UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC.,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC.,
Patent Owner.

IPR2019-00111
U.S. Patent No. 5,699,275

PATENT OWNER PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. §42.107(a)

TABLE OF CONTENTS

I. INTRODUCTION

As a threshold matter, the Board should note that this petition for *Inter Partes* Review is ***substantively identical*** to the petition filed by Samsung Electronics Co., Ltd. (IPR2018-01553), and to which Patent Owner has filed a preliminary response. By substantively identical, we mean the identified claim is the same (Claim 1); the identified art is identically the same (Hapka, Parillo, Wortham); and the arguments presented are identically the same. From Patent Owner's detailed review, the only differences relate to the specific petitioners. See Institution Decision in IPR2018-01554 at 27 – 31.

The Board also should note that this Preliminary Response is, therefore, substantively identical to the Preliminary Response filed by Patent Owner in IPR 2018-01553.

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 Google LLC., (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 shift through the art relied upon by Petitioner to see if a reasonable likelihood of unpatentability ***could have been shown*** for Claim 1. Rather, it is the Board's duty to determine whether the arguments and evidence ***actually presented*** in the Petition demonstrate such likelihood in the first instance. The Petition fails to meet this standard.

Each ground advanced in the Petition fails because the Petition does 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 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 no trial has been instituted against the '275 Patent.

A. Petitions Based Primarily on Hapka

A petition for *inter partes* review was earlier filed by Samsung Electronics Co., Ltd. (IPR2018-01553) contending that claim 1 of the '275 patent is obvious over Hapka and Parillo; or obvious over Hapka, Parillo and Wortham. As noted above, the Samsung petition is substantively identical, if not absolutely identical, to the subject Petition.

B. Petitions Based Primarily on Sugita and Ballard

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 anticipated by Sugita; or rendered obvious over Sugita and Wortham; or rendered obvious over Ballarad and Shimizu.

A petition for *inter partes* review was later filed by Petitioner, Google LLC (IPR2019-0110) contending that claim 1 of the '275 patent is anticipated by Sugita; or rendred obvious over Sugita and Wortham; or rendered obvious over Ballard and Shimizu. It should be noted that the Google petition is substantively identical, if not absolutely identical, to IPR2018-01552 filed by Samsung..

A petition for *inter partes* review has been filed by Microsoft Corporation (IPR2019-0106) contending that claim 1 of the '275 patent is anticipated by Sugita; or obvious over Sugita; or obvious over Sugita and Burson; or obvious over Sugita and Kirouac (with or without Burson); or obvious over Sugita and Ballard (with or

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