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

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MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

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

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# PATENT OWNER SUR-REPLY

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Petitioner's burden was to file a Petition that "specif[ied] where each element of [Claim 1] is found in the prior art patents or printed publications relied upon;" and "the exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104 at (4). Further, "[t]he Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104 at (5). See Response at 1-4.

As shown below, among other things, the Petition did not adequately specify where the Sugita reference disclosed a Manager Host operable to decide ***not*** to initiate transmission of the at least one patch message to a ***second mobile unit***, which second mobile unit is operable to create patched operating code ***from the current operating code and the at least one patch.*** Because the Petition did not adequately specify where each claim element is found in the prior art, the Petition must be denied.

## I. INTRODUCTION

Petitioner's Reply highlights why the Petition fails to demonstrate unpatentability of Claim 1. Distilled to its essence, the Petition failed to demonstrate by a preponderance of the evidence how Sugita disclosed a Manager Host that is operable to decide ***not*** to initiate transmission of the at least one patch message to a

***second mobile unit*** that is operable to create patched operating code ***from the current operating code and the at least one patch***, a patch that was also able to be sent to, received by, and merged into the first mobile unit.

In other words, the literal wording and organization of Claim 1, as construed by the Panel, requires that both the First and Second Mobile Units be

> further operable to create patched operating code by incorporating the at least one patch into the current operating code, without replacing the current operating code.

See Ex.1001 at claim 1 & Decision at 5 (incorporating Panels' construction).

Not only do the First and Second Mobile Units of Claim 1 have to be "operable to ***receive*** the at least one discrete patch message" (which is ***the*** patch message that the Manager Host is operable to transmit), the First and Second Mobile Units also have to be "further operable to ***create*** patched operating code by merging ***the at least one patch*** with ***current operating code***." See Ex.1001 at Claim 1 (emphasis added).

Thus, the literal wording and organization of claim 1 requires that a First Mobile Unit and Second Mobile Unit be operable to create patched operating code from the same "at least one patch," and that the Manager Host be operable to decide ***not*** to initiate transmission of that "at least one patch" to the Second Mobile Unit,

even though the Second Mobile Unit is operable to create patched operating code from ***the*** "at least one patch" and the "current operating code." [1]

## II. PETITIONER'S REPLY HIGHLIGHTS THE INADEQUACY OF THE PETITION

In Reply, Petitioner argues that Patent Owner makes a "convoluted argument based on an overly narrow interpretation of the claim …" Reply at 3.[2] To support

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[1] Claim 12, which depends directly from Claim 1, further limits the system of Claim 1 by requiring that the Manager Host is further operable to address another discrete patch message to the Second Mobile Unit but not the First Mobile Unit. Further, Claim 14, which depends directly from Claim 1, further limits the system of Claim 1 by requiring that the Manager Host is further operable to address ***the*** discrete patch message of Claim 1 to the First Mobile Unit and the Second Mobile Unit. Thus, it is clear from Claims 1, 12 and 14 that the discrete patch message of Claim 1 that is not sent to the Second Mobile Unit in Claim 1 is clearly the same discrete patch message that is sent to the First Mobile Unit.

[2] Petitioner appears to contend that the argument is "convoluted" because Patent Owner cited to Petitioner's certified Sugita translation (i.e., Ex. 1005), and reprinted portions of the certified Sugita translation filed in IPR2018-01552. One would

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