

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00106
Patent 5,699,275

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

MEDLEY, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Microsoft Corporation (“Petitioner”) 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 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claim 1 of the ’275 patent.

A. Related Matters

The parties indicate that the ’275 patent is the subject of several court proceedings. Pet. 3–4; Paper 3, 2–3. The ’275 patent also is the subject of Board proceedings IPR2018-01552, IPR2018-01553, IPR2019-00110, and IPR2019-00111. Pet. 3; Paper 3, 3.

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, [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 Claims

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. Asserted Grounds of Unpatentability

Petitioner asserts that claim 1 is unpatentable based on the following grounds (Pet. 5–6):

Reference(s)	Basis	Challenged Claim
Sugita ¹	§ 102	1
Sugita	§ 103	1
Sugita and Burson ²	§ 103	1
Sugita and Kirouac ³ with or without Burson	§ 103	1
Sugita and Ballard ⁴ with or without Burson and Kirouac	§ 103	1

II. DISCUSSION

A. Claim Construction

The '275 patent is expired. Ex. 1001; Pet. 13. For claims of an expired patent, our claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Moreover, for claims of an expired patent, the Board construes claims to generally have their ordinary and customary meaning, as that meaning would be understood by one of ordinary skill in the art in the context of the entire patent disclosure. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*). Petitioner contends that the claims should be construed consistent with the principles set forth in *Phillips*. Pet. 13.

Petitioner proposes constructions for the following claim terms found in challenged claim 1: “mobile unit,” “current operating code,” “manager

¹ JP Published Patent Application No. 1993-128022, published May 25, 1993 (Ex. 1005, “Sugita”).

² U.S. Patent No. 5,550,895, issued Aug. 27, 1996 (Ex. 1008, “Burson”).

³ U.S. Patent No. 5,155,847, issued Oct. 13, 1992 (Ex. 1007, “Kirouac”).

⁴ Australian Patent Application No. 77395/91, published May 12, 1991 (Ex. 1006, “Ballard”).

host operable to initiate transmission through a wireless [communication] network of at least one discrete patch message defining at least one patch,” “merging the at least one patch with current operating code,” and “manager host is further operable to address the at least one discrete patch message.” Pet. 8–16. Patent Owner does not oppose Petitioner’s proposed constructions. *See generally* Prelim. Resp.; *id.* at 4.

“merging the at least one patch with current operating code”

Claim 1 recites “the first mobile unit [second mobile unit] further operable to create patched operating code by *merging the at least one patch with current operating code.*” Petitioner argues that “merging the at least one patch with current operating code” means “incorporating the at least one patch into the current operating code, without replacing the current operating code.” Pet. 17. We determine that Petitioner’s proposed construction is consistent with the specification of the ’275 patent, which consistently describes merging as incorporating at least one patch into the current operating code without replacing the entire operating code. Ex. 1001, 1:54–61, 2:2–5, 3:63–66, 4:65–5:10, 6:60–7:5, 7:28–30, 10:24–32, 11:22–25, 11:54–12:26. Therefore, for purposes of this Decision, we adopt Petitioner’s proposed claim construction, interpreting “merging the at least one patch with current operating code” as “incorporating the at least one patch into the current operating code, without replacing the current operating code.”

*“manager host is further operable to address
the at least one discrete patch message”*

Claim 1 recites that 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

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.