

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION  
Petitioner

v.

PROXYCONN, INC.  
Patent Owner

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Case IPR2012-00026  
Patent 6,757,717

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Before SALLY C. MEDLEY, SCOTT R. BOALICK, and THOMAS L. GIANNETTI, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

**ORDER**

An initial telephone conference call in this matter was held on January 22, 2013. The participants were John D. Vandenberg, Esq. for the Petitioner, Matthew L. Cutler for the Patent Owner, and Administrative Patent Judges Sally C. Medley, Scott R. Boalick, and Thomas L. Giannetti.

The following matters were discussed:

1. Petitioner's Submission Under 37 C.F.R. § 42.64(b)(2)

Petitioner submitted supplemental evidence under this rule in response to Patent Owner's objection to certain evidence as lacking proof of authenticity. Petitioner was advised that this submission was premature and would be expunged. At the proper time Petitioner may file the supplemental evidence in response to a motion by Patent Owner to exclude this evidence.

2. Schedule

If the pending motion for joinder in IPR2013-00109 is granted, the parties will request a two-month extension of the schedule. If there is no joinder, the current schedule is acceptable.

3. Protective Order

The parties are considering the need for a protective order covering certain Microsoft sales information sought by Patent Owner, and they requested two weeks to discuss the matter further before bringing the matter before the Board. The request was granted.

4. Additional Discovery

The parties have not exchanged mandatory disclosures. No compelled testimony or e-discovery requests are foreseen by either party.

#### 5. Motions

Patent Owner will move to amend the claims at the time of filing the patent owner response. Patent Owner is reminded of the provisions of 37 C.F.R. § 42.121, particularly the provision requiring that any amendment propose a reasonable number of substitute claims. As stated in the rule, the presumption is that only one claim would be needed to replace each challenged claim. *See* 37 C.F.R. § 42.121(a)(3). Patent Owner may also seek authorization to file a motion to compel certain Microsoft sales information if the above-mentioned discussions with Petitioner are not successful.

#### 6. Petitioner's Motion for Reconsideration

The parties were advised that the Petitioner's motion for reconsideration of the decision not to institute a trial on certain claims is being taken under advisement by the Board.

#### 7. Settlement

There have been no further settlement discussions.

#### 8. Other Matters

The parties are filing a joint motion to dismiss the parallel district court litigation without prejudice.

The parties request oral argument.

The expert retained by Petitioner may not be available for a deposition in the United States during the scheduled period for discovery. If the joinder

motion is granted and the schedule is extended by two months this will not be an issue.

In consideration of the foregoing, it is, therefore,

**ORDERED** that Petitioner's submission of supplemental evidence (Papers 20-21; Exhibits 1019-1020) is premature, and those papers and exhibits are expunged from the record in this proceeding under 37 C.F.R. § 42.7(a), without prejudice to Petitioner resubmitting such evidence at the proper time in response to a motion to exclude;

**FURTHER ORDERED** that the parties shall have an additional two weeks from the entry date of this Order to confer on the need for a protective order and/or a motion to compel production of certain Microsoft sales information. At the end of that two-week period the parties shall arrange a conference call with the Board to advise the Board on the status of those discussions.

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BY ELECTRONIC TRANSMISSION

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