

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MICROSOFT CORPORATION,  
Petitioner,

v.

PROXENSE, LLC  
Patent Owner

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U.S. Patent No. 8,646,042 B1  
IPR Case No.: 2024-00573

**PATENT OWNER'S MOTION TO DEEM THE FILING OF ITS PRELIMINARY  
RESPONSE AND EXHIBITS AS TIMELY**

## **I. INTRODUCTION**

Patent Owner, Proxense, LLC (“Proxense”), respectfully submits this motion to the Patent Trial and Appeal Board (“Board”) to accept the late-filed Preliminary Patent Owner Response in the above-captioned proceeding. The delay in filing was due to human error that resulted from an unexpected series of coincidences: (1) Petitioner filed this petition a month after it filed two nearly identical petitions challenging other patents in the same family as the patent challenged here; and (2) Petitioner served former prosecution counsel with the petition and did not serve undersigned counsel, who had appeared in all prior IPRs for Proxense. Acceptance of the proffered preliminary response would cause no prejudice to the Petitioner or the proceedings and would promote judicial efficiency, and consistency, as well as a just, speedy, and inexpensive resolution as detailed below.

## **II. BACKGROUND**

Petitioner filed the instant petition, IPR Case No.: 2024-00573, challenging U.S. Patent No. 8,646,042 (“042”), on February 15, 2024. *Microsoft Corp. v. Proxense LLC*, PTAB-IPR2024-00573 (the “573 Petition”), Paper 2 (Petitioner Feb. 15, 2024). By way of NOFDA, the Board set the Patent Owner Preliminary Response to three months from February 26, 2024. *Id.*, Paper 3 (Board Feb. 26, 2024). The certificate of service lists Patent Law Works, former prosecution counsel for the patents, on whom the filing was served. *Id.*, Paper 2 at 92 (Petitioner Feb. 15, 2024).

Petitioner filed PTAB-IPR2024-00405 on January 16, 2024 challenging U.S. Patent No. 10,073,960 which is in the same family as the 042, and raising nearly the same invalidity arguments as in the instant petition. Patent Owner’s Preliminary Response was due on April 16, 2024 and was timely filed. *Microsoft Corp. v. Proxense LLC*, PTAB-IPR2024-00405 (the “405 Petition”), Paper 002 (Petitioner January 16, 2024); Paper 006 (Patent Owner Apr. 29, 2024).

Petitioner filed PTAB-IPR2024-00407 on January 16, 2024 challenging U.S. Patent No.9,679,289, which is in the same family as the 042, and raising nearly the same invalidity arguments as in the instant petition. Patent Owner's Preliminary Response was due on April 16, 2024 and was timely filed. *Microsoft Corp. v. Proxense LLC*, PTAB-IPR2024-00407 (the "407 Petition"), Paper 002 (Petitioner January 16, 2024); Paper 006 (Patent Owner Apr. 29, 2024).

Patent Owner's error caused the late filing. The due date for Patent Owner's Preliminary Response was unexpectedly staggered from the other response for the same patent family, making nearly identical arguments. In addition, because the undersigned counsel was not directly served, the docketing, rather than being automated as usual, was input by hand. Exhibit 2013, Declaration of David L. Hecht ("Hecht Decl"). ¶3. These two circumstances resulted in human error wherein Patent Owner internally marked this Preliminary Response as timely filed together with the other response even though it was not. *Id.* ¶4. On June 5, immediately upon realizing that the response was not timely filed, Patent Owner provided Microsoft with a copy of its Preliminary Response and began drafting the instant motion. *Id.* ¶5.

Petitioner has not objected nor asserted any prejudice arising from the delay in Patent Owner's filing. *Id.* ¶5.

### **III. THE BOARD SHOULD DEEM PATENT OWNER'S FILING AS TIMELY**

"A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." 37 C.F.R. 42.5(c)(3). The Board has construed this rule "to secure the just, speedy, and inexpensive resolution of every proceeding." *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 19 at 2 (PTAB Sept. 15, 2014).

