

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

THROUGHPUTER, INC.,
Patent Owner.

IPR2023-00852
Patent 11,150,948 B1

Before MICHAEL R. ZECHER, JOHN A. HUDALLA, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Denying Petitioner's Request for Authorization to File a Reply to
Patent Owner's Preliminary Response
37 C.F.R. §§ 42.5(a), 42.108(c)

BACKGROUND

Microsoft Corporation (“Petitioner”) filed a Petition requesting institution of an *inter partes* review of claims 1–15 of U.S. Patent No. 11,150,948 B1 (Ex. 1001, “the ’948 Patent”). Paper 2 (“Pet.”). The ’948 patent claims priority to several patent applications and provisional applications, the earliest having a filing date of November 4, 2011. Ex. 1001, code (60). Petitioner challenges claims 1–15 of the ’948 patent as being unpatentable as obvious over the combination of Nollett (Ex. 1004), Tuan (Ex. 1005), and Seo (Ex. 1006). Pet. 16–68. Relevant to the discussion here, Petitioner asserts that Tuan—a doctoral dissertation—is prior art under pre-AIA 35 U.S.C. § 102(b) and was publicly available as of October 2009. *Id.* at 2 & n.1 (citing Ex. 1012 ¶¶ 8; Ex. 1015 ¶¶ 7–9).

ThroughPuter, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 11 (“Prelim. Resp.”)) contending, among other arguments, that “Petitioner has not established that Tuan is prior art” because “Petitioner . . . fails to demonstrate public accessibility” of Tuan before the critical date of the ’948 patent. Prelim. Resp. 2–15.

On September 26, 2023, Petitioner sent an email seeking a conference call with the Board to request authorization to file a reply to the Preliminary Response. Ex. 3001. In particular, Petitioner seeks to address Patent Owner’s arguments regarding Tuan’s public accessibility and to submit the following additional evidence:

(1) Reproduced pages from Internet Archive’s Wayback Machine demonstrating the searching capabilities of Keio University’s Libraries on or before the Critical Date of the ’948 Patent

(2) A brief declaration from Ms. June Munford explaining the relevance of the above Wayback Machine pages

to public accessibility and the ability of POSITAs [persons of ordinary skill in the art] to locate Tuan on or before the Critical Date of the '948 Patent; and

(3) A brief declaration from Dr. Henry Houh related to how the title of Tuan was sufficiently descriptive to permit a POSITA to find Tuan through reasonable diligence.

Id.

On October 2, 2023, Judges Zecher, Hudalla, and Meyers held a conference call with counsel for the parties. Petitioner presented arguments in support of its request for authorization to file a reply. Patent Owner opposed Petitioner's request. A court reporter was on the line, and a copy of the transcript will be filed as an exhibit in this proceeding in due course.¹ For the reasons below, we *deny* Petitioner's request for authorization to file a reply to the Preliminary Response.

DISCUSSION

Our rules do not automatically authorize a petitioner to file a reply to a patent owner preliminary response; instead, a petitioner seeking to file a reply prior to institution must make a showing of good cause. *See* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”). In addition, preliminary reply briefs “may only respond to arguments raised in the corresponding . . . patent owner preliminary response.” 37 C.F.R. § 42.23(b). The word “respond” in the context of 37 C.F.R. § 42.23(b) “does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing.”

¹ This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”) at 74 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

On the conference call, Petitioner stated several reasons that allegedly support its showing of good cause. First, Petitioner asserted that Board precedent set forth in *Hulu LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 8–21 (PTAB Dec. 20, 2019) (precedential) endorses developing the record on a reference’s public accessibility. Second, Petitioner asserted that Patent Owner’s argument regarding Tuan’s public accessibility is based on the Board’s decision denying institution (DDI) in IPR2022-01566 (“the ’1566 IPR”),² which, according to Petitioner, developed and clarified the legal precedent set in *Hulu* for showing that a reference was publicly accessible. In particular, Petitioner noted that the ’1566 IPR DDI had not yet been issued when the Petition in this case was filed. Lastly, Petitioner asserted that granting its request would not pose an undue burden on the Board, and that Patent Owner would have an opportunity to file a responsive brief.

