

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)**

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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-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. 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 ’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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