

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IPA TECHNOLOGIES INC.,
Patent Owner.

IPR2019-00810, IPR2019-00811, IPR2019-00814 (Patent 6,851,115 B1)
IPR2019-00835, IPR2019-00836 (Patent 7,069,560 B1)¹

Before LYNNE E. PETTIGREW, MINN CHUNG, and KEVIN C. TROCK,
Administrative Patent Judges.

PETTIGREW, *Administrative Patent Judge.*

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

¹ This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be entered in each case.

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IPR2019-00835, IPR2019-00836 (Patent 7,069,560 B1)

Microsoft Corporation (“Petitioner”) challenged claims of U.S. Patent No. 6,851,115 B1 (IPR2019-00810, Ex. 1001, “the ’115 patent”) in five *inter partes* reviews, including IPR2019-00810, IPR2019-00811, and IPR2019-00814. Petitioner challenged claims of related U.S. Patent No. 7,069,560 B1 (IPR2019-00835, Ex. 1001, “the ’560 patent”) in three *inter partes* reviews, including IPR2019-00835 and IPR2019-00836. We entered Final Written Decisions holding all challenged claims unpatentable, except for claims 8–10, 29–47, 63, and 86–89 of the ’115 patent and claims 10, 11, 28, 50, 51, and 53–55 of the ’560 patent. IPR2019-00810, Paper 44; IPR2019-00811, Paper 44; IPR2019-00812, Paper 44; IPR2019-00813, Paper 44; IPR2019-00814, Paper 44; IPR2019-00835, Paper 42; IPR2019-00836, Paper 42; IPR2019-00837, Paper 42.

Petitioner appealed, and IPA Technologies Inc. (“Patent Owner”) cross-appealed. *See, e.g.*, IPR2019-00810, Papers 45, 46; IPR2019-00835, Papers 43, 44. The U.S. Court of Appeals for the Federal Circuit affirmed all of our determinations challenged on appeal by Patent Owner. *Microsoft Corp. v. IPA Techs. Inc.*, 2022 WL 989403, at *1 (Fed. Cir. Apr. 1, 2022). As to Petitioner’s appeal, the Federal Circuit affirmed our determinations that Petitioner had not shown that claims 29–47 of the ’115 patent and claims 50, 51, and 53–55 of the ’560 patent are unpatentable. *Id.* The court reversed certain determinations regarding claims 8–10, 63, and 86–89 of the ’115 patent and claims 10, 11, and 28 of the ’560 patent and remanded for further proceedings as may be necessary and appropriate. *Id.* at *1, *11.

The claims at issue on remand were challenged in IPR2019-00810 (claims 8–10 of the ’115 patent), IPR2019-00811 (claims 86–89 of the ’115 patent), IPR2019-00814 (claim 63 of the ’115 patent), IPR2019-00835

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(claim 28 of the '560 patent), and IPR2019-00836 (claims 10 and 11 of the '560 patent). This Order addresses the procedure for these cases on remand.

The Board's Standard Operating Procedure 9 provides guidance regarding the procedure for handling cases remanded from the Federal Circuit. *See* PTAB SOP 9 ("Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings"). Under SOP 9, "the panel shall consider procedures proposed by the parties," but "ultimately will decide the procedures to be followed on remand." *Id.* at 5 (App'x 2). SOP 9 further provides that "[t]he panel will consider the scope of the remand, as determined from the reasoning and instructions provided by the Federal Circuit, as well as 'the effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.'" *Id.* at 6 (App'x 2) (quoting 35 U.S.C. §§ 316(b), 326(b)). As to additional briefing, SOP 9 states that "the panel will take into account whether the parties already have had an adequate opportunity to address the issues raised by the remand." *Id.* If additional briefing is allowed it "will normally be limited to the specific issues raised by the remand." *Id.* (citing *Microsoft Corp. v. Proxyconn, Inc.*, Case No. IPR2012-00026 (Paper 77) (PTAB Sept. 1, 2015); *Dell Inc., v. Acceleron, LLC*, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016)).

On July 25, 2022, the parties sent an email to the Board jointly requesting a briefing schedule to address the issues on remand. Ex. 3003. The parties agree that no new evidence will be submitted and that the scope of briefing will be limited to the following three claim groups:

1) claims 8–10 and 63 of the '115 patent and claim 28 of the '560 patent;

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- 2) claims 86–89 of the '115 patent; and
- 3) claims 10 and 11 of the '560 patent.

We agree that additional briefing is warranted in these remand proceedings and authorize briefing according to the following schedule:

Each party is authorized to file a single opening brief, limited to 10 pages, no later than **September 16, 2022**. Each party's brief shall address all issues pertaining to the three claim groups above and shall be filed in each of IPR2019-00810, IPR2019-00811, IPR2019-00814, IPR2019-00835, and IPR2019-00836.

Each party is authorized to file a single responsive brief, limited to 10 pages, no later than **September 30, 2022**. Each party's brief shall be filed in each of IPR2019-00810, IPR2019-00811, IPR2019-00814, IPR2019-00835, and IPR2019-00836.

The briefs may cite to the record in any of the five cases, making clear the proceeding in which any particular paper or exhibit was entered.

It is

ORDERED that each party is authorized to file an opening brief and a responsive brief according to the schedule above; and

FURTHER ORDERED that no issues other than those pertaining to the three identified claim groups shall be briefed, and no new evidence shall be submitted.

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PETITIONER:

Joseph A. Micallef
Scott M. Border
SIDLEY AUSTIN LLP
jmicallef@sidley.com
sborder@sidley.com

PATENT OWNER:

Steven W. Hartsell
Alexander E. Gasser
Sarah E. Spires
SKIERMONT DERBY LLP
shartsell@skiermontderby.com
agasser@skiermontderby.com
sspires@skiermontderby.com