

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00107
Patent 5,966,658

PATENT OWNER'S NOTICE OF APPEAL

Pursuant to 37 C.F.R. § 90.2(a), notice is hereby given that Patent Owner Iron Oak Technologies, LLC (“Iron Oak”) appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision of the Patent Trial and Appeal Board (“PTAB”) entered on May 7, 2020 (Paper 24) in Case No. IPR2019-00107, and from all underlying orders, decisions, rulings, and opinions including the earlier entered Final Written Decision entered on April 6, 2020 (Paper 23).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Iron Oak anticipates that the issues on appeal may include, but are not limited to:

I. The PTAB’s construction of certain words, terms and/or phrases in claim 1 of U.S. Patent No. 5,966,658 (“the ‘658 patent”), as well as the PTAB’s determination that it was not necessary to provide claim constructions of other disputed terms.

II. The PTAB’s determination that the claim phrase “a plurality of ordered lists of communication paths, each ordered list associated with one of a plurality of communication attributes, each communication attribute representing a separate priority for communication,” in claim 1 of the ‘658 patent was disclosed or taught by the cited references.

III. The PTAB's determination that Microsoft Corporation ("Microsoft") had shown, by a preponderance of the evidence, that claim 1 of the '658 patent is determined to be unpatentable under 35 U.S.C. § 102 in light of U.S. Patent No. 5,509,000 ("Oberlander".)

IV. The PTAB's determination that Microsoft had shown, by a preponderance of the evidence, that claim 1 of the '658 patent is determined to be unpatentable under 35 U.S.C. § 103 in light of Oberlander.

V. The PTAB's determination that Microsoft had shown, by a preponderance of the evidence, that claim 1 of the '658 patent is determined to be unpatentable under 35 U.S.C. § 103 in light of U.S. Patent No. 5,953,319 ("Dutta") in view of Oberlander.

VI. The PTAB's retroactive application of inter partes review to the '658 Patent, which issued prior to the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (effective September 16, 2012.)

VII. The PTAB permitting a Panel to issue a decision in this IPR regarding the patentability of claim 1 of the '658 Patent when two of the three administrative judges were appointed in violation of the

Appointments clause of the U.S. Constitution and previously had issued a decision adverse to claim 1 of the '658 patent, rather than constituting an entirely new panel of Constitutionally-appointed administrative judges to decide this case. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 18-2140, (CAFC, October 31, 2019); *Lucia v. SEC*, 138 S. Ct. 2044 (2018.)

VIII. Any findings or determinations relating to the foregoing issues, as well as all other issues decided adversely to Iron Oak in any orders, decisions, rulings, or opinions.

Pursuant to 37 C.F.R. § 90.2(a), this Notice of Appeal is being filed with the Director of the United States Patent and Trademark Office as provided in 37 C.F.R. § 104.2; with the Patent Trial and Appeal Board as provided in 37 C.F.R. § 42.6(b); and with the Clerk's Office for the United States Court of Appeals for the Federal Circuit as provided in Fed. Cir. R. 15(a)(1) and 25(b)(1), along with payment of the required fee.

Date: May 13, 2020

Respectfully submitted,
/ Robert J. McAughan, Jr. /
Robert J. McAughan, Jr., Reg. #36,599
Lead Counsel for Patent Owner

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on May 13, 2020 I caused a true and correct copy of the foregoing Patent Owner's Notice of Appeal to be served via email, as previously agreed by the parties, on the following Counsel for Petitioner:

Joseph A. Micallef (Reg. No. 39772) at jmicallef@sidley.com (202.736.8492)
Scott M. Border at sborder@sidley.com (202.736.8818)
Through their email alias at sidley_microsoft_ironoak_ipr@sidley.com
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The undersigned hereby also certifies that in addition to being filed and served electronically through the Board's E2E System, the foregoing document was filed on May 13, 2020 with the Director of the United States Patent and Trademark Office by way of UPS overnight delivery to:

Office of the General Counsel
U.S. Patent and Trademark Office
10B20, Madison Building East
600 Dulany Street
Alexandria, Virginia 22314

The undersigned hereby also certifies that the foregoing document was filed on May 13, 2020 with the Clerk's Office of the United States Court of Appeals for the Federal Circuit through the court's Case Management and Electronic Case Files (CM/ECF) system along with the requisite fee. As per Administrative Order 20-01

of March 20, 2020, of the Court of Appeals for the Federal Circuit, no paper copies of this document were served to the Court.

Date: May 13, 2020

Respectfully submitted,
/ Robert J. McAughan, Jr. /
Robert J. McAughan, Jr., Reg. #36,599
Lead Counsel for Patent Owner