Patent Owner responded that Petitioner’s intended reply arguments and evidence about Tuan’s public accessibility should have been included in the Petition, but the Petition merely included a single footnote—with citations to testimony that does not address public accessibility—in support of Petitioner’s assertion that Tuan qualifies as prior art to the ’948 patent.

² Patent Owner filed a copy of the Decision Denying Institution (the “’1566 IPR DDI”) from the ’1566 IPR as Exhibit 2002. The ’1566 IPR involved the same parties as here and also addressed whether the Tuan reference qualifies as prior art and was publicly accessible before the critical date of the involved patent. *See* Ex. 2002, 7–16.

See Pet. 2 & n.1 (citing Ex. 1012 ¶¶ 8; Ex. 1015 ¶¶ 7–9). Patent Owner also stated that Petitioner was on notice of the very same arguments that Patent Owner puts forth here because they were included in Patent Owner’s Preliminary Response from the ’1566 IPR (“the ’1566 POPR”),³ which was filed a month before the Petition in this proceeding. Indeed, Patent Owner noted that Petitioner appears to have responded to certain arguments from the ’1566 POPR by filing and citing a second declaration of librarian June Ann Munford (Ex. 1015) with the instant Petition.⁴ Patent Owner additionally argued that the Board’s ’1566 IPR DDI did not change Board precedent on public accessibility in the wake of *Hulu*. Patent Owner also noted that Petitioner did not seek rehearing of the ’1566 IPR DDI. Therefore, in Patent Owner’s view, Petitioner should not be allowed an opportunity to supplement the instant record.

Having considered the respective positions of the parties, we determine that Petitioner has not shown good cause for us to authorize a reply to the Preliminary Response. Nor has Petitioner shown good cause to file a second declaration of its technical expert (Dr. Houh), a third declaration of Ms. Munford, and additional evidence from the Wayback Machine. We set forth our reasoning below.

³ Patent Owner filed a copy of the ’1566 IPR POPR as Exhibit 2007.

⁴ The signature page for this declaration lists a date of “4/14/2022,” but the context makes clear that it should have been dated April 14, 2023, given that the declaration includes web printouts dated March 18, 2023. *See* Ex. 1015, 11–12; *see also* Prelim. Resp. 9 n.5 (noting date discrepancy). Thus, the second Munford declaration was signed after the filing date of the ’1566 POPR (i.e., March 9, 2023) and contemporaneous with the filing date of the instant Petition (i.e., April 17, 2023).

First, we note that the Petition is devoid of any substantive explanation as to how Tuan qualifies as prior art to the '948 patent. Instead, Petitioner merely asserts a date and includes a footnote with citations to Ms. Munford's two existing declarations.⁵ *See* Pet. 2 & n.1 (citing Ex. 1012 ¶ 8; Ex. 1015 ¶¶ 7–9). As such, Petitioner's intended reply brief and evidence would, in essence, set forth from scratch Petitioner's contentions for qualifying Tuan as prior art—particularly with regard to public accessibility and searchability at the time of the '948 patent. We find this situation to be more aligned with a wholly new approach by Petitioner than with merely “respond[ing]” to Patent Owner's arguments by elaborating on existing arguments and evidence. *See* 37 C.F.R. § 42.23(b); CTPG at 74; *see also Hulu*, Paper 29 at 15 (“The opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition.”). A new approach to proving the prior art status of Tuan is not apt in the context of a reply to a preliminary response. *See* 37 C.F.R. § 42.23(b); CTPG at 74.

⁵ To the extent Petitioner has made *any* case for qualifying Tuan as prior art to the '948 patent based on the present record, it appears in the two declarations of Ms. Munford. *See* Ex. 1012 ¶¶ 9–11; Ex. 1015 ¶ 9. But 37 C.F.R. § 42.6(a)(3) prohibits the incorporation of arguments arising from Ms. Munford's declarations into the Petition by reference. Rule 42.6(a)(3) is meant to “eliminate abuses that arise from incorporation” so that we need not “play archaeologist with the record.” *Cisco Sys., Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 at 10 (PTAB Aug. 29, 2014) (informative) (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999)) (citing Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,617 (Aug. 14, 2012)).

