


December 8, 2021

VIA EMAIL ONLY

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IP Strategy
Ivanti, Inc.
10377 South Jordan Gateway, Suite 110
South Jordan, UT 94095

Re: *Patch my PC - Ivanti*
Response to November 1, 2021 Letter
Notice of Lack of Compliance with Fed. R. Civ. P. 11

Dear Mr. Brunell:

We represent Patch my PC in patent litigation matters. Please direct all further correspondence to our firm. This is to respond to your November 1, 2021 letter and to follow up on my November 18, 2021 conversation with you, and in anticipation of our follow-up call.

We have thoroughly investigated the allegations of your letter and its enclosed claim charts. Patch my PC does not infringe any claim of U.S. Patents 6,990,660 ("the '660 patent"), 7,823,147 ("the '147 patent") or 8,507,687 ("the '687 patent"), either literally or under the doctrine of equivalents. Accordingly, Patch my PC is not interested in licensing these patents or paying any settlement fees. This letter sets forth some, but not all, of the reasons there is no infringement based on our investigation.

We provide this information to you for two reasons. One, if you have additional information which in your view would change our analysis, we will review it. We think it is in both parties' interests to fully understand the position of the other party. However, given the allegations relate to the operation of the Patch my PC product, we are confident that we are in a position to have all the facts necessary to address the infringement allegations.

Two, the letter shows in detail why Ivanti's claim charts fail to set forth a Fed. R. Civ. P. 11 basis for Ivanti to proceed with litigation. Patch my PC will seek attorney's fees and costs from Ivanti should it proceed with filing a lawsuit. Our analysis follows:

I. No Infringement of the '660 Patent

Ivanti has provided a claim chart for claim 1 of the '660 Patent. This is a method claim, which requires that Patch my PC perform all of the steps of claim 1. The claim chart completely fails to show how Patch my PC performs each and every step of claim 1.

In this regard, we note that Patch my PC customers have computers with the Microsoft Windows Server Update Service (WSUS) installed. Patch my PC merely provides a file with information about updates and patches. Any further work is carried out by WSUS and other Microsoft products. Patch my PC therefore does not and cannot perform the steps outlined in claim 1, which relate to activities occurring on target computers.

During our call, I recall that you acknowledged this hole in your analysis. You suggested that you considered Patch my PC an infringer anyway. You provided no basis for that allegation, however, either in your claim chart or in our call. That is a serious deficiency in your allegations.

Moreover, no one else performs all steps of claim 1 either, even when Patch my PC files are used. The specific elements and steps of claim 1 of the '660 patent that are not performed include but are not limited to the following:

Preamble:

We understand that the "first target computer" is the computer to be updated/patched. The preamble also requires a "repository component," the definition of which is not clear. It appears from later claim elements that the repository component be a file with update/patch information customized to the target computer. That is consistent with the patent's description.

Your claim chart asserts "Patch my PC has update servers that connect to the target computers through agents." However, you cite no support for this statement, and nothing in the Patch my PC documentation included in

your charts supports this. Patch my PC takes a fundamentally different approach. It provides a single, common file of information that is identical for and distributed to multiple "target computers" without regard to the characteristics of any individual target computer. There is no "repository component" when Patch my PC services are used. And as further addressed below with individual elements of the claim, Patch my PC does not use any device which could constitute an "update server" that performs the claimed steps.

Element (a):

Patch my PC's generic update/patch files merely provide information. They are not "configured to request target information from the target computer" as required by element (a). Instead, PCs on the system have their own intelligence and maintain PC information that allows them to self-direct what patches and updates to implement. Also, consistent with the above discussion of the preamble, there is no "repository component" that is configured to request information or that includes "recommended configuration information for the first target computer."

Element (b):

"Gathering" target information does not occur through use of Patch my PC products or services. The "Microsoft Windows Update Agent" on individual PCs may assess information on the PC, but any such step would be performed without prompting or direction from Patch my PC and stored in the \Windows\SoftwareDistribution\DataStore\DataStore.edb file. Ivanti's chart (and my November 18, 2021 conversation with you confirms this) concedes that the purported "discovery agent" is in the Microsoft system.

Moreover, you allege that the Patch my PC file provides "patch signatures" as claimed. However, the purported discovery agent operates to gather information independently of the Patch my PC file, so it does not "utilize the patch signature to gather the target computer information." The purported patch signature is not utilized at all in the gathering of any information at target computers.

