UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

Patent No. 5,699,275
Issued: December 16, 1997
Filed: April 12, 1995
Inventors: Dale E. Beasley et al.

Title: SYSTEM AND METHOD FOR REMOTE PATCHING OF OPERATING CODE LOCATED IN A MOBILE UNIT

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Inter Partes Review No. IPR2019-00106

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PETITIONER'S REPLY

I. INTRODUCTION

Claim 1 of the 275 Patent is directed to "[a] system for remote patching of operating code located in a mobile unit." EX1001, 13:32-33. The system includes "a manager host **operable** to initiate transmission … of at least one discrete patch message defining at least one patch." *Id*., 13:34-37. The claimed system also requires two mobile units, a first and a second, each of which is "**operable** to create patched operating code by merging the at least one patch with current operating code located in the [first/second] mobile." *Id*., 13:38-49 (emphasis added). Finally, the claimed system requires that the "manager host" be "**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*., 13:50-53 (emphasis added in each).

Claim 1 therefore recites a system having certain components capable of performing certain functionality. It is not a method claim. It requires no activity. Nor does it require the claimed "operability" to be employed in all circumstances, or in any particular circumstance. It merely requires a system whose parts can perform the specified functionality in the claim.

The Petition ("Pet.") demonstrated that Sugita discloses such a system. In particular, Sugita discloses a system that includes multiple mobile units, each of which is capable of receiving a patch message and in response creating patched

operating code. Pet., 35-42. The Petition further demonstrated that the system of Sugita includes a base station capable of performing the functionality of the claimed "*manager host,*" including addressing the patch message such that it "is transmitted to the first mobile unit but not to the second mobile unit." Pet., 30-35.

The Petition demonstrated that Sugita's base station satisfies this last claim requirement in two, alternative ways. *See* Pet., 44 ("Both ways of addressing update information (*i.e.*, group ID or individual ID) meet this claim element under either construction."); *see also id.*, 43-46. First, Sugita discloses transmission of a patch message addressed to one of several groups of mobile units (*i.e.*, a "specific group," *see* EX1005, [0013]), rather than to all mobile units, using a Group ID as an address. Pet., 44-45. Thus, in this mapping of the claim, the "first mobile unit" is a unit within the "specific group" to which the patch message is transmitted and the "second mobile unit" is a unit within some other group, *i.e.*, a group to which the patch message is not transmitted. *See id.*

Second, Sugita discloses that, after such a group transmission, the system will re-transmit the patch message to units that did not acknowledge reception of the group transmission, and these re-transmissions will address the patch message using the respective "individual IDs" of those units. *See, e.g.*, Pet., 45-47. In this mapping of the claim, the "first mobile unit" is a unit to which the patch message is (re-)transmitted using its "individual ID" and the "second mobile unit" is a mobile

unit to which that re-transmission is not sent because, for example, that unit acknowledged successfully receiving the patch via the group transmission, was not a target of the group transmission, or is an unsuccessful target of the group transmission but is not the target of this particular individual transmission. *See id.*

In response, Patent Owner advances a convoluted argument[1] based on an overly narrow interpretation of the claim that is unsupported by and inconsistent with the claim language. The basis of its argument is that the claim supposedly requires the "second mobile unit" to have the capability "to create patched operating code" from the patch message *at the time the patch message is transmitted* and that it will necessarily employ that functionality in response to a patch message.

That position is both confused and erroneous for several reasons. First, in relevant part the claim only requires the "second mobile unit" to be "operable to create patched operating code" by merging the patch with current operating code.

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[1] Patent Owner appears to use another translation of Sugita from the related IPR proceeding IPR2018-00152. That translation is not of record in this proceeding. For the Board's convenience, Petitioner addresses Patent Owner's arguments in view of the same cited paragraphs of Sugita's translation that is of record in this proceeding (EX1005).

It includes no requirement that the mobile unit use that functionality in any particular circumstance or at any particular time. A mobile unit that is capable of creating patched operating code in some circumstances still satisfies the claim, "even if it does not meet the claim limitations in all modes of operation." *ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1361 (Fed. Cir. 2018).

Second, a mobile unit that has the ability "to create patched operating code" in some circumstances, is still "operable to create patched operating code" even during time periods or under circumstances it may not implement that functionality. Thus, a mobile unit operable to create patched operating code only on Mondays, is still a mobile unit "operable to create patched operating code" during the rest of the week.

Finally, as demonstrated below, the disclosure of Sugita and the analysis included in the Petition satisfy the claim even under Patent Owner's erroneous claim interpretation.

Accordingly, as demonstrated below and in the Petition, Sugita satisfies all elements of claim 1. Petitioner therefore respectfully requests that the Board find that claim to be unpatentable.

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