

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

Cases: IPR2012-00026, IPR2013-00109
Patent No.: 6,757,717 B1
Filed: September 16, 1999
Issued: June 29, 2004
Inventor: Leonid Goldstein
Title: SYSTEMS AND METHODS FOR DATA ACCESS

**PATENT OWNER'S MOTION TO AMEND
UNDER 37 C.F.R. § 42.121**

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This Motion to Amend is submitted in compliance with 37 C.F.R. §42.121. To the extent one or more of Original Claims 1, 3, 6, 10, 11, and 22-23 of U.S. Patent 6,757,717 (“the ‘717 Patent”) are found unpatentable, Proxyconn, Inc. (“Patent Owner”) requests that the Original Claims be cancelled and the corresponding one or more Substitute Claims be entered.

Pursuant to 37 C.F.R. §42.121(a), Patent Owner has conferred with the Board and been granted permission to file this Motion to Amend. DOC No. 33

Additionally, upon confirmation of the patentability of the Original Claims, the Patent Owner requests entry of Substitute Claims 35-42 in addition to the original claims, because such claims are necessary to further define the invention.

I. LISTING OF CLAIMS

Proposed Substitute Claims 35-42 are included herein. Each of the substitute claims presented in this motion is based on an original claim from the ‘717 Patent. Consistent with 37 C.F.R. §42.121(a)(3), the Motion includes only one substitute claim for each claim to be replaced. Pursuant to 37 C.F.R. §42.121(a)(2), the amendments herein do not seek to enlarge the scope of the claims of the ‘717 Patent or to introduce new subject matter.

Appendix A includes the amendments to the claims.¹ Amendments to the

¹ The Proposed Substitute Claims are attached as Appendix A. *Illumina, Inc. v. The Trustees of Columbia University in the City of New York*, IPR2012-00006,

Original Claim are illustrated over the original claim to be replaced, with additions underlined and deletions struck-through or bracketed.

II. SUPPORT FOR THE PROPOSED AMENDMENTS

The Substitute Claims are supported by the original disclosure of the ‘717 Patent, including the exemplary citations included below. The ‘717 Patent claims priority to Israeli Application Ser. No. 126292 filed September 18, 1998 (Ex. 2004), for which parallel citation are provided.

Substitute claim 35 is based on and supported by original Claim 1. The substitute claim 35 adds: said receiver/computer configured to initiate a request data from the sender/computer, disclosed in the ‘717 Patent at, *e.g.*, 7:65-67 and 8:37-39; (Ex. 2004 at 15:3-4, 16:6-8) said sender/computer configured to transmit a digital digest representative of the requested data in response to the request, disclosed in the ‘717 Patent at, *e.g.*, 7:52-67 and Fig. 5; (Ex. 2004 at 14:19-15:4, Fig. 5) and the data includes a range of octets in a file, disclosed in the ‘717 Patent at, *e.g.*, 2:5-8 (Ex. 2004 at 3:1-3).

Substitute claim 36 is supported by original Claims 1 and 3. Substitute claim 36 adds: sender/computer includes means for creating digital digests on data stored in said permanent storage memory, disclosed in the ‘717 Patent at, *e.g.*,

Paper 33 at 5 (“The amendment, which is to be a listing of substitute claims, is to be filed as either an appendix to the motion or as an exhibit so that it will not count towards the page limits set for the motions to amend.”).

7:29-32 and Fig. 4; (Ex. 2004 at 13:26-14:2 and Fig. 4) the receiver/computer includes means for storing said digital digest created by the sender/computer in its permanent storage memory, disclosed in the '717 Patent at, *e.g.*, 3:37-39; (Ex. 2004 at 6:4-6) and the data includes at least a range of octets in a file, disclosed in the '717 Patent at, *e.g.*, 2:5-8; (Ex. 2004 at 3:1-3).

Substitute claim 37 is supported by Original Claim 6. Substitute claim 37 adds: a digital digest received from one of the at least two other computers through the packet-switched network, disclosed in the '717 Patent at, *e.g.*, 9:12-31, Fig. 12; (Ex. 2004 at 17:12-18:2, Fig. 12) and the data includes a plurality of octet ranges in a file or files, disclosed in the '717 Patent at, *e.g.*, 2:5-9; (Ex. 2004 at 3:1-3).

Substitute claim 38 is supported by claim 10. Substitute claim adds: said receiver/computer configured to search for said digital digest received from the sender/computer, in response to receiving the digital digest, disclosed in the '717 Patent at, *e.g.*, 7:52-67 and Figs. 5 and 7; (Ex. 2004 at 14:19-15:4 and Figs. 5 and 7) and the data includes at least a range of octets in a file, disclosed in the '717 Patent at, *e.g.*, 2:5-9; (Ex. 2004 at 3:1-3).

Substitute claim 39 is supported by claim 11. Substitute claim 11 adds: receiving a request for said data from the receiver/computer, disclosed in the '717 Patent at, *e.g.*, 7:65-67 and 8:37-39; (Ex. 2004 at 15:3-4, 16:6-8) and in response to

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