There also is no infringement of this element because the Patch my PC logical file is the same for all PCs and is agnostic as to the changes needed by any particular PC. The Patch my PC file does not "define current

configuration information of the first target computer.” The prosecution history affirms that the invention relates to centrally locating the intelligence for assessing individual PC needs and does not encompass implementing such functionality at individual PCs as is done with PCs which implement WSUS. In other words, the '660 patent was obtained in large part because the patent applicant admitted before the U.S. Patent and Trademark Office that systems like the one that implements Patch my PC files take a fundamentally different approach from the method claimed in the patent. Ivanti is bound by those concessions and must abide by them when enforcing the patent.

Element (c):

When Patch my PC files are used, no one performs the claimed step of “sending the target computer information” ... “back to ... the update server” or to any component such as a repository component located on an update server. The target computer has the intelligence to detect which patches are needed, and to directly apply the patches locally on the target computer without sending any discovery information to an update server. The Patch my PC logical data file is agnostic to patches needed by individual PCs, so there is no reason to send information about individual PCs back to an update server. Therefore, step (c) is not performed by anyone when Patch my PC products and services are used.

Element (e):

There is no comparing “at the update server.” Any scanning and update comparisons are done on the client computer by Microsoft Windows Update Agent.

You failed to identify any server that could correspond to the claimed update server that performs this comparing step. Indeed, your analysis of this element (“Notes”) does not even *mention* an update server.

Element (f):

There is no “task identifier specifying the first” or any other target computer nor are there links any updates on a package computer specific to

a target computer. Far from providing a task identifier specifying target computers, Patch my PC provides a generic logical data file that is not specific to individual computers. Your analysis of this element fails to identify anything in the Patch my PC system that corresponds to the claimed task list. The prosecution history of the '660 patent confirms that the claims require intelligence to be centrally located and confirms that the method used when implementing Patch my PC products and services is fundamentally different from the method claimed.

Element (g):

No task is started "in response to a task identifier" when Patch my PC products and services are used. Instead, individual PCs initiate the downloads based on schedule configured in Microsoft Endpoint Configuration Manager and not in response to any files provided by Patch my PC. Also, there is no "specific" target update downloaded from a package computer to an update server.

Again, your analysis of this element ignores the requirements of the claim element, at least through failing to even mention the requirement that the task be started "in response to a task identifier." This is yet another fundamental difference that shows no one performs this claimed step when Patch my PC products and services are used.

Conclusion

Infringement requires a showing that a single entity performs each and every step as recited in the claims. If even one claim requirement is missing, there is no infringement. As the above analysis shows, there are several claim requirements that are missing when the Patch my PC system is used. Ivanti's purported support for its allegation of infringement is woefully inadequate, ignoring several requirements of the claims and also failing to identify any actor who performs all the claimed steps.

II. No Infringement of '147 Patent

Ivanti has provided a claim chart for claim 1 of the '147 Patent. This is a system claim, which would require Patch my PC to make, use, sell, offer to sell, or import a system including each of the elements of claim 1. The chart is deficient for a variety of reasons, including but not limited to the following:

Element (a):

Patch my PC does not use "XML metadata queries," as required by claim 1 (and as admitted by Ivanti during our call on November 18, 2021). We understand that Ivanti acknowledges this and that it relies on the doctrine of equivalents to allege this element. This is a striking acknowledgement, as the claim chart you provided to Patch my PC nowhere indicates that Ivanti relies on the doctrine of equivalents. In any event, the doctrine of equivalents is not available to Ivanti for this element, and thus there is no infringement of the '147 patent at least for this reason.

All 20 original claims were rejected by the examiner during prosecution as obvious in view of the prior art in an office action dated March 4, 2009. These claims were cancelled and replaced with new claims, including what issued as claim 1 (claim 21 during prosecution) in a September 4, 2009 response to the office action. Applicant amended the claims by adding references to "XML metadata queries," and argued that claim 1 was allowable over the prior art previously cited by the examiner, stating that "[t]he claimed patch fingerprints contain an XML metadata query," that "Collins [the prior art] does not disclose, teach, or suggest Software Packages that use an XML metadata query," and that "the instant claims require the use of the XML metadata query in combination with a discovery agent to gather target computer information."

Prosecution history estoppel arises when elements are added to claims during prosecution to convince the examiner to find the claims are patentable, as occurred here. When elements are so added, the patentee must show those added elements literally exist in the accused system and cannot rely on the doctrine of equivalents. See *Honeywell Intern., Inc., Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1312 (Fed. Cir. 2008) ("The doctrine of prosecution history estoppel prevents a patent owner from recapturing with the doctrine of equivalents subject matter surrendered to

acquire the patent.”); *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1356 (Fed. Cir. 2003) (“Prosecution history estoppel serves to limit the doctrine of equivalents by denying equivalents to a claim limitation whose scope was narrowed during prosecution for reasons related to patentability.”).

