasons, and for the other reasons set forth below, the Petitioner should be denied as failing to prove obvious for each and every claim element.

II. OVERVIEW OF 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. Ex. 1001, 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 available for the establishment, or re-establishment, of a new uplink channel. *Id.*, 1:24–33.

In conventional systems at the time, for example those operating in accordance with the Global System for Mobile communication (GSM) standard, fast uplink signaling was enabled by the provision of a random-access channel using a slotted ALOHA or similar protocol. However, such a scheme works satisfactorily only with a low traffic load and was not believed to be capable of handling the requirements imposed by third-generation telecommunications standards such as UMTS. *Id.*, 1:34–41.

According to certain embodiments, a system and method is provided to improve the efficiency of the method by which a MS requests resources from a BS. A method implementation, for example, involves operating a radio communication system, comprising a secondary station transmitting a request for resources to a primary station in a time slot allocated to the secondary station. The method is characterized, at least in part, by the secondary station re-transmitting the same request in consecutive allocated time slots, without waiting for an acknowledgment, until an acknowledgement is received from the primary station. *Id.*, 1:60–67.

Certain disclosed schemes may improve the typical time for a response by the primary station to a request by a secondary station. Because there is no possibility of requests from different secondary stations colliding, a secondary station can

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