Filed on behalf of Microsoft Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

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Case IPR2012-00026 (TLG)
Case IPR2013-00109 (TLG)
Patent 6,757,717 B1

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**MICROSOFT CORPORATION'S OPPOSITION TO PATENT OWNER'S
CORRECTED MOTION TO AMEND UNDER 37 C.F.R. § 42.121**

TABLE OF CONTENTS

Page

The Board should deny Patent Owner's over-length motion to amend. Each proposed claim enlarges the scope of the claims and/or introduces new matter, in violation of 35 U.S.C. § 316(d)(3). At least one claim is unpatentable for indefiniteness, under 35 U.S.C. § 112(b). Several amendments seek to correct claim defects in ways that do not respond to a ground of unpatentability involved in the trial, in violation of 37 C.F.R. § 42.121(a)(2)(ii). Each claim is anticipated by DRP and/or Yohe, under 35 U.S.C. § 102. Proxyconn does not even try to meet its burden to show that the proposed claims are patentable over prior art known to it.

Microsoft submits its cross-examination of Dr. Alon Konchitsky (Ex. 1024). (The parties have agreed to Microsoft filing this transcript, unsigned.) Dr. Konchitsky is not an expert in this field. Nevertheless, he is a retained agent of Proxyconn and thus it is proper to treat his cited admissions as admissions of Proxyconn, if the Board admits his direct testimony in this trial.

Ground	35	36	37	38	39	40	41
Enlarged		√		√		√	√
New Matter	√		√	√	√	√	√
Indefinite				√			
Non-responsive		√		√			√
Anticipated by DRP	√	√	√	√	√	√	√
Anticipated by Yohe	√	√	√	√		√	√

I.   CLAIM 35

Some Changes from Claim 1: Adds that (1) the receiver is "configured to initiate a request for data" from the sender; (2) the sender is "configured to transmit a digital digest . . . in response to the request;" and (3) the data includes a range of octets in a file.

New Matter: Change (1) is new matter. The '717 patent does not disclose a receiver being so configured. Admittedly, the patent does refer to the step of beginning a transaction with the receiver sending "a request to the sender/computer." (IPR2012-00026, Ex. 1002 ("'717"), e.g., 7:65-67, 8:37-39). But, for Figs. 5-7 and 8-10, it does not say request for data. (Compare id., 9:66 ("a request for data" (for Fig. 15) with 7:65-67, 8:37-39 ("a request to the sender")). And, it does not disclose the receiver being programmed or otherwise configured to initiate this request. It may instead, e.g., merely react to a prompt from elsewhere to send a request. This new "configured to initiate" limitation thus is new matter.

Anticipated by DRP: DRP's client embodies the claim's "receiver." A DRP client is programmed to (a) request data from the server using a GET or differential GET request (IPR2013-00109, Ex. 1003 ("DRP"), 5:22-23, 6:43-7:1, 7:20-31, 7:37, 8:11-13, 9:22-32), (b) store data received over the network from the server into its disk-based cache (id., 5:30-33, 7:2-8), (c) calculate MD5 digests on that same data it receives and stores in cache (id., 3:24-27, 7:42-45, 8:36-37, 11:5-6),

and (d) compare MD5 digests (id., 5:30-33, 7:2-8, 7:42-45, 11:5-6). (See also Ex. 1024 ("Konchitsky TR"[1]), 91:18-21, 98:5-9, 108:11-109:18). DRP's server embodies the claim's "sender." A DRP server is programmed to (a) calculate MD5 digests on files it stores in its file-system file cache (DRP, 3:24-27, 5:26-28, 8:25-27, 9:30-31, 10:45-11:2) and (b) transmit MD5 digests of requested data in response to the client's request for data (id., 5:22-23, 7:33-34, 7:37-39, 8:29-31, 9:22-32). (See also Konchitsky TR 93:14-94:7, 106:12-15). The data includes files and thus a range of octets in a file. (DRP, 2:31-32, 2:44-3:2, 3:13-15, 3:28-31).

Anticipated by Yohe: The three changes to the claim do not overcome Yohe's anticipation of claim 1. (See IPR2012-00026, Ex. 1001, entries for claim 1). (Change 1:) As part of Yohe's "file system primitives" (IPR2012-00026, Ex. 1005 ("Yohe"), 3:8-12) and "program operations" (id., 4:13-23), Yohe's client is programmed to perform the method of Fig. 15. The client is configured to initiate a request for data from the server, beginning with its directory verify request (id., Fig. 15 (720)) to the server. (Change 2:) The server is configured to respond to this request from the client with an MD5 or CRC signature of the requested directory (id., Fig. 15 (721)). (Change 3:) As Dr. Konchitsky testified, Yohe's "directo-

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[1] Dr. Konchitsky is Patent Owner's retained agent but not an expert in this field.

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