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)

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EXHIBIT LIST

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

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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.

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