UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

Case IPR2024-00306
U.S. Patent No. 9,173,054

JOINT MOTION TO EXTEND THE MAXIMUM
ONE-YEAR PENDENCY AND MODIFY THE SCHEDULING ORDER

TABLE OF CONTENTS

Page(s)

LIST OF PREVIOUSLY FILED EXHIBITS ii

I. BACKGROUND 1

II. REQUEST FOR EXTENSION OF ONE-YEAR PENDENCY 2

III. REQUEST FOR MODIFICATION OF DUE DATES 7 AND 8 5

A. If Pendency Is Extended, The Parties Request Modification Of Due Dates 7 And 8 To Align With IPR2024-00538 5

B. Alternatively, If The Motion To Extend Pendency Is Denied, The Parties Request The Following Modification Of Due Dates 7 And 8 To Align With IPR2024-00538 7

IV. CONCLUSION 9

CERTIFICATE OF SERVICE 11

LIST OF PREVIOUSLY FILED EXHIBITS

No.	Description
1001	U.S. Patent No. 9,173,054 ("**the '054 Patent**")
1002	File History of U.S. Patent No. 9,173,054
1003	Declaration of Peter Rysavy, dated December 20, 2023 ("**Rysavy Decl.**")
1004	U.S. Patent Application Pub. No. 2009/0298419 to Ahya et al. ("**Ahya**")
1005	U.S. Patent Application Pub. No. 2008/0166967 to Christopher D. McKillop ("**McKillop**")
1006	International Patent Application Pub. No. WO 2005/1072895 to J. Peter Hoddie ("**Hoddie**")
1007	U.S. Patent Application Pub. No. 2007/0191028 to Hinckley et al. ("**Hinckley**")
1008	Sidhu et al., *Emerging Wireless Standards – WiFi, ZigBee and WiMAX*, International Journal of Electronics and Communication Engineering Vol. 1 No. 1, at 43-48 (2007)
1009	Harry Newton, Newton's Telecom Dictionary, 20th Updated and Expanded Edition (excerpted) (2004)
1010	U.S. Patent Application Pub. No. 2009/0034498 to Banerjea et al. ("**Banerjea**")
1011	N/A
1012	U.S. Patent Application Pub. No. 2007/0135046 to Kapur et al. ("**Kapur**")
1013	U.S. Patent Application Pub. No. 2009/0215398 to Adler et al. ("**Adler**")
1014	Bluetooth Specification Version 1.1, Vol. 2, "Profiles" (Feb. 22, 2001)
1015	Megowan et al., Infrared Data Association® (IrDA®) Object

No.	Description
	Exchange Protocol OBEX™ Version 1.3 (Jan. 3, 2003).
1016	Postel et al., RFC 959, File Transfer Protocol (FTP) (Oct. 1985)
1017	K. Sollins, RFC 1350, The TFTP Protocol (Revision 2) (Jul. 1992)
1018	Frodigh et al., *Wireless ad hoc networking—The art of networking without a network*, Ericsson Review No. 4, at 248-263 (2000)
1019	U.S. Patent Application Pub. No. 2007/0146347 to Louis B. Rosenberg ("**Rosenberg**")
1020	Cheverst et al., *Exploring Bluetooth based Mobile Phone Interaction with the Hermes Photo Display*, Proceedings of the 7th International Conference on Human Computer Interaction with Mobile Devices and Services, at 47-54 (Sep. 2005)
1021	User's Guide for Nokia N72 (2006)
1022	U.S. Patent No. 7,356,347 to David Kammer ("**Kammer**")
1023	Phil Karn, *MACA - A New Channel Access Method for Packet Radio*, The Proceedings of the 9th ARRL Computer Networking Conference, at 134-140 (1990)
1024	Chatzimisios et al., *Optimisation of RTS/CTS handshake in IEEE 802.11 Wireless LANs for maximum performance*, IEEE Communications Society Globecom 2004 Workshops, at 270-275 (2004)
1025	Nokia 9500 Communicator User Guide (2004-2005)
1026	User's Guide for Nokia N95 (2007)
1027	U.S. Patent Application Pub. No. 2005/0113079 to Hui Guo ("**Guo**")
1028	U.K. Patent Application Pub. No. GB 2,439,364 to Turner et al. ("**Turner**")
1029	U.S. Patent Application Pub. No. 2004/0242216 to Demetrios Boutsikakis ("**Boutsikakis**")
1030	U.S. Patent No. 7,043,548 to Stephane Bouet ("**Bouet**")

