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 RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. § 42.120**

TABLE OF CONTENTS

UPDATED LIST OF EXHIBITS

Exhibit No.	Description
2001	Declaration of Dr. Val DiEuliis (*filed previously in this matter*)
2002	Petitioner's Motion before the District Court (*previously filed*)
2003	Dr. Rubin's Deposition Transcript (*newly filed*)

I.   INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.120, Uniloc Luxembourg S.A. ("Patent Owner") submits this Response to the Petition for *Inter Partes* Review ("the Petition") of U.S. Patent No. 8,566,960 ("the '960 Patent") filed by Amazon.com, Inc., Amazon Digital Services, Inc., Amazon Fulfillment Services, Inc., Hulu LLC, and Netflix, Inc. (collectively, "Petitioner").

The Petition injects several fully-dispositive claim construction disputes. This Response identifies multiple substantive deficiencies in the Petition derived from Petitioner's erroneous claim constructions. Petitioner cannot prove unpatentability through application of an erroneous construction. *See Mentor Graphics Corp., v. Synopsys, Inc.*, IPR2014-00287, 2015 WL 3637569, at *11 (P.T.A.B. June 11, 2015), *aff'd sub nom. Synopsys, Inc. v. Mentor Graphics Corp.*, 669 Fed. Appx. 569 (Fed. Cir. 2016) (denying Petition as tainted by reliance on an incorrect claim construction).

With the benefit of a more complete record, including the concessions Petitioner offered through its expert that undermine the constructions set forth in the Petition, the Board is urged to reconsider some of its preliminary findings concerning claim construction, as set forth in its Institution Decision. *See* IPR2017-00948, Paper No. 10. If the Board ultimately is disinclined to adopt Patent Owner's claim constructions concerning the original claims challenged in the Petition, Patent Owner respectfully submits that entry of the clarifying claim amendments set forth in its Contingent Motion to Amend (filed concurrently herewith) would greatly simplify resolution of the disputes over claim interpretation.

II.   RELATED MATTERS

This is not the first post-issuance proceeding the Board has considered. The '960 patent was also the subject of an *inter partes* review petition filed on June 29, 2016 by Unified Patents: *Unified Patents Inc. v. Uniloc Luxemburg S.A.*, IPR2016-01271. On January 9, 2017, the Board entered a Decision Denying Institution of *Inter Partes* Review, terminating that proceeding. *See* EX1006.

Patent Owner notes that since the filing of the present Petition, Google Inc. (now Google LLC) filed another largely duplicative petition against the '960 patent. *See Google LLC v. Uniloc Luxemburg S.A.*, IPR2017-01655. Google's petition copied the same arguments as the present Petition and introduced a vertically-redundant obviousness challenge, which added a third reference, U.S. Patent No. 7,962,424, to the same combination presented in the instant Petition.

The Petition appears to provide an accurate summary of related litigation concerning the '960 patent. *See* Pet. 2–3.

III.   THE '960 PATENT

A.   Overview of the '960 Patent

During prosecution, Applicant offered the following overview of the '960 patent:

> The present application ("Richardson") discloses an invention for a system that automatically adjusts usage limitations on licensed software. The adjustable license is based on exploitation of an advanced technique for generating a "device fingerprint" or "device identifier" for each of many computers that a single licensee may use to execute the licensed software. The device

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