Filed: July 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

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

Case No. IPR2017-01685
U.S. Patent No. 7,804,948

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

I. Introduction

Patent Owner does not challenge most of the substantive positions raised in the Petition for challenged claims 1-4, 6-8, 18, 21, and 22 of U.S. Patent No. 7,804,948 ("the '948 patent"). (Patent Owner's Response, Paper 13.) Rather, Patent Owner focuses on prosecution disclaimer, contending that (1) a user selecting attendees for a conference call was disclaimed during prosecution of the '948 patent, and (2) *Tanigawa* falls within the scope of this disclaimer. Patent Owner has to prevail on both to demonstrate patentability, but it cannot prove either. For at least the reasons below, Petitioner respectfully requests that the Board cancel claims 1-4, 6-8, 18, 21, and 22 as unpatentable.

II. Argument

A. Applicant Did Not Clearly and Unambiguously Disclaim Selecting Attendees

Patent Owner dedicates a majority of its response to arguing that prosecution disclaimer precludes the challenged claims from reading on *Tanigawa*. According to Patent Owner, the Applicant disclaimed "requiring the requester to select which attendees to invite to join a conference call," and tied this alleged disclaimer to the claimed "generating a conference call request responsively to a single request by the conference call requester." (Patent Owner's Response, Paper 13 at 14-15.)

In pursuing this argument, Patent Owner appears to concede that the claim language itself contemplates selecting attendees, otherwise there would be no need

to resort to a disclaimer argument.[1] This concession is warranted because nothing in the claims precludes selecting attendees before a conference call requester issues the "single request" to convert an instant messaging session into a conference call. Indeed, the '948 specification teaches selecting attendees for a call, explaining that "User A could be provided with a list of participants of the on-going IM session, and be provided 312 with the opportunity to add or remove potential participants from a planned conference call." ('948 Patent at 7:34-44; *accord* Ex. 1032 at 22:19-25.) Therefore, giving the claims their broadest reasonable interpretation consistent with the specification, as is currently required in *inter partes* review, results in the claims including systems where the requester selects attendees for the conference call—hence the need for Patent Owner to argue a prosecution disclaimer.

But establishing prosecution disclaimer requires a patent owner to meet an "exacting" standard not met here. *See, e.g.*, *Apple Inc. v. VirnetX Inc.*, IPR2014-00481, Paper 35 at 6-7 (P.T.A.B. Aug. 24, 2015). As the Board has recognized, "[w]hile the prosecution history can inform whether the inventor limited the claim

[1] Patent Owner contends that its alleged disclaimer is "consistent with the explicit claim language," but never alleges that the claim language itself precludes selecting attendees. (Patent Owner's Response, Paper 13 at 13.)

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.