No.	Description
1031	Brad A. Myers, The Importance of Percent-Done Progress Indicators for Computer-Human Interfaces, Proceedings of the SIGCHI Conference on Human Factors in Computing Systems (Apr. 1985)
1032	U.S. Patent Application Pub. No. 2009/0140986 to Karkkainen et al. ("**Karkkainen**")
1033	U.S. Patent Application Pub. No. 2007/0124503 to Ramos et al. ("**Ramos**")
1034	U.S. Patent No. 8,059,111 to Phil Harrison ("**Harrison**")
1035	U.S. Patent Application Pub. No. 2006/0026521 to Hotelling et al. ("**Hotelling '521**")
1036	Westerman et al., *Multi-Touch: A New Tactile 2-D Gesture Interface For Human-Computer Interaction*, Proceedings of the Human Factor and Ergonomic Society 45th Annual Meeting, at 632-636 (2001)
1037	Jun Rekimoto, *Pick-and-Drop: A Direct Manipulation Technique for Multiple Computer Environments*, Proceedings of the 10th annual ACM symposium on User interface software and technology, at 31-39 (1997)
1038	U.S. Patent Application Pub. No. 2008/0009309 to Hwang-hyeon Gha ("**Gha**")
1039	Pravin Bhagwat, *Bluetooth: Technology for Short-Range Wireless Apps*, at 96-103 (Jun. 2001)
1040	N/A
1041	N/A
1042	U.S. Patent Application Pub. No. 2003/0134629 to Ollis et al. ("**Ollis**")
1043	N/A
1044	U.S. Patent Application Pub. No. 2006/0097991 to Hotelling et al., ("**Hotelling '991**")

No.	Description
1045	U.S. Patent Application Pub. No. 2008/0168384 to Platzer et al. ("**Platzer**")
1046	U.S. Patent No. 7,479,949 to Jobs et al., ("**Jobs**")
1047	U.S. Patent Application Pub. No. 2008/0143685 to Lee et al. ("**Lee**")
1048	File History of U.S. Patent No. 8,200,265
1049	U.S. Patent No. 8,200,265 to Carlton et al. ("**the '265 patent**")
1050	File History of U.S. Patent No. 8,478,207
1051	U.S. Patent No. 8,478,207 to Carlton et al. ("**the '207 patent**")
1052	N/A
1053	Bluetooth Specification Version 1.1, Vol. 1, "Core" (Feb. 22, 2001)
1054	European Patent Application Pub. No. 1,489,783 to Anders Angelhag ("**Angelhag**")
1055	U.S. Patent Application Pub. No. 2005/0289195 to Lehtola et al. ("**Lehtola**")
1056	N/A
1057	Information Disclosure Statement for Lehtola filed June 23, 2004
1058	Affidavit of Nathaniel E. Frank-White, Records Request Processor at the Internet Archive ("Frank-White") Authenticating Exhibits 1014-1015, 1053, and 1060-1062
1059	Affidavit of Scott Delman, Director of Publication at the Association for Computing Machinery Authenticating Exhibit 1020
1060	User Guide for Nokia N91 (2006)
1061	User Guide for Nokia N75 (2006)
1062	User Guide for Nokia 9300 (2005)

No.	Description
1063	N/A
1064	User Guide for the Sony CLIE (2001)
1065	David Pogue, iPhone The Missing Manual (1st ed. Aug. 2007)
1066	U.S. Provisional Patent Application No. 61/140,126 to Carlton et al. ("**the '126 provisional**")
1067	U.S. Patent Application Pub. No. 2007/0011335 to Burns et al. ("**Burns**")
1068	Yardena Arar, *Bluetooth to work with Wi-Fi*, NetworkWorld (February 12, 2008)
1069	Staff's Proposed Claim Constructions, *Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, And Components Thereof*, Inv. No. 337-TA-1373 (Dec. 4, 2023)
1070	InterDigital's Proposed Claim Constructions, *Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, And Components Thereof*, Inv. No. 337-TA-1373 (Nov. 30, 2023)
1071	U.S. Patent No. 8,737,933 ("**the '933 Patent**")
1072	File History of U.S. Patent No. 8,737,933
1073	U.S. Patent Application No. 12/128,497 to Ahya et al. ("**As-Filed Ahya Application**")
1074	U.S. Patent Application Pub. No. 2005/0281237 to Heinonen et al. ("**Heinonen**")
1075	Full Claims Listing (1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, 49-50)
1076	U.S. Patent No. 7,102,640 to Aholainen et al. ("**Aholainen**")
1077	Bluetooth Technology To Harness The Speed Of 802.11, Feb 11, 2008
1078	Megowan et al., Infrared Data Association® (IrDA®) Object Exchange Protocol OBEX™ Version 1.5 (Aug. 14, 2009).

