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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

IPR2024-00305 (Patent 8,737,933 B2)[1]
IPR2024-00306 (Patent 9,173,054 B2)
IPR2024-00537 (Patent 8,737,933 B2)
IPR2024-00538 (Patent 9,173,054 B2)

Before JAMESON LEE, JOHN F. HORVATH, and LISA A. MURRAY, *Administrative Patent Judges*.

PER CURIAM.

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

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[1] This Order addresses issues common to the listed proceedings. The combined caption is for administrative convenience only and does not indicate that the above-listed proceedings have been joined. The parties are not authorized to use this caption without express permission of the Board.

I. INTRODUCTION

On August 22, 2024, in response to a joint email from Petitioner and Patent Owner dated August 2, 2024 (Ex. 3001), Judges Lee, Horvath, and Murray conducted a conference call with counsel for the parties to discuss schedule adjustments that the parties contend would align IPR2024-00537 ("the '537 IPR) and IPR2024-00538 ("the '538 IPR") with earlier-instituted IPR2024-00305 ("the '305 IPR") and IPR2024-00306 ("the '306 IPR").

During the conference call, the parties presented their respective case-consolidation and schedule-changing positions with the panel. For the reasons discussed below, either party is authorized, or the parties are jointly authorized, to file motions for consolidation of proceedings and/or to extend the maximum one-year pendency in the '305 and '306 IPRs.

II. DISCUSSION

During the conference call, Petitioner indicated that the parties seek to align the schedules in the above-listed proceedings so that final written decisions for each patent can issue on the same day. To achieve that goal, Petitioner seeks authorization to file a motion to consolidate the '305 and '537 IPRs and to terminate the '305 IPR, as well as a motion to consolidate the '306 and '538 IPRs and to terminate the '306 IPR. Alternatively, Petitioner seeks authorization to file motions to extend the maximum one-year pendency of the '305 and '306 IPRs. *See* 35 U.S.C. § 316 (a)(11); 37 C.F.R. §42.100(c).

Despite the joint email to the panel seeking consolidation of the '305 and '537 IPRs and the '306 and '538 IPRs, Patent Owner expressed a different understanding of the relief sought by the parties. Namely, Patent

Owner suggested the parties seek to consolidate the ’305 and ’306 IPRs as well as the ’537 and ’538 IPRs. In response, Petitioner explained that these consolidations were not necessary because they would not accomplish the goal of extending the maximum one-year pendency of the ’305 and ’306 IPRs.

Having heard the parties’ positions, we informed the parties that any motion to consolidate any combination of the IPRs under discussion is unlikely to succeed, given the different patents challenged, the differences in issues presented, and the filing time differences between the different IPRs. A motion to extend the maximum one-year pendency of the earlier-filed IPRs would face fewer challenges, although good cause must be shown for such a motion to succeed.

The parties were then instructed that authorization to file motions for consolidation or to extend the maximum one-year pendency of the earlier-filed IPRs would be granted in an order. We hereby authorize either party to file (jointly or separately) one or more of (1) a motion to consolidate the ’305 and ’537 IPRs, (2) a motion to extend the maximum one-year pendency of the ’305 IPR, (3) a motion to consolidate the ’306 and ’538 IPRs, and (4) a motion to extend the maximum one-year pendency of the ’306 IPR. Any motions filed should indicate whether they are opposed or unopposed and include proposed schedules for the affected proceedings such that the scheduled oral argument date in any affected proceeding is no later than the

currently scheduled oral argument dates in the '537 and '538 IPRs.[2] Further, any motions to extend the maximum one-year pendency of the '305 and '306 IPRs should include the procedural background of the proceedings and all relevant facts, including when Petitioner first became aware of the Forutanpour reference and an explanation for any delay between that date and the filing date of the '537 and '538 IPRs.

III. ORDER

Accordingly, it is:

ORDERED that either party is authorized to file a motion for consolidation of IPR2024-00305 with IPR2024-00537 in IPR2024-00305;[3]

FURTHER ORDERED that either party is authorized to file a motion for consolidation of IPR2024-00306 with IPR2024-00358 in IPR2024-00306;

FURTHER ORDERED that either party is authorized to file a motion to extend the maximum one-year pendency of IPR2024-00305; and

FURTHER ORDERED that either party is authorized to file a motion to extend the maximum one-year pendency of IPR2024-00306.

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[2] We note that although we have authority to rule on motions for consolidation, only the Chief Administrative Patent Judge has authority to rule on motions to extend the maximum one-year pendency of an *inter partes* review proceeding. *See* 37 C.F.R. §§ 42.100(c), 42.122(a).

[3] Information on motions practice before the Board can be found in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019) (*available at* https://www.uspto.gov/TrialPracticeGuideConsolidated).

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