UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00023
Patent 6,467,088

_____

REMAND BRIEF OF
PETITIONER MICROSOFT CORPORATION

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I.   INTRODUCTION

Petitioner Microsoft has shown by a preponderance of the evidence that the challenged claims are unpatentable, and the Board should issue a new Final Written Decision accordingly. The Federal Circuit found that prior art Apfel (EX1004) discloses the claimed "comparing" step, which is the only step that Patent Owner had argued was lacking in the prior art. The undisputed evidence in the Petition shows how the prior art meets all other features of the challenged claims, thus rendering each claim unpatentable.

II.   ARGUMENT

A.   In The Original IPR Proceedings, The Only Dispute Was Whether The Prior Art Satisfied The Claimed "Comparing" Step

The Institution Decision found that "Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that [independent] claims 1, 11, and 21 would have been obvious over Apfel alone or the combination of Apfel, Todd, and Lillich." Paper 7, 23. In doing so, the Board determined that the "reasons to combine Apfel with both Lillich and Todd … appear reasonable at this stage" and rejected Patent Owner's preliminary arguments against the combination. *Id.*, 19–23. The Institution Decision also determined preliminarily that Apfel and Pedrizetti (EX1007) render obvious dependent claims 9 and 19. *Id.*, 25–26. Thus, the Board instituted IPR on the following grounds:

Claims Challenged	35 U.S.C. §	References
1–4, 6–14, 16–21	§ 103	Apfel, Lillich, Todd
9, 19	§ 103	Apfel, Lillich, Todd, Pedrizetti
1–3, 9–13, 19–21	§ 103	Apfel, Lillich
1, 3, 4, 6–11, 13, 14, 16–21	§ 103	Apfel, Todd

Paper 7, 30.

After institution, Uniloc disputed only whether the prior art satisfies the "'comparing' / 'compare' limitations" of the independent claims. The only substantive arguments in the Patent Owner Response were within a section titled "The Petition fails to prove obviousness, under any one of the redundant grounds, of the 'comparing' / 'compare' limitations recited in each challenged claim." POR (Paper 10), 13–27. The remainder of the Patent Owner Response merely pointed back to these "comparing" arguments, asserting that they "apply equally" to other claims and grounds. *Id.*, 28–29; *see also* PO Sur-Reply (Paper 13), 2–10 (arguing that Apfel does not disclose the "'known' requirement recited in the comparison limitations"); *id.*, 10–16 (arguing that Lillich does not cure the deficiencies of Apfel regarding that "known" requirement of the "comparing" step); *id.*, 16–20 (arguing that Todd does not cure "the deficiencies of Apfel and Lillich regarding the 'comparing' and 'compare' limitations").

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