No.	Description
1079	U.S. Patent No. 7,333,514 to Anehem et al. ("**Anehem**")
1080	U.S. Patent Application No. 11/804,359 to McKillop et al. ("**As-Filed McKillop Application**")
1081	Defendant Lenovo's Supplemental Notice Regarding Prior Art Invalidity Grounds, Document No. 96, Case No. 5:23-cv-00493 (E.D.N.C.)
1082	United States District Courts Judicial Caseload Profile

Pursuant to the Board's Order (Paper 17), the parties jointly file this motion to extend the one-year pendency of this IPR and adjust certain due dates to align the schedule of this IPR with later-instituted IPR2024-00538, which involves the same patent and the same claims. As explained below, good cause exists for this extension and these adjustments at least because it will allow for efficiencies in coordinating depositions, briefing, and oral argument, and will allow the Board to issue a final written decision ("FWD") for this IPR on the same day as IPR2024-00538. The parties have been diligent and neither party is prejudiced by this extension and alignment of due dates.

I. BACKGROUND

Petitioner Microsoft Corporation ("Petitioner") filed a Petition requesting inter partes review of Patent 9,173,054 ("the '054 patent") on December 20, 2023 (IPR2024-00306) and then filed another petition on February 9, 2024 (IPR2024-00538) challenging the same claims, asserting a later effective filing date and relying on an intervening prior art reference ("Forutanpour") that was not cited in the earlier-filed -00306 petition. The Board instituted trial in IPR2024-00306 on May 10, 2024 (Paper 12) and instituted trial in IPR 2024-00538 on July 15, 2024 (Paper 10). Thus,

the one-year period to issue a FWD in IPR2024-00306 ends May 9, 2025[1], and in IPR2024-00538 ends July 15, 2025.

The ’054 patent was asserted in a related ITC proceeding but was dropped from that proceeding on July 26, 2024 (after the two IPRs were instituted). *Certain Electronic Devices, Including Smartphones, Computers, Tablet Computers, And Components Thereof*, Inv. No. 337-TA-1373 (ITC), Order No. 51. The ’054 patent was also asserted in district court litigation where it was found invalid under 35 U.S.C. § 101. *InterDigital, Inc. et al. v. Lenovo Group Limited et al.,* Case No. 5:23-cv-00493-FL (E.D.N.C.), ECF No. 133.

II. REQUEST FOR EXTENSION OF ONE-YEAR PENDENCY

In IPR2024-00306, the parties respectfully request extension of the maximum one-year pendency to issue a FWD from the current deadline of May 9, 2025, to July 15, 2025 (the one-year deadline for IPR2024-00538). This roughly two-month extension will promote efficiencies by facilitating alignment of schedules with IPR2024-00538, which involves the same challenged claims, and allow the Board to issue FWDs in both IPRs on the same day.

For at least the following reasons, good cause exists for the extension.

[1] May 10, 2025 falls on a Saturday.

First, extension would promote efficiencies by allowing alignment of the schedules in IPR2024-00306 and IPR2024-00538. *Infra* Section III. Aligning these schedules will allow depositions and oral arguments for the two IPRs to be held on the same or back-to-back days, thus promoting efficiency in preparation and any required travel. Alignment would also enable the Board to consider briefings and issue final written decisions contemporaneously. While the two IPRs involve different issues (IPR2024-00538 is based on a priority date challenge and intervening prior art reference), they involve the same challenged patent and claims. Thus, alignment of the briefing schedules would also promote efficiencies and allow parties to better focus the respective arguments than if the briefing proceeded on different schedules.

