UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.
Petitioner,

v.

UNILOC USA, INC.
Patent Owner

Case IPR2017-01665
U.S. Patent 8,566,960

DECLARATION OF DR. VAL DIEULIIS

OCTOBER 18, 2017

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

1. INTRODUCTION 4

2. QUALIFICATIONS 5

3. COMPENSATION, TESTIMONY, AND PUBLICATIONS 8

4. INFORMATION CONSIDERED 10

5. LEGAL STANDARDS 10

6. THE '960 PATENT 12

6.1 Ordinary Skill in the Art 22

6.2 Claim Construction 23

6.2.1 A POSITA would have understood the preambles of claims 1 and 22 teach "adjusting a license" that includes an "allowed copy count" 24

6.2.2 "a first time period after an initial authorization of the digital product" (claim 25) 28

7. U.S. PATENT NO. 7,047,411 ("DEMELLO") 29

8. IRISH PATENT APPLICATION NO. 02/0429 ("STARUIALA") 31

9. U.S. PATENT NO. 7,962,424 ("COLOSSO") 34

10. DEMELLO IN VIEW OF STARUIALA FAILS TO RENDER OBVIOUS ANY CHALLENGED CLAIM OF THE '960 PATENT 35

10.1 The proposed combination DeMello and Staruiala fails to render obvious "verify that a license data associated with the digital product is valid based at least in part on a device identity generated by sampling physical parameters of the given device" 36

10.1.1 Staruiala fails to remedy the deficiencies in DeMello 42

10.1.2 Colosso fails to remedy the deficiencies in the proposed combination of DeMello and Staruiala 43

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

10.2 DeMello fails to disclose or render obvious "in response to the device identity not being on the record, set the allowed copy count to a first upper limit for a first time period" 48

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

I, Dr. Val DiEuliis, hereby declare and state as follows:

1. Introduction

1. My name is Val DiEuliis, and I have been retained by Uniloc USA, Inc. ("Uniloc" or the "Patent Owner"). My client Uniloc and its associated counsel, Etheridge Law Group, have asked me to study U.S. Patent No. 8,566,960 ("the '960 patent"), the Petition, the proffered prior art in this case, and other relevant documents. I document my findings in this declaration.

2. I have concluded that U.S. Patent No. 7,047,411 ("DeMello") [EX1004], alone or in view of Irish Patent Application IE 02/0429 ("Staruiala") [EX1005] and U.S. Patent No. 7,962,424 ("Colosso") [EX1006], does not render obvious any challenged claim of the patent at issue, the'960 patent, at least for the following reasons:

- The proposed combinations of prior art do not disclose "verify that a license data associated with the digital product is valid based at least in part on a device identity generated by sampling physical parameters of the given device"
- A POSITA on the priority date would not have been motivated to combine Colosso with DeMello and/or Staruiala because Colosso and DeMello disclose significantly different, and mutually exclusive, approaches to the licensing problem.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

- Even if combined, the proposed combinations do not disclose "in response to the device identity not being on the record, set the allowed copy count to a first upper limit for a first time period, the allowed copy count corresponding to a maximum number of devices authorized to use the digital product"

3. The limited scope of my opinions and analysis in this declaration do not imply that I may not later express other opinions or report other results from other investigations concerning other issues raised by the Petitioner or its experts in this IPR.

2. Qualifications

4. I am an electrical engineer with over 45 years of experience developing, programming, and analyzing computer algorithms and software. I am experienced with and able to create, read, and interpret firmware and software in C, C++, Java, assembly language, HTML, and other computer programming languages. I have served as an expert witness in multiple cases for which I analyzed computer source code in various languages and testified at ITC hearings and two jury trials concerning my results.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.