

Filed on behalf of Microsoft Corporation

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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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Patent 6,757,717 B1

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**MOTION FOR JOINDER TO RELATED  
INSTITUTED INTER PARTES REVIEW (37 C.F.R. § 42.122(b))**

Petitioner Microsoft Corporation files this Motion for Joinder of the Petition For Inter Partes Review Of Claims 6, 7, 9, 11, 12 And 14 Of U.S. Patent No. 6,757,717 (“Second Petition”), with the instituted inter partes review, *Microsoft Corporation v. Proxyconn, Inc.*, Case No. IPR2012-00026 (TLG) (“IPR2012-00026”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

No fee is required for consideration of this Motion. Petitioner has paid the fee for the IPR2012-00026 and will be paying the fee for the Second Petition for inter partes review. Should this be incorrect, the Patent Office is authorized to charge Deposit Account 02-4550 the necessary fee.

**I. APPLICABLE RULES**

37 C.F.R. § 42.122(b) states:

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any inter partes review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

**II. RELIEF REQUESTED**

In this Motion, Petitioner Microsoft requests that the Second Petition be joined with IPR2012-00026.

### III. STATEMENT OF MATERIAL FACTS

1. On November 4, 2011, Proxyconn, Inc. filed a suit against Microsoft and three Microsoft customers (Dell, HP and Acer), *Proxyconn Inc. v. Microsoft Corporation, et al.*, Case No. SA CV11-1681 DOC (JPRx) [consolidated with Case Nos. SA CV11-1682 DOC (JPRx), SA CV11-1683 DOC (JPRx), and SA CV11-1684 DOC (JPRx)], pending in the U.S. District Court for the Central District of California (the “’717 Concurrent Litigation”).

2. On September 18, 2012, Microsoft filed a Petition for Inter Partes Review requesting review of claims 1, 3, 10-12, 14 and 22-24 of U.S. Patent No. 6,757,717, now styled, *Microsoft Corporation v. Proxyconn, Inc.*, Case No. IPR2012-00026 (TLG). That set of challenged claims constituted the entire set of claims in this patent that Proxyconn had by then asserted, at some point, in the ’717 Concurrent Litigation.

3. On October 9, 2012, Proxyconn informed Microsoft that, in addition to the claims already identified, it intended to assert claims 6 and 9.

4. On November 2, 2012, Proxyconn and Microsoft entered into a stipulation to stay the ’717 Concurrent Litigation unless the Board declines to institute an inter partes review or unless the Board agrees to institute an inter partes review on less than all challenged claims and Proxyconn selects to terminate the stipulation. (Ex. 1012). The stipulation included an agreement by Proxyconn and

Microsoft that Microsoft shall file a second inter partes review challenging at least claims 6 and 9 within three weeks of the Board instituting an inter partes review based on the September 18, 2012 petition.

5. On December 21, 2013, the Board instituted trial on claims 1, 3, 10, and 22-24 (“IPR2012-00026 Decision”).

6. On January 3, 2013, Proxyconn served supplemental infringement contentions on Microsoft asserting additional claims 6, 7, and 9.

7. On January 4, 2013, Microsoft filed a Motion for Rehearing of the Decision On Request For Inter Partes Review in IPR2012-00026, arguing in part that the trial should include claims 11, 12, and 14.

8. Concurrently with this Motion, Microsoft is filing its Second Petition, challenging claims 6, 7, and 9, and also again challenging claims 11, 12, and 14 but on new grounds.

9. Submitted with the Second Petition is Exhibit 1012, a true and correct copy of the Joint Stipulation Requesting Stay of Case Pending Inter Partes Review, filed on November 2, 2012 in the ’717 Concurrent Litigation (Dkt. No. 90).

#### **IV. ARGUMENT**

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second inter partes review petition to an instituted inter partes review proceeding.

This request for joinder is timely and the time periods set forth in 37 C.F.R. §

42.101(b) do not apply to the Second Petition because it is accompanied by this request for joinder. 37 C.F.R. § 42.122(b).

The Second Petition involves the same parties—Proxyconn and Microsoft—and the same patent. Both parties agree to this requested joinder. (Ex. 1012). Thus, the patent owner is not prejudiced by joinder of the Second Petition with IPR2012-00026.

The Second Petition challenges six claims. Three of the challenged claims (claims 6, 7, and 9) were asserted in the litigation only after the first petition was filed. Petitioner has not unduly delayed seeking inter partes review of these newly asserted claims.

The other three claims (claims 11, 12, and 14) were part of IPR2012-00026 and Microsoft has filed a motion for rehearing of the decision to exclude those three claims from the trial. Microsoft also has included claims 11, 12, and 14 in the Second Petition, arguing different grounds for invalidating the claims, in part based on the Board's claim interpretation in its IPR2012-00026 Decision.

Joinder will not unduly delay the IPR2012-00026. The patent owner has stipulated to not file a response to this Second Petition.

Therefore, the Second Petition is related to IPR2012-00026, and joining the Second Petition with IPR2012-00026 would not prejudice or alarm Proxyconn. Microsoft requests joinder of the Second Petition with IPR2012-00026.

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