

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case No. IPR2019-01559

U.S. Patent No.: 8,724,622

STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner Microsoft Corporation, (“Microsoft”) submits this paper pursuant to the July 2019 Update to the AIA Trial Practice Guide (pp. 26-27), in order to explain why the Board should institute review based on each of the following two petitions challenging U.S. Patent No. 8,724,622 (“the ’622 patent”):

- IPR2019-01558, challenging claims 1, 2, 9, 36, 37 and
- IPR2019-01559 challenging claim 5.

While Microsoft raises only a single ground against each challenged claim, two petitions were necessary to fully address each limitation of the challenged claims and their respective parent claim(s). Institution of both petitions will be an efficient use of resources because it requires minimal additional work for the Board, and would prevent prejudice to Microsoft.

Microsoft ranks the petition challenging claims 1, 2, 9, 36, and 37 (IPR2019-01558) first and the petition challenging claim 5 (IPR2019-01559) second. Microsoft so ranks the petitions because IPR2019-01559 challenges a single claim not currently asserted against Microsoft. However, Microsoft would be severely prejudiced if its petition challenging claim 5 were denied merely for being presented in a separate petition, because doing so would encourage patent owner to attempt assertion of that claim in litigation.

I. TWO PETITIONS WERE NEEDED TO PREVENT PREJUDICE

Uniloc asserted the '622 Patent against Microsoft in April 2019, thereby triggering the one year bar on filing an IPR petition. *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1367 (Fed. Cir. 2018). While Uniloc currently only asserts claims 1 and 2 in litigation (in its *preliminary* infringement contentions), its litigation history shows that it may later seek to assert different claims in its final infringement contentions, thus necessitating the challenge of the remaining claims not yet found unpatentable (5, 9, 36, and 37) in order to prevent prejudice to Microsoft. As explained below in Section II, two petitions were necessary to fully address claims 1, 2, 5, 9, 36, and 37.

II. TWO PETITIONS WERE NEEDED TO ADDRESS ALL LIMITATIONS OF THE CHALLENGED CLAIMS

Microsoft presents its claim 5 challenge in a separate petition due to word count limitations. The following table is provided to aid the Board in identifying the similarities and differences between the petitions:

Petition	Challenged Claims	Cited References
IPR2019-01558	9 (depends from 3)	Zydney and Shinder
	36 and 37 (depend from 27)	Zydney and Shinder
	1 (independent)	Zydney, Shinder, and Kirkwood
	2 (depends from 1)	Zydney, Shinder, Kirkwood, and Boneh
IPR2019-01559	5 (depends from 3 and 4)	Griffin and Zydney

As the table shows, the Challenged Claims of the petitions have differing dependencies. Multiple grounds are not being raised against a same claim, although

the separate grounds challenging claims 5 and 9 each implicates underlying independent claim 3. As discussed in Section III of each petition, claim 3 was previously found unpatentable in view of Zydney and Shinder in IPR2017-01667 *and* separately unpatentable in view of Griffin and Zydney in IPR2017-01797. These different grounds both implicate claim 3 because different challenged claims (5 and 9) depend from it. Although claims 5 and 9 both depend from independent claim 3, claim 5 further depends from dependent claim 4, which was also found unpatentable in view of Griffin and Zydney. (IPR2017-01797, Paper 32 at 60-63.)

Microsoft challenges claim 5 under a combination of Griffin and Zydney because the Board previously found that both parent claims of claim 5 (claims 3 and 4) were unpatentable in view of Griffin and Zydney. (IPR2017-01797, Paper 32 at 37-63 (claim 5 was not challenged).) Furthermore, in a different proceeding the Board previously found claim 5 was not shown to be unpatentable over a combination including Zydney and Shinder. (IPR2017-01668, Paper 37 at 98-103.) Thus, in order to promote efficient use of the Board's resources, and to present a

single, strongest ground for each claim, claim 5 is challenged under a combination of Griffin and Zydney.¹

Despite the fact that only a single ground is raised for each challenged claim, Microsoft was unable to fully address all the limitations of the relevant parent claims for all the Grounds (claims 3 and 27 for Ground 1 in IPR2019-01558 and claims 3 and 4 for Ground 1 in IPR-01559), as well as the limitations of the Challenged Claims, and still satisfy the word limitation imposed by 37 C.F.R. § 42.24. Since claim 5 is challenged using a different combination of references than the other claims, Microsoft elected to file a separate petition challenging claim 5.

III. THE SECOND PETITION ADDS MINIMAL ADDITIONAL WORK

Microsoft raises only a single ground as to each challenged claim. Thus, Microsoft does not rely on multiple petitions to challenge the same claim using multiple grounds. Therefore, the second petition adds minimal additional work. Accordingly, both petitions should be fully considered and instituted.

¹ While Microsoft believes that claim 5 is unpatentable in view of a combination of references including Zydney and Shinder, Microsoft has opted not to raise such a ground in order to avoid redundant challenges to the same claim.

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