Filed on behalf of Proxyconn, Inc.

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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

_____

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

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PROXYCONN'S REMAND BRIEF

INTRODUCTION

Logically, a Petitioner should assert claim constructions just broad enough to result in the invalidation of the challenged claims over the available prior art. In these proceedings Microsoft's "just broad enough" claim constructions were found unreasonable and rejected in two respects: the construction of "sender/computer" and "receiver/computer" and the construction of "at least two other computers." These erroneously broad constructions underpinned the determination of unpatentability of claims 1, 3, 6, 7, 9, 10 and 22–23, and without these unreasonably broad constructions what remains of Microsoft's grounds is insufficient to show that these claims are unpatentable.

At no point during these proceedings did Microsoft ever explain (let alone assert) that these claims were unpatentable under any other claim construction. It cannot do so for the first time on remand, long after these proceedings were to have terminated, when Proxyconn does not even have a chance to defend the claims. By definition any claim construction or argument that Microsoft presents for the unpatentability of claims 1, 3, 6, 7, 9, 10 and 22–23 is new, and should be rejected as untimely and unfair.

*Inter Partes R*eview is not examination – unlike an ex parte appeal there is no provision for the Board to modify the grounds of unpatentability submitted by the Petitioner. *Inter Partes* Review is an *adjudication* of those grounds properly

before the Board, i.e., the grounds as presented by the Petitioner that the Board

instituted. Microsoft chose to present grounds that required expansive claim

constructions that the Federal Circuit found ***unreasonable***. Because Microsoft

relied exclusively on those constructions, without arguing *any* other

constructions, there is no other option but to conclude that Microsoft failed to

prove these grounds. There is no provision for changing the instituted grounds

whether that change is the result of new prior art, new evidence, or new claim

constructions. The *Inter Partes* Review proceeding is already skewed in favor of

Petitioner, but to allow a patent to be invalidated based upon claim constructions or

arguments that the Patent Owner was never permitted to address is not only unfair,

but a denial of due process.

Microsoft has had a full and fair chance to present its chosen claim

construction and arguments for unpatentability, and it has lost. The Board is

respectfully requested to merely modify its Final Written Decision to remove the

findings of unpatentability of claims 1, 3, 6, 7, 9, 10, and 22–23, in view of the

Federal Circuit's vacatur. Nothing more is required, warranted or permitted.

ARGUMENT

Microsoft's arguments in its two Petitions, and the Board's Final Written

Decision (IPR2012-00026, Paper 73 and IPR2013-00109, Paper 16, ("FWD"))

depend upon the claim constructions now rejected by the Federal Circuit. In

modifying its Final Written Decision[1], the Board should find that Microsoft failed

to show, by a preponderance of evidence, that claims 1, 3, 6, 7, 9, 10, and 22–23

are unpatentable on the instituted grounds.

Claims 6, 7, and 9

Unpatentability over DRP

The Board's decision that claims 6, 7 and 9, were unpatentable over DRP

was based upon its rejection of Proxyconn's argument that "two other computers"

excluded the caching computer. FWD at 47. The Federal Circuit held that this was

error:

> The Board erred in concluding that the "two other computers" could include
>
> the caching computer.

Microsoft Corp. v. Proxyconn, Inc, 789 F.3d 1292, 1299 (Fed. Cir. 2015). The

proper construction is at odds with Microsoft's reading of DRP. The protocol of

DRP provides an efficient transfer of data from the server to the client. As shown

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[1]   The Board's finding of unpatentability of claims 1, 3, 6, 7, 9, 10, and 22–23

has been vacated. Because that time period permitted for the Board to make a final

determination has expired (*i.e.*, at most 18 months from institution), the Board is

without authority to take further action. 35 U.S.C. § 316 (a)(11); 37 C.F.R. §

42.100(c).

below, the proxy cache (or caching computer) is intermediate between the server

and client. With this construction of DRP, *only* the proxy cache is connected

between two "other" computers, as construed by the Federal Circuit – yet the

proxy cache does not include a "means for calculating" as required by claims 6, 7

and 9.

The only disclosed parts of DRP

Because Microsoft's construction was in error and forms the ***only*** basis for

its argument of anticipation of claims 6, 7 and 9 based on DRP, and further at no

point did Microsoft ever attempt to show that DRP anticipated claims 6, 7 and 9 if

the "two other computers" excluded the caching computer, the only possible

conclusion is that Microsoft has failed to show that claims 6, 7 and 9 are

unpatentable as anticipated by DRP.

Unpatentability over Mattis and DRP

Microsoft indicated in the August 27, 2015, conference call that on remand

it wanted to raise the unpatentability of claims 6, 7 and 9 in view of Mattis and

DRP, which the Board's Final Written Decision found to be moot. FWD at 53.

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