

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IPR LICENSING, INC.,
Patent Owner.

Case IPR2015-00074
Patent 8,380,244 B2

Before SALLY C. MEDLEY, BEVERLY M. BUNTING, *Administrative
Patent Judges.*

BUNTING, *Administrative Patent Judge.*

ORDER

A conference call in IPR2015-00074 was held on February 13, 2015, among respective counsel for Petitioner, Microsoft Corporation, and Patent Owner, IPR Licensing, Inc., and Judges Bunting and Medley.

The call was initiated by the Panel to discuss the motion for joinder of IPR2015-00074 (“the ’074 petition”) with recently instituted IPR2014-00525 (“the ’525 IPR”) presently under consideration. We remarked that 35 U.S.C. 315(c) gives the Board discretion over whether to allow joinder, and that the one-year time bar of 35 U.S.C. § 315(b) is not applicable to a request for joinder. In addition, we reviewed the various factors that influence our consideration, such as timing/status of the already instituted case, the burden on the patent owner, the instituted grounds, and substantive arguments. We also explained that the ’074 petition would be considered on its merits, including whether the petition is barred under 35 U.S.C. § 315(b), if determined that the motion for joinder should be denied.

In comparing the ’074 petition to the ’525 IPR, we noted that by arguing the one ground instituted in the ’525 IPR in the alternative, Microsoft was essentially asserting 4 grounds. Moreover, the differences between the ’074 petition and the petition in the ’525 IPR, including restructured arguments to emphasize certain points, additional citations, arguments regarding related litigation, and supplemental declaration, could potentially place an additional burden on IPR Licensing.

Thus, we authorized Microsoft to file a paper specifying that if joined with the ’525 IPR, it would only pursue the instituted ground in the ’525 IPR, and to the extent any argument in the ’074 petition differs from arguments and evidence of record filed by the Petitioner in the ’525 IPR, Microsoft would not be relying on such arguments and evidence. IPR

Licensing does not, at this time, oppose such paper. Should joinder be granted, in view of this paper, we confirmed that all filings in the joined proceedings would be made by ZTE, the petitioner in the '525 IPR. While Microsoft could attend an oral hearing, they would not be providing argument. In addition, should ZTE and IPR Licensing settle their dispute, Microsoft could continue as petitioner.

Microsoft agreed to notify the panel, by February 17, 2015, of its intent regarding filing of such paper. The parties agreed to meet and confer, and Microsoft further agreed to provide IPR Licensing a draft of the paper prior to filing. The paper is due by February 20, 2015, and is limited to 2 pages. IPR licensing will notify the Board if it seeks authorization to file an opposition by February 23, 2015.

In consideration of the foregoing, it is hereby:

ORDERED that Microsoft is authorized to file a paper in accordance with this order by February 20, 2015, limited to 2 pages;

FURTHER ORDERED that Microsoft will notify the Board by February 17, 2015 of its intent to file the paper;

FURTHER ORDERED that the parties will meet and confer and Microsoft will provide a draft of the paper to IPR Licensing before filing; and

FURTHER ORDERED that IPR licensing will notify the Board, by February 23, 2015, if it intends to seek authorization to file an opposition.

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