UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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

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IPR2017-00948

PATENT 8,566,960

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PATENT OWNER'S REPLY FOR 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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LIST OF EXHIBITS

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

I.   INTRODUCTION

The Motion (Paper 17 or "Mot.") should be granted because (1) it is uncontested that the amendment is adequately supported; (2) it is uncontested that the amendment responds to a ground of unpatentability in the trial; (3) Petitioner's party admissions confirm that the amendment does not enlarge claim scope; and (4) Petitioner has not met its burden to prove unpatentability of the substitute claims.[1]

II.   THE AMENDMENT DOES NOT ENLARGE CLAIM SCOPE

Petitioner's sole challenge to the Motion itself is that the amendment is allegedly broadening because it removes claim language originally recited in the "verify[ing]" limitations. Paper 19 ("Opp.") at 22. However, Petitioner's former party admissions undermine its interpretation of the scope of the substitute claims.

The Board observed in its Institution Decision that the Petition essentially interprets the original "verify[ing]" limitations as "set[ing] forth a test" that encompasses determining whether the "device identity" is on a "record" as claimed. *See* Paper 10 at 8, 10. The substitute claims make this "determining" an additional and explicit requirement. Thus, Petitioner's acknowledgment of structure encompassed by the original claims confirms that the substitute claims are not broader in scope. *See Lavergne v. Concrete*, 899 F.2d 1228 (Fed. Cir. 1990) ("claims are broadened if it is possible to read those claims on structures that could not have been covered by the original claims, … a situation that does not here

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[1] *See Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1305-06 (Fed. Cir. 2017) ("*Aqua Prod.*") (holding that once the patent owner establishes that its amendment is non-broadening, supported, and responsive to a ground already at issue, the petitioner must satisfy its burden to prove the amended claims are not patentable).

prevail"). A*rcelormittal France v. AK Steel Corp.*, 786 F.3d 885, 891-92 (Fed. Cir. 2015) (in reissue proceedings, an amendment is not broadening when it recites adjudicated scope of the original claims).

It is also significant, and narrowing in scope, that the "determin[ing]" limitations are recited *in addition to* the "verify[ing]" limitations and must be "in response to the license data being verified as valid". In addressing the original claim language, a dispute arose as to whether "[verify/verifying] that a license data associated with the digital product is valid" requires deeming the "license data" to be "valid." Paper 10 at 10-11. The newly-added limitation "in response to the license data being verified as valid" makes such a requirement explicit as a condition precedent to the additional "determin[ing]" limitations, thereby expressly interrelating the "verify[ing]" and "determin[ing]" limitations and further ensuring the substitute claims are not broader in scope.

III. PETITIONER FAILS TO PROVE THE AMENDED CLAIMS ARE NOT PATENTABLE OVER THE CITED ART

Petitioner dedicates a scant portion of its Opposition to address its burden of proving unpatentability based on the cited references. The short-shrift analysis does not even purport to address the entirety of the claim language on an element-by-element basis, as is required. Rather, the Opposition admittedly focuses on alleged "differences between the original and substitute claims" ostensibly "[b]ecause the motion assumes that all features of the original claims were known in and/or not patentably distinct over the prior art." Opp. 12. However, Uniloc's Motion does not concede that the original claims recite no patentable features; and Petitioner provides

no citation to suggest otherwise. On the contrary, the Motion emphasizes how certain claim amendments clarify the meaning of patentable claim language *recited in the original claims*. For example, the Motion explains in detail how the recitation "temporarily adjust the allowed copy count from its current number to a different number by setting the allowed copy count to a first upper limit for a first time period" further defines the patentable "set[ting]" limitations recited in the original claims. *See*, *e.g.*, Paper 17 (Motion) at 9-15. The deficiencies of the Opposition identified herein apply in general to all substitute claims 26, 27, and 28.

A.   The conditional "temporarily adjust" limitations

Petitioner fails to prove that the cited references render obvious the recitation "in response to the device identity not currently being on the record, temporarily adjust the allowed copy count from its current number to a different number by setting the allowed copy count to a first upper limit for a first time period …." Petitioner does not purport to address this specific claim language in its Opposition. Instead, Petitioner relies exclusively on *DeMello* as allegedly disclosing that "[w]hen a device is not in the record of activated devices, the disclosed process proceeds to determine what device limit to apply and if that device limit has been met." Reply at 17 (citing EX1003 at 22:51-56). Petitioner cannot prove obviousness by addressing something other than what the amended claims recite.

Moreover, Petitioner's primary citation to *DeMello* teaches away from the claimed conditional and temporary adjustment by disclosing that "an error message is rendered" if the preestablished limit has been reached:

Next, it is determined at step 164 if this is a *new activation* for the

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