

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00023
Patent 6,467,088

**PETITIONER'S RESPONSE TO
PATENT OWNER'S OPENING REMAND BRIEF**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT	1
A. The Mandate Rule Precludes Reconsideration Of Whether Apfel Discloses The “Comparing” Step	2
1. The Federal Circuit Decided That Apfel Discloses The “Comparing” Step	2
2. The Board May Not Reconsider The Court’s Finding	3
3. No Exceptions To The Mandate Rule Apply Here	5
B. Even Absent The Mandate Rule, Patent Owner’s Arguments Fail	5
III. CONCLUSION.....	8
CERTIFICATE OF SERVICE	10

TABLE OF AUTHORITIES

Page(s)

Cases

Amado v. Microsoft Corp.,
517 F.3d 1353 (Fed. Cir. 2008)2

Anneal Pharms. LLC v. Almirall, LLC,
960 F.3d 1368 (Fed. Cir. 2020)4

Banks v. United States,
741 F.3d 1268 (Fed. Cir. 2014) 2, 5, 8

MyMail, Ltd. v. ooVoo, LLC,
934 F.3d 1373 (Fed. Cir. 2019)1

Sibbald v. United States,
37 U.S. 488 (1838)4

Sprague v. Ticonic Nat. Bank,
307 U.S. 161 (1939)2

United States v. Semon Bache & Co.,
27 C.C.P.A. 89 (1939)4

United States v. J.H. Cottman & Co.,
23 C.C.P.A. 378 (1936)4

Board Decisions

Zodiac Pool Sys., Inc. v. Aqua Prod., Inc.,
No. IPR2013-00159 (P.T.A.B. Feb. 11, 2019).....2

Statutes

35 U.S.C. § 1442

I. INTRODUCTION

Implicitly acknowledging that it is the only way its patent could survive, Patent Owner invites the Board to overturn the Federal Circuit’s determination that the Apfel prior art reference teaches the claimed “comparing” step. However, the mandate rule precludes revisiting this issue that the Court already decided.

The Final Written Decision (Paper 20) addressed only the “comparing” step. Thus, that step was the focus of the briefing and opinion on appeal. *See* Paper 29 (the “Opinion”). After finding Apfel teaches this step, the Court properly remanded for the Board to address in the first instance whether the prior art satisfied the other claim elements. *MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373, 1380 (Fed. Cir. 2019) (“It is improper for us to determine factual issues in the first instance on appeal.”).

The Court did not remand for the Board to overturn the Court’s determination that Apfel teaches the “comparing” step. Yet Patent Owner’s remand brief disputes only that issue. Because the Federal Circuit already resolved that issue in Petitioner’s favor, and for the reasons set forth in Microsoft’s Petition—which otherwise remain un rebutted—the Board should find all claims unpatentable.

II. ARGUMENT

The mandate rule bars Patent Owner’s argument that “Petitioner has failed to show that Apfel discloses the recited comparing step.” *E.g.*, Paper 31, 9. That argument also fails on the merits and as waived for not being previously presented.

A. The Mandate Rule Precludes Reconsideration Of Whether Apfel Discloses The “Comparing” Step

“[T]he mandate rule forecloses reconsideration of issues implicitly or explicitly decided on appeal.” *Amado v. Microsoft Corp.*, 517 F.3d 1353, 1364 (Fed. Cir. 2008). “The mandate rule, encompassed by the broader law-of-the-case doctrine, dictates that ‘an inferior court has no power or authority to deviate from the mandate issued by an appellate court.’” *Banks v. United States*, 741 F.3d 1268, 1276 (Fed. Cir. 2014) (citation omitted). Thus, the Board is “bound by the mandate on matters the mandate addressed.” *Zodiac Pool Sys., Inc. v. Aqua Prod., Inc.*, No. IPR2013-00159 (P.T.A.B. Feb. 11, 2019); *see also, e.g.*, 35 U.S.C. § 144 (a Federal Circuit “mandate and opinion ... shall govern the further proceedings” in a case before the Board); *Sprague v. Ticonic Nat. Bank*, 307 U.S. 161, 167–69 (1939).

1. The Federal Circuit Decided That Apfel Discloses The “Comparing” Step

The Federal Circuit decided that Apfel discloses the “comparing” step. *See, e.g.*, Paper 29, 3 (“[T]he Board erred in concluding that Apfel does not perform the claimed ‘comparing’ step.”).

Patent Owner agrees that the Court determined that “Apfel requires a comparing step.” Paper 31, 2 (Section IV header). Despite this admission, Patent Owner argues that the Court—in making this determination—was not evaluating Apfel in relation to the ’088 patent’s claimed comparing step. *Id.*, 2–8 (arguing that

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.