

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE, INC.,  
Petitioner,

v.

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

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Case IPR2017-01685  
Patent 7,805,948

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**PATENT OWNER PRELIMINARY RESPONSE**  
**PURSUANT TO 37 C.F.R. § 42.120**

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2001	Declaration of William Easttom II

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc Luxembourg S.A. (“Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“the Petition”) of U.S. Patent 7,804,948 (“the ‘948 Patent”) filed by Google, Inc. (now Google, LLC) (“Petitioner”).<sup>1</sup>

Petitioner has failed to prove that there is a reasonable likelihood that at least one of the claims challenged in the Petition is unpatentable. *See* 37 C.F.R. § 42.108(c). For several different reasons, Petitioner fails to meet this standard for any of the challenged claims. Petitioner: (1) does not address the prosecution history and the import it has on the claim construction, (2) relies on a primary reference that expressly teaches away from the very limitations for which it is cited; (3) impermissibly picks and chooses features from references to the exclusion of remainder of such references, and (4) relies on a combination that renders a reference inoperable for its intended purpose. In view of the reasons presented herein, the Board should reject the Petition in its entirety.

The Board should also deny institution because this proceeding would violate

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<sup>1</sup> Petitioner relies on the exact same combination of references and substantially identical obviousness theories to those presented in IPR2017-01684, filed by the same Petitioner against U.S. Patent No. 7,853,000, which claims priority to and is a continuation of the '948 Patent.

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