

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON DIGITAL SERVICES, INC., AMAZON
FULFILLMENT SERVICES, INC., HULU, LLC, and NETFLIX, INC.,
Petitioners

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owners

IPR2017-00948
PATENT 8,566,960

**PATENT OWNER'S CONTINGENT MOTION TO
AMEND CLAIMS 1, 22, and 25 OF U.S. PATENT NO. 8,566,960
UNDER 37 C.F.R. § 42.121**

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UPDATED LIST OF EXHIBITS

Exhibit No.	Description
2001	Declaration of Dr. Val DiEuliis (<i>previously filed</i>)
2002	Petitioner's Motion before the District Court (<i>previously filed</i>)
2003	Dr. Rubin's Deposition Transcript (<i>newly filed</i>)
2004	U.S. Application Serial No. 12/272,570 or "the '570 Application" (<i>newly filed</i>)
2005	U.S. Application Serial No. 60/988,778 or "the '778 Application" (<i>newly filed</i>)

I. STATEMENT OF RELIEF REQUESTED

To the extent the Board finds independent claims 1, 22, or 25 unpatentable, Uniloc Luxembourg S.A. (“Patent Owner”) moves to amend U.S. Patent No. 8,566,960 (“the ’960 patent”) by replacing the claim(s) deemed unpatentable with a corresponding one of the proposed substitute independent Claims 26, 27, or 28. *See* 37 C.F.R. §§ 42.22(a)(2); 42.121; 35 U.S.C. § 316(d).

II. INTRODUCTION

The proposed substitute claims satisfy the statutory and regulatory requirements. No more than one substitute claim is proposed for each challenged claim. 37 C.F.R. § 42.121(a)(3). The proposed substitute claims do not enlarge the scope of the issued claims and do not introduce new matter. 37 C.F.R. § 42.221(a)(2)(ii); 35 U.S.C. § 316(d)(3). The amendments simply clarify the meaning of the claims in a manner that is consistent with the description of the inventions in the specifications as originally filed. The amendments are responsive to a ground of unpatentability involved in the trial. 37 C.F.R. § 42.121.

The Board verbally acknowledged that the scheduled conference call between the parties and the Board, which took place on November 8, 2017, satisfies Rule 42.221. During the conference call, the Board confirmed that trial will continue to proceed pursuant to the Scheduling Order (Paper 11) entered in this matter on August 14, 2017. This Motion is timely filed by Due Date 1 of the Scheduling Order.

III. LISTING OF CLAIM AMENDMENTS

The following is a complete listing of amendments with a correlation of the substitute claim to the original claim. *See* 37 C.F.R. § 42.121(b).

Claims 1-25 (Instituted)

Claim 26 (Proposed substitute for original independent Claim 1)

Claim 27 (Proposed substitute for original independent Claim 22)

Claim 28 (Proposed substitute for original independent Claim 25)

Pursuant to 37 C.F.R. § 42.221(3)(b), Appendix A attached hereto provides a complete listing of proposed contingent claim amendments with a correlation of the substitute claims to the originally challenged claims. Patent Owner contingently proposes amendments affecting only challenged independent Claims 1, 22, and 25. No proposed amendments are made to any dependent claims. It is intended that the antecedent claims referenced in the dependent claims will reflect proper claim dependency if the proposed substitute claims are entered (*e.g.*, if proposed Claim 26 is entered, the dependent claims previously depending from Claim 1 will then depend, instead, from Claim 26, and so forth).

IV. SCOPE OF THE PROPOSED SUBSTITUTE CLAIMS

Each proposed substitute claim corresponds to a respective claim originally challenged in the Petition, thereby satisfying the provision that “only one substitute claim would be needed to replace each challenged claim.” *See* 37 C.F.R. § 42.121(a)(3). The proposed substitute claims do not enlarge the scope of the originally challenged claims or introduce new matter. 37 C.F.R. § 42.121(2)(ii); 35 U.S.C. § 316(d)(3). Specifically, the claim language originally recited in the challenged Claims 1, 22, and 25 is recited in the proposed substitute Claims 26, 27, and 28, respectively, together with several clarifying amendments that do not enlarge claim scope.

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