

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG TECHNOLOGIES, LTD.,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

IPR2018-01552
U.S. Patent No. 5,699,275

IPR2019-00106
U.S. Patent No. 5,699,275

PATENT OWNER COMBINED RESPONSE

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I. INTRODUCTION

The Board instituted review of claim 1 of U.S. Patent No. 5,699,275 (“the ’275 patent”) based on two petitions, one filed by petitioner Samsung (IPR2018-1552) and the other filed by petitioner Microsoft (IPR2019-106). Both petitions are based primarily on the Petitioner’s characterizations of the Japanese Sugita reference (Ex. 1005 in both proceedings, but different translations). Petitioner Samsung also based its petition on Ballard as a primary reference. Petitioner Microsoft uses Ballard as a secondary reference (Ex. 1006 in both petitions).

This is a combined response to both petitions.

Patent Owner presents herein only those arguments necessary to defeat the petitions. Patent Owner does not accede to those arguments and evidence set forth in the petitions, or to the conclusions drawn by the Board in the Institution Decision, that are not directly addressed herein. Patent Owner incorporates herein those arguments presented in its Preliminary Response for all purposes.

II. NEITHER PETITION DEMONSTRATED INVALIDITY OF CLAIM 1 BY A PREPONDERANCE OF THE EVIDENCE

After institution, Petitioner has the burden of persuasion to establish by a preponderance of the evidence that claim 1 is invalid as alleged in the petition. 35 U.S.C. § 316(e); *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1334 (Fed. Cir. 2016)

("[T]he burden of proof is on the petitioner to prove unpatentable those issued claims that were actually challenged in the petition for review and for which the Board instituted review."). The burden of persuasion never shifts to the Patent Owner. *Dynamic Drinkware LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) ("In an *inter partes* review, the burden of persuasion is on the petitioner to prove 'unpatentability by a preponderance of the evidence,' 35 U.S.C. § 316(e), and that burden never shifts to the patentee.").

Additionally, the ***burden of production*** never shifts to the Patent Owner. *In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016) ("We thus disagree with the PTO's position that the burden of production shifts to the patentee upon the Board's conclusion in an institution decision that "there is a reasonable likelihood that the petitioner would prevail.").

In other words, to prevail on its allegation that claim 1 is anticipated by Sugita, a Petitioner must have produced a preponderance of evidence in its petition showing that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). As shown below, when the content of Sugita is properly characterized neither Petitioner has met this burden.

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