Accordingly, the doctrine of equivalents is not available to Ivanti as a matter of law regarding the “XML metadata query” elements. Here, during prosecution the applicant specifically added a requirement that the claims use “XML metadata queries” in order to convince the examiner to allow the claims over prior art which did not purportedly use XML metadata queries. Ivanti, therefore, must show XML metadata queries are literally used in the accused system. Ivanti’s assertion that Patch my PC infringes because it uses something similar to XML metadata queries is simply not an option for Ivanti, and its infringement assertion fails as a result.

Other elements of claim 1 of the ‘147 patent are lacking as well when Patch my PC products and services are used. Much of the analysis above regarding the ‘660 patent also shows this regarding the ‘147 patent. Merely one more example is the following:

Element (c):

The claimed “discovery agent” as alleged in the claim chart is WSUS Config Mgr or other Microsoft functionality is not “configured to separately interact with” any data queries to produce target computer information, as this claim element requires. Further, “first target computer information” is not “produced” in response to anything sent from an update server and is not associated with XML metadata queries or patches. Lastly, Patch my PC does not use or provide an update server that sends the claimed queries or “determine[s] at the update server based on the first target computer information, whether the specific software update is both applicable to and absent from the first target computer” as claimed. No such determinations are made, as the same logical file goes to each PC.

Your claim chart provides no support for any assertion that this claim element is satisfied. Instead, your chart makes assertions “on information and belief,” and even these unsupported assertions do not address all of the claim element requirements. This is but one example of the inadequacy of Ivanti’s allegations.

The analysis of the '660 patent above provides more detail relating to the fundamental differences between the Ivanti system and the '147 patent.

III. No Infringement of '687 Patent

Ivanti has also provided a claim chart for claim 1 of the '687 Patent. This is a method claim, which requires that Patch my PC perform all of the steps of claim 1. The claim chart also completely fails to show how Patch my PC performs each and every step of claim 1.

Element (a):

As noted above, no one using Patch my PC products or services uses XML metadata queries as required by this element, so there is no literal infringement. Further, there is no infringement under the doctrine of equivalents because the '687 patent is a continuation of the '660 patent and is bound by the estoppel that arose from prosecution of that parent application. *See Elkay Mfg. Co. v. Ebc Co. Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999) ("When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation.") (citing *Jonsson v. The Stanley Works*, 903 F.2d 812, 817-818 (Fed.Cir.1990) (holding that when two patents issued from continuation-in-part applications derived from one original application, the prosecution history of a claim limitation in the first patent to issue was properly applied to the same claim limitation in the second patent to issue)). Therefore, there is no infringement of claim 1.

The infringement allegations related to claim 1 of the '687 patent suffer from several other deficiencies as well. For example:

Elements (b) - (d):

Patch my PC does not perform these steps as there is no "repository component" and no "sending" or XML queries "from the update server to a first target computer." Nor is scanning done "utilizing" any such query emanating from an "update server" to "produce target computer information."

Your chart alleges that "Patch my PC sends metadata queries . . . through ether (sic) SCCM or Intune in XML format." However, nothing in the information cited supports this allegation. Moreover, your analysis does not address the need for an "update server" to send queries that are utilized to produce target computer information. This does not happen in the Patch my PC system. More detailed explanation for the differences from the claimed method is provided in connection with the analysis herein of the '660 patent.

Element (e):

Patch my PC does not "send[] the target computer information to the repository component located on the update server" as shown in more detail herein. Nothing in the materials cited describe any such step occurring in the Patch my PC system.

Element (g):

Patch my PC does not perform the step of "comparing, at the update server, at least a portion of the target computer information with at least one of the patch fingerprints." Nothing that could correspond to a purported "update server" performs this step, as individual PCs have the intelligence, also as shown in more detail herein. Nothing in the cited material regarding the Patch my PC product supports your assertion that this comparing step is performed at an update server.

Elements (h) – (j):

The purported update server used with the Patch my PC system sends the same file to all PCs. The update server does not "determine[e], in response to the comparing step (g), whether the specific software update is absent from the first target computer" as claimed. This also is explained in more detail herein. Again, your chart cites nothing from the Patch my PC description that would support this allegation.

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In summary, your analysis wholly fails to support any of your allegations. Patch my PC does not infringe any of the claims in the claim charts. We request that you withdraw your allegations accordingly.

Yours truly,

A handwritten signature in black ink that reads "Daniel W. McDonald". The signature is written in a cursive, slightly slanted style.

Daniel W. McDonald

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