Trials@uspto.gov
571-272-7822

Paper 21
Entered: February 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

IPR2019-00106
Patent 5,699,275

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

MEDLEY, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining the Challenged Claim Unpatentable
35 U.S.C. § 318(a)

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

I. INTRODUCTION

Microsoft Corporation ("Petitioner") 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 6 ("Prelim. Resp."). Upon consideration of the Petition and Preliminary Response, we instituted *inter partes* review, pursuant to 35 U.S.C. § 314, as to claim 1 based on all challenges set forth in the Petition. Paper 7 ("Decision to Institute" or "Dec.").

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 12, "PO Resp."), Petitioner filed a Reply to Patent Owner's Response (Paper 13, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 14, "Sur-reply"). On November 4, 2019, we held an oral hearing. A transcript of the hearing has been entered into the record. Paper 20 ("Tr.").

In our Scheduling Order, we notified the parties that "any arguments for patentability not raised in the [Patent Owner] response may be deemed waived." *See* Paper 8, 5; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) ("The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief."). In addition, "[a]rguments must not be incorporated by reference from one document into another document." 37 C.F.R. § 42.6(a)(3) (2018). In violation of our rule and guidance, Patent Owner argues in its Patent Owner Response: "Patent Owner incorporates herein those arguments presented in its Preliminary Response for all purposes." PO Resp. 1. We decline to consider whatever Patent Owner considers is "incorporated" from its Preliminary Response as if it were a part

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

of Patent Owner's Response, but only consider arguments substantively presented in Patent Owner's Response. Any arguments for patentability not raised in the Patent Owner Response are deemed waived.

For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claim 1 of the '275 patent is unpatentable.

A. Related Matters

The parties indicate that the '275 patent is the subject of several stayed court proceedings. Pet. 3–4; Paper 3, 2–3; Paper 9, 3–4. The '275 patent also is the subject of Board proceedings IPR2018-01552 and IPR2018-01553. A Final Written Decision is made in each of IPR2018-01552 and IPR2018-01553 concurrently with this Final Written Decision. In IPR2019-00110, Google LLC filed a motion to join IPR2018-01552, which we granted. *See Google LLC v. Iron Oak Techs., LLC*, IPR2019-00110, Paper 11 (PTAB Apr. 3, 2019). In IPR2019-00111, Google LLC filed a motion to join IPR2018-01553, which we granted. *See Google LLC v. Iron Oak Techs., LLC*, IPR2019-00111, Paper 10 (PTAB Apr. 3, 2019).

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, code (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 to create patched operating code by merging the patch with the current operating code and to switch execution to the patched operating

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

code. *Id.* The mobile unit also can receive a download message defining new operating code to replace current operating code. *Id.*

C. Illustrative Claim

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.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

D. *Instituted Grounds of Unpatentability*

We instituted trial based on all asserted grounds of unpatentability under 35 U.S.C.[1] as follows (Dec. 4, 24):

Claim Challenged	35 U.S.C. §	Reference(s)
1	102	Sugita[2]
1	103	Sugita
1	103	Sugita, Burson[3]
1	103	Sugita, Kirouac,[4] with or without Burson
1	103	Sugita, Ballard,[5] with or without Burson and Kirouac

II. ANALYSIS

A. *Principles of Law*

To prevail in its challenge to Patent Owner's claim, Petitioner must demonstrate by a preponderance of the evidence[6] that the claim is

---

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because the '275 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

[2] JP Published Patent Application No. 1993-128022, published May 25, 1993 (Ex. 1005, "Sugita").

[3] U.S. Patent No. 5,550,895, issued Aug. 27, 1996 (Ex. 1008, "Burson").

[4] U.S. Patent No. 5,155,847, issued Oct. 13, 1992 (Ex. 1007, "Kirouac").

[5] Australian Patent Application No. 77395/91, published May 12, 1991 (Ex. 1006, "Ballard").

[6] The burden of showing something by a preponderance of the evidence simply requires the trier of fact to believe that the existence of a fact is more probable than its nonexistence before the trier of fact may find in favor of the party who carries the burden. *Concrete Pipe & Prods. of Cal., Inc. v. Constr. Laborers Pension Tr. for S. Cal.*, 508 U.S. 602, 622 (1993).

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.