

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
U.S. Patent No. 5,699,275

PATENT OWNER PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. §42.107(a)

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I. INTRODUCTION

As a threshold matter, the Board should note that grounds A and B in this petition for *Inter Partes* Review are ***substantively identical*** to the petitions earlier filed by Samsung Electronics Co., Ltd. (IPR 2018-01552) and Google LLC (IPR 2019-01110), and to which Patent Owner has filed preliminary responses. By substantively identical, we mean the identified claim is the same (Claim 1); the identified art is identically the same (Sugita); and the arguments presented are identically the same. From Patent Owner's detailed review, the only differences relate to the petitioner specific information. See Institution Decision in IPR2018-01554 at 27 – 31.

For the reasons presented below, Iron Oak Technologies, LLC (Patent Owner) respectfully requests that the Board exercise its discretion to deny the Petition for *Inter Partes* Review filed by Microsoft Corporation (Petitioner) concerning U.S. Patent No. 5,699,275 ('275 patent).

35 U.S.C. § 314(a) sets forth the standard by which an IPR may be instituted:

The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Thus, it is *not* the Board’s burden or duty to sift through the art relied upon in the Petition to see if a reasonable likelihood of unpatentability *could have been shown*. Rather, it is the Board’s duty to determine whether the arguments and evidence *actually presented* in the Petition demonstrate such likelihood by a preponderance of the evidence in the first instance. The Petition does not meet this standard.

Each ground advanced in the Petition fails because Petitioner did not establish the content of each reference as would have been understood by a person of ordinary skill in the art (hereafter, POSITA). *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (“Under §103, the scope and content of the prior art are to be determined; ...”). The properly understood content of the cited art demonstrates that they do not anticipate or render obvious the subject matter of Claim 1 of the ’275 Patent.

For at least these reasons, the Petition should be denied in its entirety.

II. RELATED *INTER PARTES* REVIEW CASES

IPR Petitions currently pending against the ’275 Patent are listed below. As of this filing, trial has not been instituted against the ’275 Patent.

A. Petitions Based Primarily on Sugita and Ballard

As noted above, a petition for *inter partes* review was earlier filed by Samsung Electronics Co. Ltd (IPR2018-01552) contending that claim 1 of the ’275 patent is

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