The late filing was due to an unexpected series of events that permitted human error into an otherwise strict automated docketing system. A related petition challenging a patent in the

same family as the 042 (namely, the 960 patent) was filed on January 16. *Microsoft Corp. v. Proxense LLC*, PTAB-IPR2024-00405 (the “405 Petition”), Paper 002 (Petitioner January 16, 2024). Another related petition, challenging another patent in the same family as the 042 (namely, the 289 patent) was also filed on January 16. . *Microsoft Corp. v. Proxense LLC*, PTAB-IPR2024-00407 (the “407 Petition”), Paper 002 (Petitioner January 16, 2024). But the petition for this matter was filed almost a month after the 405 and 407 and the deadline here was further extended by operation of an NOFDA. 573 Petition, Paper 2 (Petitioner Feb. 15, 2024); Paper 3 (Board Feb. 26, 2024). Moreover, because the petition was not served directly on Patent Owner’s chosen IPR counsel that appeared in all prior IPRs, undersigned counsel manually found and uploaded the documents and manually entered the relevant dates, introducing an opportunity for human error where it would otherwise have been automated. Hecht Decl.¶¶XX. As a result, when the preliminary responses for the two petitions were filed timely, the response for this petition was also inadvertently considered as filed when it had not been. While this error is not an example of best practices, it is somewhat understandable under the circumstances.

Accepting the late filed Preliminary Response would not prejudice Petitioner in any way. Patent Owner timely filed its Preliminary Responses in the related, and nearly identical, petitions (PTAB-IPR2024-00405 and PTAB-IPR2024-00407). The arguments presented in the Patent Owner’s Preliminary Response that is being proffered by this motion are nearly identical to those presented in responses filed in the 407 and 405 IPRs. Hecht Decl.¶3. The main difference is that a section of arguments is removed where a claim term does not appear in the 042 patents but does appear the patents at issue in the 407 and 405 IPRs. *Id.* Furthermore, the Preliminary Response proffered here, and those filed in the 407 and 405, IPRs request do not request discretionary denial. Rather, each addresses the Petitions solely on their merits. Additionally,

Microsoft has not requested a pre-institution reply in either the 405 or 407 IPRs. Petitioner was thus on notice of all of Patent Owner's arguments, has chosen not to respond, and will not be prejudiced in any way if it chooses to request a reply in this case.

Accepting the late filed Preliminary Response serves the interest of justice and to do otherwise would impose undue burdens on the Board and the Parties. Proxense should be afforded a full opportunity to defend its patent rights and identify the same deficiencies in the petition as Proxense identified in its Preliminary Response on the 407 and 405 IPRs despite the filing error. The issues in these three proceedings will have significant, nearly complete, overlap. A situation where one of the three petitions has a different outcome than the other two would create inconsistency and introduce a burden on the parties and the Board, potentially creating conflicting decisions. Moreover, Patent Owner would present the same arguments in an instituted proceeding, meaning the Petitioner would respond to and the Board would consider the arguments presented in the proffered Preliminary Response anyway, just at a later date. The parties and the Board would thus have to unnecessarily duplicate efforts for this petition. The interests of a just, speedy, and inexpensive resolution for all three petitions are best served by allowing the late-filed Preliminary Response.

#### **IV. CONCLUSION**

For the foregoing reasons, Patent Owner respectfully requests that the Board accept the late-filed Preliminary Patent Owner Response. This acceptance will ensure that the proceedings are fair and efficient, and it will avoid undue prejudice to both parties.

Dated: June 7, 2024

Respectfully submitted by,

/s/ David L. Hecht

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that Patent Owner's Motion to Deem The Filing of Its Preliminary Response And Exhibits As Timely was served on June 7, 2024 by e-mailing copies to the following e-mail addresses as provided in Petitioner's Petition:

IPR42342-0134IP1@fr.com; PTABInbound@fr.com; axf-ptab@fr.com; devoto@fr.com; khan@fr.com; driesslein@fr.com

Dated: June 7, 2024

Respectfully submitted,

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