

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

SAINT REGIS MOHAWK TRIBE,
Patent Owner.

Case IPR2018-01594 (Patent 6,434,687 B1)
Case IPR2018-01599 (Patent 6,076,152)
Case IPR2018-01600 (Patent 6,247,110 B1)
Case IPR2018-01601, IPR2018-01602, and IPR2018-01603
(Patent 7,225,324 B2)
Case IPR2018-01604 (Patent 7,421,524 B2)
Case IPR2018-01605, IPR2018-01606, and IPR2018-01607
(Patent 7,620,800 B2)¹

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This Order addresses an issue pertaining to all ten cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2018-01594 (Patent 6,434,687 B1)
IPR2018-01599 (Patent 6,076,152)
IPR2018-01600 (Patent 6,247,110 B1)
IPR2018-01601, IPR2018-01602, IPR2018-01603 (Patent 7,225,324 B2)
IPR2018-01604 (Patent 7,421,524 B2)
IPR2018-01605, IPR2018-01606, IPR2018-01607 (Patent 7,620,800 B2)

On February 15, 2019, a conference call was held between the Board, Microsoft Corporation (“Petitioner”), and Saint Regis Mohawk Tribe (“Patent Owner”). Petitioner requested the conference call to request authorization to file a reply addressing three issues raised in Patent Owner’s Preliminary Responses: (1) Patent Owner’s arguments that the Board should deny institution under 35 U.S.C. § 314(a) because SRC Labs, LLC (“SRC”) is a sole-source supplier for a U.S. Army program; (2) Patent Owner’s argument that the Board should deny institution under 35 U.S.C. § 314(a) because Petitioner asserts the same prior art in these proceedings and the parallel district court case; and (3) Patent Owner’s proposed constructions and application of the claim terms “systolic” and “systolically” for IPR2018-01601, -01602, and -01603, and “internet site” for IPR2018-01594. Petitioner argued that it was unable to foresee these issues as being raised by Patent Owner, and, therefore, should be afforded an opportunity to address these issues. Patent Owner opposed, arguing that Petitioner was aware of the facts underlying these issues prior to filing the Petitions.

Upon further consideration, we are persuaded that Petitioner has established good cause to file a reply only with respect to the first issue listed above. *See* 37 C.F.R. § 42.108(c). We authorize Petitioner to file a reply to Patent Owner’s Preliminary Response, limited to addressing Patent Owner’s arguments that we should exercise our discretion under 35 U.S.C. § 314(a) based on the activities and status of SRC. *See, e.g.*, IPR2018-

IPR2018-01594 (Patent 6,434,687 B1)
IPR2018-01599 (Patent 6,076,152)
IPR2018-01600 (Patent 6,247,110 B1)
IPR2018-01601, IPR2018-01602, IPR2018-01603 (Patent 7,225,324 B2)
IPR2018-01604 (Patent 7,421,524 B2)
IPR2018-01605, IPR2018-01606, IPR2018-01607 (Patent 7,620,800 B2)

01594, Paper 15, 2–9. Petitioner must file the same reply² in each of the proceedings, and the reply is limited to 5 pages. Petitioner’s reply is due no later than February 28, 2019. Patent Owner may also file a sur-reply to Petitioner’s reply, limited to the same issue, which must be the same in each of the proceedings, and may not exceed 5 pages. Patent Owner’s sur-reply is due no later than March 7, 2019. We have determined that all other issues raised by Petitioner have been sufficiently briefed on the record.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a reply to Patent Owner’s Preliminary Response, limited to the issue raised by Patent Owner of a discretionary denial of institution of *inter partes* review under 35 U.S.C. § 314(a) based on the activities and status of SRC, of no more than 5 pages, due on February 28, 2019, and the same reply must be filed in each of the proceedings listed above; and

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply responsive to arguments raised by Petitioner in its authorized reply, of no more than 5 pages, due on March 7, 2019, and the same sur-reply must be filed in each of the proceedings listed above.

² The case heading may differ, because we have not authorized use of a single heading for all ten cases.

IPR2018-01594 (Patent 6,434,687 B1)
IPR2018-01599 (Patent 6,076,152)
IPR2018-01600 (Patent 6,247,110 B1)
IPR2018-01601, IPR2018-01602, IPR2018-01603 (Patent 7,225,324 B2)
IPR2018-01604 (Patent 7,421,524 B2)
IPR2018-01605, IPR2018-01606, IPR2018-01607 (Patent 7,620,800 B2)

PETITIONER:

Joseph A. Micallef
Jason P. Greenhut
SIDLEY AUSTIN LLP
jmicallef@sidley.com
jgreenhut@sidley.com
sidleysrclabsipr@sidley.com

PATENT OWNER:

Alfonso Chan
Joseph DePumpo
SHORE CHAN DEPUMPO LLP
achan@shorechan.com
jdepumpo@shorechan.com