

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2020-00755

PATENT 6,366,908

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. §42.107(a)**

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CERTIFICATE OF COMPLIANCE.....i

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EXHIBIT LIST

Exhibit	Description
2001	Google's Invalidation Contentions in <i>Uniloc 2017 LLC v. Google LLC</i> , No. 2:18-cv-553 (E.D. Tex.), dated August 26, 2019.
2002	Exhibit A-18 to Google's Invalidation Contentions in <i>Uniloc 2017 LLC v. Google LLC</i> , No. 2:18-cv-553 (E.D. Tex.), dated August 26, 2019.

I. INTRODUCTION

Uniloc 2017 LLC (“Uniloc” or “Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 6,366,908 (“the ’908 patent” or “Ex. 1001”) filed by Google LLC (“Google” or “Petitioner”) in IPR2020-00755. The Petition purports to challenge independent claim 6 and claims 7–12 depending directly or indirectly therefrom.

As threshold matter, the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a) and precedential authority interpreting the same, including *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential) (“*NHK*”) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (discussing *NHK*).

Because, as a threshold issue, denial is independently warranted under 35 U.S.C. § 314(a), the Board need not reach the substantive merits of the Petition. A substantive analysis is nevertheless presented herein because the Board has held that “weakness on the merits” also weighs in favor of discretionary denial under 35 U.S.C. § 314(a) and *NHK*, particularly when (like here) this factor is coupled with an earlier district court trial date. *Apple v. Fintiv*, IPR2020-00019, Slip Op. 15 (citing *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00162, Paper 16 at 8, 13, 20 (PTAB June 5, 2019)).

II. OVERVIEW OF THE ’908 PATENT

The ’908 patent, titled “Keyfact-Based Text Retrieval System, Keyfact-based Text Index Method, and Retrieval Method,” issued on April 2, 2002 and claims priority to a foreign counterpart application filed on Dec. 30, 1999—*two decades ago*.

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