

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD. and  
GOOGLE LLC,  
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,  
Patent Owner.

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IPR2018-01552<sup>1</sup>  
Patent 5,699,275

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Before SALLY C. MEDLEY, PATRICK R. SCANLON, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

JUDGMENT  
Final Written Decision  
Determining the Challenged Claim Unpatentable  
*35 U.S.C. § 318(a)*

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<sup>1</sup> Google LLC, who filed a petition in IPR2019-00110, has been joined as a petitioner in this proceeding.

## I. INTRODUCTION

Samsung Electronics Co., Ltd. (“Petitioner”)<sup>2</sup> filed a Petition for *inter partes* review of claim 1 of U.S. Patent No. 5,699,275 (Ex. 1001, “the ’275 patent”). Paper 1 (“Pet.”). Iron Oak Technologies, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted *inter partes* review, pursuant to 35 U.S.C. § 314, as to claim 1 based on all challenges set forth in the Petition. Paper 9 (“Decision to Institute” or “Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 20, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 21, “Sur-reply”). On November 4, 2019, we held a consolidated oral hearing for this case and related Case IPR2018-01553. A transcript of the hearing has been entered into the record. Paper 28 (“Tr.”).

In our Scheduling Order, we notified the parties that “any arguments for patentability not raised in the [Patent Owner] response may be deemed waived.” *See* Paper 10, 5; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) (“The patent owner response . . . should identify all the involved claims that are believed to be patentable and state the basis for that belief.”). In addition, “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3) (2018). In violation of our rule and guidance, Patent

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<sup>2</sup> Petitioner, Samsung Electronics Co., Ltd., identifies Samsung Electronics America, Inc. as a real party-in-interest. Pet. 1.

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Owner argues in its Patent Owner Response: “Patent Owner incorporates herein those arguments presented in its Preliminary Response for all purposes.” PO Resp. 1. We decline to consider whatever Patent Owner considers is “incorporated” from its Preliminary Response as if it were a part of Patent Owner’s Response, but only consider arguments substantively presented in Patent Owner’s Response. Any arguments for patentability not raised in the Patent Owner Response are deemed waived.

For the reasons that follow, we conclude that Petitioner has proven by a preponderance of the evidence that claim 1 of the ’275 patent is unpatentable.

#### *A. Related Matters*

The parties indicate that the ’275 patent is the subject of several stayed court proceedings. Pet. 1–2; Paper 6, 2–3; Paper 18, 4. The ’275 patent also is the subject of Board proceedings IPR2018-01553 and IPR2019-00106. A Final Written Decision is made in each of IPR2018-01553 and IPR2019-00106 concurrently with this Final Written Decision. In IPR2019-00110, Google LLC filed a motion to join IPR2018-01552, which we granted. *See Google LLC v. Iron Oak Techs., LLC*, IPR2019-00110, Paper 11 (PTAB Apr. 3, 2019). In IPR2019-00111, Google LLC filed a motion to join IPR2018-01553, which we granted. *See Google LLC v. Iron Oak Techs., LLC*, IPR2019-00111, Paper 10 (PTAB Apr. 3, 2019).

#### *B. The ’275 Patent*

The specification of the ’275 patent describes a system “for remote patching or updating of operating code located in a mobile unit.” Ex. 1001, code (57). The system includes a manager host operable to initiate transmission of a discrete patch message to a mobile unit. *Id.* The mobile

unit is operable to create patched operating code by merging the patch with the current operating code and to switch execution to the patched operating code. *Id.* The mobile unit also can receive a download message defining new operating code to replace current operating code. *Id.*

*C. Illustrative Claim*

Petitioner challenges claim 1 of the '275 patent. Claim 1 is reproduced below.

1. A system for remote patching of operating code located in a mobile unit, comprising:

a manager host operable to initiate transmission through a wireless communication network of at least one discrete patch message defining at least one patch;

a first mobile unit operable to receive the at least one discrete patch message, the first mobile unit further operable to create patched operating code by merging the at least one patch with current operating code located in the first mobile unit and to switch execution to the patched operating code; and

a second mobile unit operable to receive the at least one discrete patch message, the second mobile unit further operable to create patched operating code by merging the at least one patch with current operating code located in the second mobile unit and to switch execution to the patched operating code; and

wherein the manager host is further operable to address the at least one discrete patch message such that the at least one discrete patch message is transmitted to the first mobile unit but not to the second mobile unit.

*Id.* at 13:32–53.

*D. Instituted Grounds of Unpatentability*

We instituted trial based on all asserted grounds of unpatentability under 35 U.S.C.<sup>3</sup> as follows (Dec. 4, 26):

Claim Challenged	35 U.S.C. §	Reference(s)
1	102	Sugita <sup>4</sup>
1	103	Sugita, Wortham <sup>5</sup>
1	103	Ballard, <sup>6</sup> Shimizu <sup>7</sup>

II. ANALYSIS

*A. Principles of Law*

To prevail in its challenge to Patent Owner’s claim, Petitioner must demonstrate by a preponderance of the evidence<sup>8</sup> that the claim is unpatentable. 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d). To establish anticipation, each and every element in a claim, arranged as recited in the

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<sup>3</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the ’275 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

<sup>4</sup> JP Published Patent Application No. 1993-128022, published May 25, 1993 (Ex. 1005, “Sugita”).

<sup>5</sup> U.S. Patent No. 5,155,689, issued Oct. 13, 1992 (Ex. 1014, “Wortham”).

<sup>6</sup> Australian Patent Application No. 77395/91, published May 12, 1991 (Ex. 1006, “Ballard”).

<sup>7</sup> JP Published Patent Application No. 05-66937, published Mar. 19, 1993 (Ex. 1007, “Shimizu”).

<sup>8</sup> The burden of showing something by a preponderance of the evidence simply requires the trier of fact to believe that the existence of a fact is more probable than its nonexistence before the trier of fact may find in favor of the party who carries the burden. *Concrete Pipe & Prods. of Cal., Inc. v. Constr. Laborers Pension Tr. for S. Cal.*, 508 U.S. 602, 622 (1993).

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