

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.

Case IPR2017-00606
Patent 8,694,657 B1

Before KARL D. EASTHOM, DAVID C. MCKONE, and J. JOHN LEE,
Administrative Patent Judges.

MCKONE, *Administrative Patent Judge.*

ORDER
Authorizing Reply to Patent Owner Preliminary Response
37 C.F.R. § 42.108(c)

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On March 21, 2017, we held a teleconference to discuss Microsoft Corp.'s ("Petitioner") email request for authorization to file a reply to Windy City Innovations LLC's ("Patent Owner") Preliminary Response (Paper 8). Petitioner seeks to join this proceeding to *Microsoft Corporation v. Windy City Innovations LLC*, Case No. IPR2016-01155, which involves the same patent. Paper 3. In the Preliminary Response, Patent Owner compares the claims in this proceeding to those from a related patent in a related proceeding, *Microsoft Corporation v. Windy City Innovations LLC*, Case No. IPR2016-01137 ("the 1137 Proceeding"). Paper 8, 5–7. In particular, Patent Owner contends that, in the 1137 Proceeding, we determined Petitioner's showing to be lacking with respect to reading certain limitations of the claims at issue in that proceeding onto the prior art, and that those same claim limitations are present in the claims of the instant proceeding. *Id.*

Petitioner seeks permission to file a 3-page reply responding to Patent Owner's contention that the claims at issue in this proceeding contain the same limitation(s) Petitioner failed to show in the prior art asserted against the claims at issue in the 1137 Proceeding. As we explained on the teleconference, on the facts of this case, we are not persuaded that it is reasonable to expect Petitioner to have anticipated Patent Owner's comparison of the claims at issue in this proceeding to those from a different patent in a different, albeit related, proceeding. *Cf. In re NuVasive, Inc.*, 841 F.3d 966, 968 (Fed. Cir. 2016). Thus, we find that Petitioner has shown good cause for seeking a reply.

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ORDER

It is

ORDERED that Petitioner is authorized to file a 3-page reply to Patent Owner's Preliminary Response;

FURTHER ORDERED that the reply is limited to responding to Patent Owner's argument that the claims at issue in this proceeding include a limitation(s) that Petitioner, in the 1137 Proceeding, failed to establish in the prior art; and

FURTHER ORDERED that the reply is due by March 29, 2017.

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