

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

Patent of **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
Docket No.: 16502-400002

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

Substitute Claims 35-41 conform to the rules of 37 C.F.R. §41.121 and are patentable over the grounds of review being considered. Microsoft's Opposition admits to the patentability of the substitute claims, attempts to improperly inject a new ground of review, and presents argument unsupported by law.

Notwithstanding Microsoft's Opposition, Proxyconn's Motion to Amend should be granted, or in the alternative, Proxyconn should be permitted to re-file.

1. No Ground of Review for Claims 35, 36, 38, 40, and 41 is based on DRP

Substitute claims 35, 36, 38, 40, and 41 are amended versions of challenged claims 1, 3, 10, 22, and 23, respectively. Four different grounds of review have been granted for these challenged claims. In its Opposition, Microsoft only argues that the substitute claims are anticipated by Yohe (IPR2012-00026, EX1005). In doing so, Microsoft admits substitute claims 35, 36, 38, 40, and 41 are patentable over Perlman (IPR2012-00026, EX1003), Santos (IPR2012-00026, EX1004), and the combination of Perlman and Yohe. Proxyconn agrees.

Microsoft further chides Proxyconn for not distinguishing substitute claims 35, 36, 38, 40, or 41 over DRP (IPR2013-00109, EX1003). However, the substitute claims are based on claims 1, 3, 10, 22, and 23, respectively, and these challenged claims are NOT subject to any ground of review based on DRP. By its arguments, Microsoft attempts to inject a new ground of review into the proceeding. Microsoft's effort to do so is improper.

37 C.F.R. 41.121 states a Motion to Amend may be denied if it “does not respond to a ground of unpatentability involved in the trial.” The only ground involved in the trial and based on DRP is “Anticipation by DRP: claims 6, 7, 9, 11, 12, and 14.” *See* IPR2013-00109, Paper 14. Prior to Microsoft’s Opposition, there had been no argument that claims 1, 3, 10, 22, and 23 are anticipated by DRP. Indeed, there are no claims charts, expert testimony, or other materials submitted by Microsoft to advance such an argument. A ground of review based anticipation of claims 1, 3, 10, 22, and 23 by DRP is not in this proceeding. Proxyconn’s *narrowing* Motion cannot be an instrument for Microsoft to inject this new ground of review. Microsoft’s arguments regarding DRP and substitute claims 35, 36, 38, 40, or 41 should be rejected.

2. Dr. Konchitsky is Not an Agent of Proxyconn.

Microsoft argues in its Opposition that Proxyconn’s expert is an agent of Proxyconn, and that his testimony, which was beyond the scope of his declaration and objected to by counsel for Proxyconn, constitute admissions of Proxyconn. Microsoft’s position is unsupported by law. *See Kirk v. Raymark Indus., Inc.*, 61 F.3d 147 (3d Cir. 1995). Proxyconn has retained and paid Dr. Konchitsky for his testimony. Dr. Konchitsky, however, has not submitted to the control of Proxyconn with respect to the content of his testimony. Dr. Konchitsky has formed and testified to his own opinions. As such, Dr. Konchitsky is not an agent

of Proxyconn, and not empowered to make admissions on behalf of Proxyconn – especially about subjects beyond the scope of his original declaration.

Without relying on Dr. Konchitsky's statement as admissions, Microsoft's arguments are merely summaries of the art already addressed in Proxyconn's Motion and IPR Response. *See* IPR2012-00026, Papers 44 and 45. Microsoft has failed to submit or incorporate any argument from its expert, Dr. Long, regarding patentability of the substitute claims. The substitute claims are patentable, and Microsoft's arguments to the contrary are unsupported.

3. The Form and Content of the Motion to Amend

Microsoft argues Proxyconn's Motion is over-length and contains insufficient substance, citing to *Idle Free Systems Inc. v. Bergstrom, Inc.* IPR2012-00027, Paper 26 (USPTO PTAB June 11, 2012). Initially, an inadvertent error caused the content of the Motion to extend a few lines onto the 16th page. Proxyconn requests permission to re-file and conform the Motion to the 15-page limit promulgated in 37 C.F.R. §42.24.

Further, the *Idle Free* decision had not yet been rendered when Proxyconn filed its Motion. Consequently, when the Motion was filed, Proxyconn was unaware of that decision or the expectations for certain types of expert support explained therein. Accordingly, to the extent not already consistent with the *Idle Free* decision, Proxyconn respectfully requests permission to re-file its Motion.

4. Consistent with 37 C.F.R. §42.121(a)(2)(ii), the Substitute Claims do not add New Matter or Enlarge the Scope of Any Challenged Claim.

Amendments in the substitute claims are supported at the citations to the '717 patent provided in the Motion to Amend. In opposing Proxyconn's Motion, Microsoft creates a requirement that the original specification include verbatim support for any amendment. For example, with respect to substitute claim 35, Microsoft admits the '717 patent discloses "beginning a transaction with the receiver sending 'a request to the sender/computer,'" yet argues this disclosure is insufficient to support "receiver/computer configured to initiate a request for data" as recited in substitute claim 35. Microsoft's Opposition to Proxyconn's Corrected Motion to Amend, Paper 48 at p. 2. There is no requirement to have verbatim support, and Microsoft's attempt to argue such a requirement is unsupported by law. Microsoft levels similar baseless arguments against substitute claims 37-41. Each of the substitute claims is supported by the original '717 patent, and Microsoft's arguments should be rejected.

Additionally, Proxyconn has not sought to enlarge the scope of any claim, when properly interpreted in view of the '717 patent. For example, with respect to substitute claim 40, Proxyconn amends the claim to recite searching specifically for "each received digital digest," which is narrower than merely searching generally for data by the digital digest, as is recited by claim 22 (from which it is based). Substitute claim 40 is narrower in all respects as compared to original

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