Second, neither party would be prejudiced by extension and alignment of the dates as described herein. Rather, both parties support this motion.

Third, Petitioner was diligent in filing the later-instituted IPR (IPR2024-00538). The complaint in parallel district court litigation was served on September 19, 2023, and infringement contentions, which for the first time identified challenged dependent claims, were served December 4, 2023. While preparing the petition for this earlier-instituted IPR, Petitioner became aware of a later effective filing date due to a lack of written description and subsequently became aware of the Forutanpour primary reference on November 19, 2023. Petitioner moved promptly

in preparing and filing petitions in IPR2024-00537 and IPR2024-00538 on February 9, 2024, less than three months after discovering Forutanpour and barely 7 weeks after filing the first petitions in IPR2024-00305 and IPR2024-00306 on December 20, 2023. As noted in the next paragraph, given the fast schedule in the parallel ITC proceeding, it would not have been prudent to delay filing the first petition until the second petition was ready.

Fourth, given the parallel ITC and district court proceedings involving named real party-in-interest Lenovo, Petitioner moved as quickly as possible in filing the first petition. In particular, given the fast schedule of the ITC proceeding, Petitioner should not have been expected to delay filing the petition for this earlier-instituted IPR until the petition for the later-instituted IPR2024-00538 was ready for filing. Accordingly, Petitioner expeditiously filed its petitions in IPR2024-00305 and IPR2024-00306 on December 20, 2023, just weeks after being served the infringement contentions in the district court litigation.

Termination of the ’054 patent from the ITC proceeding on July 26, 2024 (*see* Paper 16) removed any timing concerns vis-à-vis that proceeding and Petitioner now supports this motion for extension of the one-year pendency of this IPR (IPR2024-00306).

To facilitate alignment of the schedules and allow the Board to issue FWDs on the same day[2], the parties jointly move to extend the one-year pendency of this IPR (IPR2024-00306) to align with the one-year pendency of IPR2024-00538.

III. REQUEST FOR MODIFICATION OF DUE DATES 7 AND 8

A. If Pendency Is Extended, The Parties Request Modification Of Due Dates 7 And 8 To Align With IPR2024-00538

If the Chief Judge grants the motion to extend the one-year pendency of this IPR (IPR2024-00306), the parties respectfully request to modify Due Dates 7 and 8 of the Schedule Order (Paper 13) of this IPR to align with the schedule of later-instituted IPR2024-00538 as proposed in the below table. This will facilitate the Board in hearing oral argument for IPR2024-00306 and IPR2024-00538 contemporaneously as well as enable the Board to issue FWDs in both IPRs on the same day.

[2] In IPR2024-00305, which involves a related patent, the Parties simultaneously are filing a motion that, like the present motion, seeks to similarly align the schedules of IPR2024-00305 and IPR2024-00537. Thus, should the Board grant the relief requested in this joint motion and the joint motion in IPR2024-00305, then there would be a similar schedule in all four IPR proceedings on the two related patents.

Event	IPR2024-00306 (Current Dates)	IPR2024-00306 (Proposed Dates)	IPR2024-00538
Due Date 1 Patent Owner Response ("POR")[3]	September 23, 2024[4]	October 7, 2024	October 7, 2024
Due Date 2 Petitioner's Reply to the POR	December 16, 2024	December 30, 2024	December 30, 2024
Due Date 3 Patent Owner's ("PO") sur-reply	January 27, 2025	February 10, 2025	February 10, 2025
Due Date 4 Request for Oral Argument	December 20, 2024	March 3, 2025	March 3, 2025
Due Date 5 Motion to Exclude ("MTE")	January 17, 2025	March 24, 2025	March 24, 2025

[3] Patent Owner does not intend to file a motion to amend.

[4] The Parties already have twice stipulated to extension of Due Dates 1-3. Paper Nos. 15, 18.

