UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

UNILOC 2017 LLC

Patent Owner.

IPR2018-01093

PATENT 7,944,353 B2

PATENT OWNER RESPONSE TO PETITION

PURSUANT TO 37 C.F.R. §42.120

Table of Contents

I. INTRODUCTION

Uniloc 2017 LLC ("Uniloc" or "Patent Owner") submits this Response to Petition IPR2018-01093 for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 7,944,353 B2 ("the '353 Patent" or "EX1001") filed by Apple, Inc. ("Petitioner"). The Petition is defective for at least the reasons set forth herein.

II. THE '353 PATENT

The '353 patent is titled "System and Method for Detecting and Broadcasting a Critical Event." The '353 patent issued May 17, 2011, from U.S. Patent Application No. 12/130,471 filed May 30, 2008, and is related to U.S. application 11/968,772 filed January 3, 2008, entitled "Method and Apparatus For digital Life Recording and Playback," which is incorporated by reference in the '353 patent.

III. RELATED PROCEEDINGS

Patent Owner is unaware of any currently pending judicial or administrative proceedings involving the '353 patent.

IV. APPLE MAY BE CONTRACTUALLY ESTOPPED FROM MAINTAINING THIS PROCEEDING

Upon information and belief, Apple may be a licensee of the '353 patent. If Apple is bound by a license agreement that forbids Apple to challenge the validity of the '353 patent, Apple has an affirmative duty to disclose at least this fact, if not also the license itself. Apple will be afforded the opportunity in its reply to either offer sworn testimony denying the existence of such a license, or, instead, to explain why additional Board resources should needlessly be consumed *even if* Apple has possibly violated license terms by bringing this Petition in the first place.

V. A PERSON OF ORDINARY SKILL IN THE ART

The Petition alleges that a person of ordinary skill in the art ("POSITA") would have had "at least a bachelor's degree in mechanical engineering, electrical engineering, or a similar field with at least two years of experience in event monitoring device design or in biometric tracking. More direct industry experience can accommodate less formal education in the field and more formal education in the field can accommodate less direct industry experience." Pet. 12-13. Without conceding as to the correctness of this definition, to simplify the issues before the Board, and given that Petitioner fails to meet its burden of proof when purportedly applying its own definition of a person of ordinary skill in the art, Patent Owner does not offer a competing definition for purposes of this proceeding.

VI. PROSECUTION HISTORY

In offering an incomplete summary of the prosecution history, the Petition curiously states that "the Applicant *broadly* argued that Lloyd does not teach any of repeatedly analyzing a 'digitized stream of signature data,' determining an 'event context,' assessing a 'criticality' or 'urgency' of the event context, and determining a reporting response." Pet. 6 (citing EX1002 at 105-106) (emphasis added). It is unclear why Petitioner used the word "broadly" to characterize certain arguments successfully raised during prosecution. To the extent those arguments have any effect on claim scope, they can only be narrowing. At a minimum, those arguments concede that each one of the identified claim limitations are distinguishable from, and therefore do not encompass, the cited references (including Lloyd).

VII. PETITIONER FAILS TO MEET ITS BURDEN OF PROOF

The Petition presents a single ground of obviousness that relies primarily on Lemelson[1] and, for only certain limitations, a combination of Lemelson in view of Zhou.[2] Petitioner has the burden of proof to establish entitlement to relief. 37 C.F.R. § 42.108(c) ("review shall not be instituted for a ground of unpatentability unless . . . there is a reasonable likelihood that at least one of the claims challenged . . . is unpatentable"). The Petition should be denied as failing to meet this burden.

A. Claim Construction

The Petition includes a section that proposes claim constructions for the terms "signature data," "glossary," "configuration data," and "configuration setting." Pet. 9-12. In its Institution Decision, the Board declined to adopt Petitioner's express constructions, finding no construction of any term was necessary. Paper 8 at 8. The Board need not resolve whether Petitioner's proposed constructions are correct because the Petition fails to articulate any invalidating theory that supposedly applies Petitioner's proposed claim constructions.

B. Claim 1

The Petition fails to prove obviousness of claim 1. To simplify the issues before the Board, Patent Owner focuses deficiencies in the Petition with respect to the limitation, "assessing a criticality of the determined event context," as recited in claim 1. Claim 1 expressly distinguishes this limitation from the antecedent step,

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[1] EX1003, U.S. Patent No. 6,028,514 to Lemelson
[2] EX1004, U.S. Patent No. 6,847,892 to Zhou et al.

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