

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2020-00023
U.S. PATENT NO. 6,467,088

PATENT OWNER SUR-REPLY

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I. INTRODUCTION

Uniloc 2017 LLC (the “Patent Owner” or “Uniloc”) submits this Sur-Reply to the Petition for *Inter Partes* Review (“Petition”) of United States Patent No. 6,467,088 (“the ’088 patent”) filed by Microsoft Corporation (“Petitioner”) in IPR2020-00023. For the reasons given in Patent Owner’s Response (Paper 10, “POR”) and herein, Petitioner fails to carry its burden of proving invalidity of the challenged claims of the ’088 patent.

II. THE REPLY UNDERSCORES DEFICIENCIES OF THE PETITION

A. Petitioner misapplies the undisputed construction of “known”

As explained in Patent Owner’s Response, the Board (indeed this same Panel) previously offered informative claim construction findings in its decision denying institution of another petition challenging the same ’088 patent. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00056, Decision Denying Institution (Paper 7) at 7–8 (PTAB April 29, 2019). There, the Board adopted Patent Owner’s construction that “known” means “previously determined.” *Id.*¹ The Board also found that, in art asserted there, “neither the client nor the server anticipates that the selected code

¹ A district court in parallel litigation involving the same patent adopted the same construction. *See Uniloc 2017 LLC v. Apple Inc.*, Case No. 6:19-cv-532-ADA, Dkt. 69, Claim Construction Order, (W.D.T.X. June 8, 2020) (construing “known [acceptable/unacceptable] configurations for the electronic device” as “[p]lain-and-ordinary meaning, wherein ‘known’ means ‘previously determined’”; and ordering “plain-and-ordinary meaning” for “at least one of a list of known acceptable configurations for the electronic device and a list of known unacceptable configurations for the electronic device”).

updates at this point are actually a ‘known acceptable configuration for the electronic device.’” *Id.*, 11. The Board clarified its finding, in part, as follows:

Although the code updates at this point match some criteria of the client device, they are not “known” to be acceptable configurations, but merely “potentially appropriate.” The indecisive language “potentially” is not the required decisive language of “known”—a difference that Petitioner does not explain persuasively, if at all.

Id., 11–12.

While Petitioner here purports to apply this same understanding of the “known” claim terms, Petitioner confirms in its Reply that its invalidity theory, instead, attempts to impermissibly expand claim scope to encompass what the Board previously found to be excluded.

B. Petitioner failed to prove Apfel inherently discloses the decisive “known” requirement recited in the comparison limitations recited in each challenged claim.

It remains undisputed that Apfel does not expressly disclose at least the comparison limitations recited in each challenged claim. As recited in claim 1, for example, Apfel does not expressly disclose “comparing the determined component and information specifying at least one additional component currently implemented in the electronic device with at least one of a list of known acceptable configurations and a list of known unacceptable configurations for the electronic device.” Petitioner’s resort to a theory of inherency is woefully deficient of the exacting standard. *See* POR 16 (collecting cases).

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