Event	IPR2024-00306 (Current Dates)	IPR2024-00306 (Proposed Dates)	IPR2024-00538
Due Date 6 Opposition to MTE, Request for Prehearing Conference	January 24, 2025	March 31, 2025	March 31, 2025
Due Date 7 Reply in Support of MTE	January 31, 2025	April 7, 2025	April 7, 2025
Due Date 8 Oral Argument	February 6, 2025	April 11 or 15[5], 2025	April 14, 2025
FWD	May 10, 2025	July 15, 2025	July 15, 2025

B. Alternatively, If The Motion To Extend Pendency Is Denied, The Parties Request The Following Modification Of Due Dates 7 And 8 To Align With IPR2024-00538

Should the Board deny the joint motion to extend the pendency of IPR2024-00306, the parties respectfully request to modify Due Dates 7 and 8 for both

[5] The parties propose two days of oral argument reflecting the time expected to hear both sets of arguments.

IPR2024-00306 and IPR2024-00538[6] as proposed in the following chart. This would, again, align oral argument and facilitate issuance of FWDs for both IPR2024-00306 and IPR2024-00538 on the same day.

Due Date	IPR2024-00306 (Current Dates)	IPR2024-00306 (Proposed Dates)	IPR2024-00538 (Current Dates)	IPR2024-00538 (Proposed Dates)
Due Date 1 POR[7]	September 23, 2024	September 23, 2024	October 7, 2024	October 7, 2024
Due Date 2 Petitioner's Reply to the POR	December 16, 2024	December 16, 2024	December 30, 2024	December 16, 2024
Due Date 3 PO sur-reply	January 27, 2025	January 27, 2025	February 10, 2025	February 3, 2025
Due Date 4 Request for Oral Argument	December 20, 2024	December 20, 2024	March 3, 2025	March 3, 2025

[6] If the Chief Judge denies the motion to extend the one-year pendency of this IPR, then the parties will file a motion in IPR2024-00538 to modify the due dates for that IPR as proposed in the chart.

[7] Patent Owner does not intend to file a motion to amend.

Due Date	IPR2024-00306 (Current Dates)	IPR2024-00306 (Proposed Dates)	IPR2024-00538 (Current Dates)	IPR2024-00538 (Proposed Dates)
Due Date 5 MTE	January 17, 2025	January 24, 2025	March 24, 2025	February 17, 2025
Due Date 6 Opposition to MTE, Request for Prehearing Conference	January 24, 2025	January 31, 2025	March 31, 2025	February 24, 2025
Due Date 7 Reply in Support of MTE	January 31, 2025	February 6, 2025	April 7, 2025	March 3, 2025
Due Date 8 Oral Argument	February 6, 2025	Week of March 17, 2025[8]	April 14, 2025	Week of March 17, 2025
FWD	May 10, 2025	May 10, 2025	July 15, 2025	July 15, 2025

IV. CONCLUSION

[8] Parties propose two days of oral argument reflecting the time expected to hear both sets of arguments.

For the foregoing reasons, the parties respectfully request that the Chief Judge extend the one-year maximum pendency of IPR2024-00306, and the Board modify the Scheduling Order (Paper 13) in this action as described herein. If the motion to extend is denied, the parties request the Board modify the scheduling orders in both IPR2024-00306 and IPR2024-00538 as described herein.

Respectfully submitted,

Dated: September 9, 2024

By: /Andrew M. Mason/

Andrew M. Mason (Reg. No. 64,034)
andrew.mason@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner

/Scott W. Hejny/

Scott W. Hejny (Reg. No. 45,822)
shejny@mckoolsmith.com
MCKOOL SMITH, P.C.
300 Crescent Court, Suite 1200
Dallas, TX 75201
Tel: 214-978-4000
Fax: 214-978-4044

Counsel for Patent Owner

CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6 (E)(4)

The undersigned certifies that on September 9, 2024, a complete copy of the **JOINT MOTION TO EXTEND THE MAXIMUM ONE-YEAR PENDENCY AND MODIFY THE SCHEDULING ORDER** was served on counsel for the Patent Owner via electronic mail as follows:

Scott W. Hejny
Richard A. Kamprath
McKool Smith P.C.
300 Crescent Court, Suite 1200
Dallas, TX 75201
Email: shejny@mckoolsmith.com
rkamprath@mckoolsmith.com

George T. Fishback, Jr.
McKool Smith P.C.
303 Colorado Street, Suite 2100
Austin, TX 78701
Email: gfishback@mckoolsmith.com

By: /Andrew M. Mason/
Andrew M. Mason (Reg. No. 64,034)
andrew.mason@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner