

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

PROXYCONN, INC.,
Patent Owner

Case IPR2012-00026
Case IPR2013-00109
Patent 6,757,717

Before SALLY C. MEDLEY, THOMAS L. GIANNETTI, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A telephone conference call in these joined proceedings was held on August 27, 2015. The participants included John D. Vandenberg, Esq., for the Petitioner, Bryan K. Wheelock, Esq., for the Patent Owner, and Administrative Patent Judges Sally C. Medley, Thomas L. Giannetti, and Mitchell G. Weatherly.

The conference was requested by the Petitioner to discuss procedures following the Federal Circuit's remand of the case to the Board.

DISCUSSION

On February 19, 2014, the Board issued a Final Written Decision in accordance with 37 C.F.R. § 42.73. Paper 73.¹ Both parties appealed the decision to the United States Court of Appeals for the Federal Circuit. On June 16, 2015, the Federal Circuit issued a decision affirming-in-part, reversing-in-part, and vacating-in-part the Board's decision, and remanding the case to the Board. *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292 (Fed. Cir. 2015). The Federal Circuit decided that the Board had erred in its construction of three terms appearing in the claims of subject patent, U.S. Patent No. 6,757,717. As a result, the Federal Circuit vacated the Board's determination that several claims of the '717 patent were unpatentable. The Federal Circuit's mandate issued on August 25, 2015. Paper 76.

The parties were unable to reach agreement on post-remand procedures, and therefore, Petitioner sought the Board's guidance. Petitioner proposed that the Board permit the parties each to file 15-page briefs addressing the effect of the Federal Circuit's claim construction rulings. The briefs would be limited to the eight claims for which the

¹ Citations are to the record in IPR2012-00026; similar papers may be found in the record of IPR2013-00109.

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Board's decision of unpatentability was vacated and to the grounds and references considered in the Board's decision regarding those eight claims. Under this proposal there would be no new evidence presented. Petitioner proposed that the briefs be filed simultaneously, and within a week.

Patent Owner opposed this proposal. Patent Owner expressed the view that additional briefing was unnecessary and would prejudice Patent Owner by delaying the proceedings. Both parties recognized, however, that the Board would have to reconsider the evidence on remand in light of the Federal Circuit's rulings on claim construction and would not be in a position to decide the case for either party without further analysis.

ORDER

Having considered the arguments of the parties, it is hereby

ORDERED that the parties shall each file an additional brief in these proceedings;

FURTHER ORDERED that the briefs shall be limited to fifteen pages and both filed no later than September 11, 2015;

FURTHER ORDERED that the briefs shall address the effect of the Federal Circuit's June 16, 2015, decision on our Final Written Decision, specifically as to the patentability of claims 1, 3, 6, 7, 9, 10, 22, and 23 of the '717 patent;

FURTHER ORDERED that no new prior art references or other evidence shall be presented by either party beyond that considered in the Board's Final Written Decision (including Mattis in combination with DRP);

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FURTHER ORDERED that no replies are authorized at this time.
Should the parties wish to file a reply, they must contact the Board for
authorization.

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