

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION
Petitioner

v.

MACROSOLVE, INC.
Patent Owner

Case IPR2014-00140

Patent 7,822,816

NOTICE OF PROPOSED MOTIONS

BY PATENT OWNER

PATENT OWNER'S NOTICE OF PROPOSED MOTIONS

Pursuant to the Office Trial Practice Guide, Patent Owner, Macrosolve, Inc. provides its notice regarding anticipated motions. The initial conference call in this matter is scheduled for June 19, 2014. At present the Patent Owner contemplates at least the following motions:

1. The patent involved in this proceeding, U.S. Patent No. 7,822,816, was recently the subject of Ex Parte Reexamination Certificate No. 10187, issued June 10, 2014, which canceled all claims. It is contemplated that the Reexamination Certificate represents the final disposition of the Ex-Parte '816 patent reexamination. Patent Owner accordingly requests permission to file a motion to terminate this IPR pursuant to 37 C.F.R. § 42.72 because the claims of the '816 Patent have already been canceled and the present Inter Partes review is moot. However, Patent Owner points out that a continuation application is still pending before the United States Patent & Trademark Office.

2. Motion for Discovery Regarding the Membership of Requestor RPX and the Real Party or Parties-in-Interest of Requestor. As detailed in Patent Owner's Preliminary Response, at the time of filing of the present Inter Partes Review (IPR), the '816 patent was being enforced in the United States District Court for the Eastern District of Texas. The '816 patent had been in litigation with numerous Defendants for over one year prior to the filing of the Request for Inter Partes Review. RPX boasts a membership network of 168 client companies of these less than half are publicly identified by RPX. Patent Owner respectfully requests discovery as to all the members of Petitioner RPX in order to determine the real party-in-interest in the present IPR.

3. Motion to Dismiss for Lack of Standing Subject Matter Jurisdiction. It is anticipated that discovery of the members of Petitioner RPX will reveal a real party or parties-in-interest who would be precluded by statute from filing the present Request for Inter Partes

Review pursuant to U.S.C. § 315(b) and 37 C.F.R. § 42.101(b). Subject to the determination of the real party or parties-in-interest, Patent Owner requests permission to file a Motion to Dismiss for Lack of Standing or Alternatively Lack of Subject Matter Jurisdiction.

4. Motion to Take the Deposition of A.L. Navasimha Reddy. Petitioner submitted the Declaration of Dr. Reddy in support of its Petition for Inter Partes Review. Patent Owner requests permission to take the deposition of Dr. Reddy.

Patent Owner does not presently intend to file any other motions but nevertheless reserves the right to file a motion to exclude evidence or a motion for observation on the dates set forth in the scheduling order for this case, as well as to request permission to file any other motions that become necessary as the case develops (e.g., additional motions for discovery).

Respectfully submitted,

June 17, 2014

/terry l. watt/

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#34061-v

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.205, that service was made on the PETITIONER as follows:

Manner of Service: U.S. Mail

Documents served: PATENT OWNER'S NOTICE OF PROPOSED MOTIONS

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