Second, at the time the Petition was filed, Petitioner was already on notice of the arguments Patent Owner would make here against Tuan. Specifically, Patent Owner had filed the '1566 IPR POPR one month before the instant Petition was filed, and Patent Owner made substantially the same arguments in the '1566 IPR POPR that it makes in this case. *Compare* Ex. 2007, 14–20, *with* Prelim. Resp. 2–15. Importantly, Petitioner seems to have partially responded to the arguments in the '1566 IPR POPR by filing and citing the second declaration of Ms. Munford at Exhibit 1015, which was not of record in the '1566 IPR.⁶ Although Petitioner emphasized that the '1566 IPR DDI focused on issues other than those addressed in Ms. Munford's second declaration, that fact does change Petitioner's prior notice of the very same arguments Patent Owner is making here.⁷ As such, Petitioner's foreknowledge of Patent Owner's arguments undermines Petitioner's attempt to show good cause.

Third, contrary to Petitioner's arguments, we do not view *Hulu* as endorsing automatic replies to preliminary responses in order to supplement the record on public accessibility for printed publications. Although *Hulu* certainly discusses the possibility of submitting additional evidence with a reply to a patent owner preliminary response, it also states that this opportunity is still subject to the requirement that "the petitioner must

⁶ Despite filing a second declaration of Ms. Munford with its Petition, Petitioner did not detail any contentions in the text of the Petition that attempted to qualify Tuan as prior art to the '948 patent, as we have discussed above.

⁷ Petitioner appears to have made a conscious choice to only address a subset of the arguments from the '1566 IPR POPR in Ms. Munford's second declaration. *See* Ex. 1015.

submit evidence sufficient to meet the reasonable likelihood standard” with the Petition. *Hulu*, Paper 29 at 13–14. Thus, Petitioner was required to include sufficient evidence for qualifying Tuan as prior art to the ’948 patent with the Petition, regardless of Patent Owner’s arguments in the Preliminary Response.⁸ This calls into question Petitioner’s need to file such a wide range of declarations and evidence with a reply—including a second declaration of Dr. Houh and a third declaration of Ms. Munford. In addition, *Hulu* mentions the good cause standard associated with 37 C.F.R. § 42.108(c) for a petitioner seeking leave to file a reply to the preliminary response. *See Hulu*, Paper 29 at 7. *Hulu* did not abrogate this standard. And, as discussed elsewhere herein, we do not find that Petitioner has demonstrated good cause.

Fourth, we do not agree with Petitioner’s characterization of the ’1566 IPR DDI as representing new guidance from the Board on public accessibility in the wake of *Hulu*. Rather, the ’1566 IPR DDI merely applied existing law on public accessibility in light of *Hulu*. Specifically, the panel in the ’1566 IPR based its decision squarely on *Hulu*’s holding that the Petition must “identify, *with particularity*, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date.” Ex. 2002, 15 (quoting *Hulu*, Paper 29 at 13 (emphasis added)); *see also id.* at 10, 16 (citing same). As such, we do not agree with Petitioner that the ’1566 IPR DDI advanced or clarified the law on qualifying printed publications as prior art. In fact, Petitioner neither sought panel rehearing of the ’1566 IPR DDI, nor requested review by the

⁸ We need not and do not determine whether Petitioner’s evidence is sufficient for institution at this juncture.

Precedential Opinion Panel (an option still available to Petitioner when the '1566 IPR DDI was entered), which suggests that Petitioner viewed the '1566 IPR DDI as manifesting a conventional analysis based on applicable law and precedent. We further note that the '1566 IPR DDI has not been designated as a precedential or informative decision of the Board. Thus, given the conventional nature of the disposition in the '1566 IPR DDI, we do not find good cause for extra briefing to address the holding in the '1566 IPR DDI.

For the foregoing reasons, Petitioner has not demonstrated good cause to file a reply with additional evidence to address Patent Owner's public accessibility arguments in the Preliminary Response. Accordingly, we deny Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response.

ORDER

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response is *denied*.

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