

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2020-00756

PATENT 9,564,952

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

TABLE OF CONTENTS

Exhibit List.....	iii
I. INTRODUCTION.....	1
II. OVERVIEW OF THE '952 PATENT.....	1
III. RELATED PROCEEDINGS.....	6
IV. THE BOARD SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION.....	6
A. The litigation is not stayed and there is no evidence it will be.	7
B. Fully overlapping substantive issues warrant discretionary denial.....	9
C. The investment in the parallel litigation, prior to transfer, weighs in favor of discretionary denial.....	13
D. Additional factors further weighing in favor of discretionary denial.	14
V. LEVEL OF ORDINARY SKILL IN THE ART	15
VI. CLAIM CONSTRUCTION	15
A. Overview of claim construction positions advanced by the parties in parallel litigation.....	17
VII. GOOGLE DOES NOT PROVE A REASONABLE LIKELIHOOD OF UNPATENTABILITY FOR ANY CHALLENGED CLAIM.....	18
A. Example substantive deficiencies arising from limitations directed to what the transmitted “content” must include	20
1. Petitioner’s reliance on Suprenant is predicated on fallacy.....	20
2. Petitioner incorrectly asserts the combination of “content” limitations recite nothing more than admitted prior art	22

B.	Example substantive deficiencies arising from “scanning a plurality of predetermined frequencies for a free frequency”	25
C.	No Prima Facie Obviousness for any challenged dependent claim	27
VIII.	CONCLUSION	28
	CERTIFICATE OF COMPLIANCE	i
	CERTIFICATE OF SERVICE	ii

EXHIBIT LIST

Exhibit	Description
2001	Google's Invalidity Contentions in <i>Uniloc 2017 LLC v. Google LLC</i> , No. 2:18-cv-552 (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. 9,564,952 (“the ’952 patent” or “Ex. 1001”) filed by Google LLC (“Google” or “Petitioner”) in IPR2020-00756. The Petition purports to challenge independent claim 9 and claims 10–12 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. Intriplex 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 ’952 PATENT

The ’952 patent, titled “Near Field Authentication Through Communication of Enclosed Content Sound Waves,” issued on Feb. 7, 2017 and claims priority to a provisional application filed on Feb. 6, 2012.

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