

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

Record of Oral Hearing
Held: November 4, 2019

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

Case IPR2019-00106
Patent 5,699,275

APPEARANCES:

ON BEHALF OF THE PETITIONER:

JOSEPH MICALLEF, ESQ.
Sidley Austin LLP
1501 K Street, N.W.
Washington, D.C. 20005

ON BEHALF OF THE PATENT OWNER:

ALBERT DEEVER, ESQ.
McAughan Deaver PLLC
550 Westcott Drive, #375
Houston, Texas 77007

The above-entitled matter came on for hearing on Monday, November 4, 2019, commencing at 2:45 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, VA, 22314.

PROCEEDINGS

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BAILIFF: All rise.

JUDGE MEDLEY: We're on the record. Good afternoon. This is the hearing for IPR2019-00106 involving U.S. Patent No. 5,699,275. At this time we'd like the parties to please introduce Counsel for the record, beginning with Petitioner.

MR. MICALLEF: Thank you, Your Honors. Good afternoon; Joe Micallef with Sidley Austin for Petitioner, Microsoft Corporation. With me is my partner, Scott Border (phonetic), and my client, Mark Taylor from Microsoft.

JUDGE MEDLEY: Thank you; for Patent Owner?

MR. DEEVER: Good afternoon, Your Honors, Al Deever for Patent Owner.

JUDGE MEDLEY: Okay. Each party has 30 minutes, total time, for their arguments. Petitioner, you'll proceed first and you can reserve argument time if you'd like, and then Patent Owner you'll respond to Petitioner's presentation. You may reserve argument time for sur-rebuttal. Petitioner, do you wish to reserve some of your time?

MR. MICALLEF: Yes, Your Honor, I'd like to reserve 10 minutes; thank you.

JUDGE MEDLEY: Patent Owner?

MR. DEEVER: Fifteen, please.

JUDGE MEDLEY: So, as a reminder, please refer to the slide number so that we may follow along. Also, please speak into the microphone at the podium so that we all may hear. We'd like to remind the

1 parties that this hearing is open to the public and the transcript will be
2 entered into the public record of the proceeding. Petitioner may begin.

3 MR. MICALLEF: Thank you, Your Honors. Once again, this is Joe
4 Micallef for Petitioner, Microsoft. Your Honors, I know you just had a
5 hearing on this same patent, this same claim, this same prior art reference;
6 and I've looked at the papers in that proceeding and it appears to be the
7 reading, the analysis on that Sugita prior art reference is very similar, if not
8 the same. So, I'm going to try not to go over the things that you just spent
9 an hour or so talking about; but I do want to hit a couple of high level points
10 in this proceeding. Now, I'd like to start with ours --

11 JUDGE MEDLEY: Keep in mind though that the transcript for that
12 other proceeding will not be going into the record of the '106 case.

13 MR. MICALLEF: I certainly understand that, Your Honor.

14 JUDGE MEDLEY: So, if you want to say something, you should say
15 it here.

16 MR. MICALLEF: I will definitely do that; thank you. I want to start
17 with slide 17 of our demonstratives. And Patent Owner's argument here
18 renders down to what, I think, it renders down to in the other proceeding as
19 well, a request, a least implicit request, that the Board read a temporal
20 limitation into the claim. What's sort of interesting here is the temporal
21 limitation that Patent Owner has asked to be read in, at least in its Patent
22 Owner response to the sur-reply is -- and it's captured, I think, up there on
23 our slide number 17, where we have a quote from the Patent Owner response
24 at page 7 -- it's a temporal limitation relating to the functionality of the
25 mobile units of the claim.

1 Now, I want to start to make two points about that, that we made in
2 our papers, and that is they've never justified reading that kind of limitation
3 in. They've never explained why the ordinary meaning of the claim
4 language requires that, or why there's something in the specification that
5 imposes that spin on it without limitation or pointed to anything in the
6 prosecution history or the extrinsic record; they've just said it requires it.
7 We've pointed out -- and by not justifying it, I think they waited, because we
8 all know what the law is under Phillips, they have to, if they're asking for
9 something other than the ordinary meaning, they're going to have to justify
10 it on the extrinsic record.

11 I think we've pointed out in our brief that this kind of operability
12 language is generally understood as its ordinary meaning includes no
13 temporal limitation, at least not in the context of an apparatus claim, like we
14 have here. Obviously, I don't know what Counsel for Patent Owner's going
15 to say when he stands up here; but I did here earlier this afternoon that
16 Patent Owner now has a different temporal limitation that they would like to
17 have read into this claim, at least in the other proceeding.

18 And that temporal limitation is a temporal limitation that relates to the
19 functionality of the manager host which, of course, is a different component
20 of the claim. And that temporal limitation has also not been justified in any
21 of the filings here. I heard it was supposedly justified by the portion of the
22 claim construction, the phraseology operable to decide; but once again,
23 under *Parker Vision*, that kind of operability language in its ordinary
24 meaning doesn't have any temporal limitation.

25 I heard him point to passages in the Spec., column 2, lines 23 to 24;
26 column 4, lines 12 to 15 of the '275 Patent. I studied that at the break, and

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