UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

_____

Case IPR2018-01553
Patent 5,699,275

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Before SALLY C. MEDLEY, PATRICK R. SCANLON, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Samsung Electronics Co., Ltd. ("Petitioner")[1] filed a Petition for *inter partes* review of claim 1 of U.S. Patent No. 5,699,275 (Ex. 1001, "the '275 patent"). Paper 1 ("Pet."). Iron Oak Technologies, LLC ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claim 1 of the '275 patent.

A. Related Matters

The parties indicate that the '275 patent is the subject of several court proceedings. Pet. 1–2; Paper 6, 2–3. The '275 patent also is the subject of Board proceedings IPR2018-01552, IPR2019-00106, IPR2019-00110, and IPR2019-00111. Pet. 2; Paper 6, 3.

B. The '275 Patent

The specification of the '275 patent describes a system "for remote patching or updating of operating code located in a mobile unit." Ex. 1001, [57]. The system includes a manager host operable to initiate transmission of a discrete patch message to a mobile unit. *Id.* The mobile unit is operable

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[1] Petitioner, Samsung Electronics Co., Ltd., identifies Samsung Electronics America, Inc. as a real party-in-interest. Pet. 1.

to create patched operating code by merging the patch with the current operating code and to switch execution to the patched operating code. *Id.* The mobile unit also can receive a download message defining new operating code to replace current operating code. *Id.*

C. Illustrative Claims

Petitioner challenges claim 1 of the '275 patent. Claim 1 is reproduced below.

> 1.   A system for remote patching of operating code located in a mobile unit, comprising:
>
> a manager host operable to initiate transmission through a wireless communication network of at least one discrete patch message defining at least one patch;
>
> a first mobile unit operable to receive the at least one discrete patch message, the first mobile unit further operable to create patched operating code by merging the at least one patch with current operating code located in the first mobile unit and to switch execution to the patched operating code; and
>
> a second mobile unit operable to receive the at least one discrete patch message, the second mobile unit further operable to create patched operating code by merging the at least one patch with current operating code located in the second mobile unit and to switch execution to the patched operating code; and
>
> wherein the manager host is further operable to address the at least one discrete patch message such that the at least one discrete patch message is transmitted to the first mobile unit but not to the second mobile unit.

Id. at 13:32–53.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claim 1 is unpatentable based on the following grounds (Pet. 3):

References	Basis	Challenged Claim
Hapka[2] and Parrillo[3]	§ 103	1
Hapka, Parrillo, and Wortham[4]	§ 103	1

II. DISCUSSION

A. Claim Construction

The '275 patent is expired. Ex. 1001; Pet. 8. For claims of an expired patent, our claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Moreover, for claims of an expired patent, the Board construes claims to generally have their ordinary and customary meaning, as that meaning would be understood by one of ordinary skill in the art in the context of the entire patent disclosure. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*). Petitioner contends that the claims should be construed consistent with the principles set forth in *Phillips*. Pet. 8.

Petitioner proposes constructions for the following claim terms found in challenged claim 1: "mobile unit," "operating code," "manager host operable to initiate transmission through a wireless communication network of at least one discrete patch message defining at least one patch," "merging the at least one patch with current operating code," and "manager host is further operable to address the at least one discrete patch message." Pet. 8–16. Patent Owner does not oppose Petitioner's proposed constructions. *See generally* Prelim. Resp.; *id*. at 4.

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[2] U.S. Patent No. 5,619,412, issued Apr. 8, 1997 (Ex. 1008, "Hapka").
[3] U.S. Patent No. 5,442,553, issued Aug. 15, 1995 (Ex. 1009, "Parrillo").
[4] U.S. Patent No. 5,155,689, issued Oct. 13, 1992 (Ex. 1014, "Wortham").

"merging the at least one patch with current operating code"

Claim 1 recites "the first mobile unit [second mobile unit] further operable to create patched operating code by *merging the at least one patch with current operating code*." Petitioner argues that "merging the at least one patch with current operating code" means "incorporating the at least one patch into the current operating code, without replacing the entire current operating code." Pet. 12. Petitioner explains that the specification of the '275 patent consistently describes merging as incorporating at least one patch into the current operating code without replacing the entire operating code. *Id.* at 12 (citing Ex. 1001, 1:54–61, 2:2–5, 3:63–66, 4:65–5:10, 6:60–7:5, 7:28–30, 10:24–32, 11:22–25, 11:54–12:26). Petitioner further argues that the specification of the '275 patent contrasts the patch process with downloading messages defining new operating code received to replace current operating code in the mobile units. *Id.* at 13 (citing Ex. 1001, 10:24–32). Petitioner further directs attention to the prosecution history of the '275 patent and "a German counterpart," in support of its construction. Pet. 13–14 (citing Ex. 1004, 86–97; Ex. 1010, 4–5).

Based on our review of the current record, we determine Petitioner's proposed claim construction for the phrase "merging the at least one patch with current operating code" to be consistent with the specification and the prosecution history. Therefore, for purposes of this Decision, we adopt Petitioner's proposed claim construction, interpreting "merging the at least one patch with current operating code" as "incorporating the at least one patch into the current operating code, without replacing the entire current operating code."

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