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'S OPENING BRIEF ON REMAND

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TABLE OF AUTHORITIES

Cases

I. INTRODUCTION

Uniloc 2017 LLC ("Uniloc" or "Patent Owner") submits this Opening Brief on Remand in connection with the Petition for *Inter Partes* Review ("Pet." or "Petition") of United States Patent No. 6,467,088 ("the '088 patent" or "Ex. 1001") filed by Microsoft Corporation ("Petitioner") in IPR2020-00023.

In view of the reasons presented herein, the Board is respectfully requested to, consistent with the decision of the Court of Appeals for the Federal Circuit in *Microsoft Corp. v. Uniloc 2017 LLC*, No. 2021-2039 (Fed. Cir. Oct. 20, 2022) (hereinafter "Opinion"), deny the Petition in its entirety, as, after review of the Court's decision, Petitioner still fails to meet its burden of showing that any challenged claim is unpatentable. 35 U.S.C. §316(e).

II. PROCEDURAL BACKGROUND

Petitioner filed the Petition on October 11, 2019, seeking *Inter Partes* Review of claims 1-4, 6-14 and 16-21 of the '088 Patent. The Board instituted *Inter Partes* Review dated April 14, 2020 (Paper 7). The Board issued a Final Written Decision on April 6, 2021 (Paper 20) ("Final Written Decision"), determining that no challenged claims were unpatentable. Petitioner appealed to the Court of Appeals for the Federal Circuit, which issued the Opinion vacating and remanding the Board's Final Written Decision on October 20, 2022. The Board's Order on Conduct of the Proceedings requires the parties to submit briefs on remand by February 1, 2023, and the present Brief is timely filed.

III. STANDARD OF REVIEW

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). As demonstrated herein, when considering the Court's ruling, Petitioner has failed to meet its burden of proving any proposition of invalidity, as to any claim, by a preponderance of the evidence. 35 U.S.C. §316(e).

IV. The Court's Determination that Apfel Requires a Comparing Step Does not Require that the Comparing Step Include "information specifying at least one additional component" as recited in Claims 1, 11 and 21.

The Court determined that the Board's conclusion that U.S. Patent No. 5,974,454 ("Apfel" or "Ex. 1004") lack of disclosure of a comparing step was not supported by substantial evidence. Opinion, 3.

The Court's analysis of whether Apfel discloses the required comparing step rests on two passages of Apfel, one of which includes the sole use of the term "incompatible" in Apfel. As demonstrated below, a proper reading of Apfel shows that the first passage, at col. 7, lines 13-19, provides a high-level overview of a two-assessment process. The first assessment is the determination of whether an upgrade is available. The second assessment *may* involve an assessment of compatibility of the determined upgrade. The second passage, at col. 9, lines 30-40, provides a detailed explanation of the *first* assessment of identifying an upgrade. The second assessment of col. 7, lines 13-19, makes clear that a compatibility determination is distinct from determining an upgrade, thus demonstrating that the second passage

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