UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

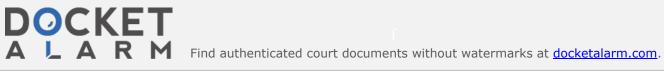
IPR2020-00757 PATENT 7,012,960

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



TABLE OF CONTENTS

Exh	ibit I	_ist i		
I.	INTRODUCTION			
II.	OVERVIEW OF THE '960 PATENT			
III.	RELATED PROCEEDINGS			
IV.	THE BOARD SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION			
	A.	The litigation is not stayed and there is no evidence it will be		
	B.	Fully overlapping substantive issues warrant discretionary denial		
	C.	The investment in the parallel litigation, prior to transfer, weighs in favor of discretionary denial		
	D.	Additional factors further weighing in favor of discretionary denial1		
V.	LEV	/EL OF ORDINARY SKILL IN THE ART1		
VI.	CLAIM CONSTRUCTION			
	A.	Overview of claim construction positions advanced by the parties in parallel litigation		
	A.	"wherein the recursive filtering step is intended to use a recursive filter such as: Rf[i]=(1—.alpha.[i]) (R1[i]+Rmc[i]), where Rf[i], R1[i] and Rmc[i] are transformed coefficients comprised in the transformed signals (Rf,R1,Rmc) and .alpha.[i] is a filter coefficient comprised between 0 and 1"		
	B.	"transformed signal" (claims 1, 4) and "transformed coefficients" (claim 1)		
	C.	"transformed motion-compensated signal" (claims 1, 4)1		
VII.	GO	OGLE DOES NOT PROVE A REASONABLE		



IPR2020-00757 U.S. Patent No. 7,012,960

LIK	KELIHOOD OF UNPATENTABILITY FOR ANY	
CH	ALLENGED CLAIM	19
A.	Example substantive deficiencies arising from limitations directed to a recursive filtering step	21
В.	Example substantive deficiencies arising from limitations directed to a spatial filtering step	27
C.	No Prima Facie Obviousness for dependent claim 5	35
VIII.	CONCLUSION	36
CERTIF	FICATE OF COMPLIANCE	i
CEDTIE	NCATE OF SEDVICE	;;



EXHIBIT LIST

Exhibit	Description
2001	Google's Invalidity Contentions in <i>Uniloc 2017 LLC v. Google LLC</i> , No. 2:18-cv-551 (E.D. Tex.), dated August 26, 2019.
2001	Uniloc's Reply Claim Construction Brief filed in <i>Uniloc 2017 LLC v</i> . <i>Google LLC</i> , No. 2:18-cv-551 (E.D. Tex.) as Dkt. No. 136, dated January 30, 2020.



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. 7,012,960 ("the '960 patent" or "Ex. 1001") filed by Google LLC ("Google" or "Petitioner") in IPR2020-00757. The Petition purports to challenge independent claims 1 and 4 and dependent claim 5.

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 '960 PATENT

The '960 patent, titled "Method of transcoding and transcoding device with embedded filters," issued on Mar. 14, 2006, and claims priority to a foreign patent applications filed Oct. 24, 2000 and Mar. 6, 2001.



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

