

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00573
Patent 8,646,042 B1

Before THU A. DANG, NORMAN H. BEAMER, and
DAVID C. McKONE, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION
Granting Motion to Deem Filings Timely
37 C.F.R. § 42.5

I. INTRODUCTION

On June 7, 2024, Proxense, LLC (Patent Owner) contacted the Board via email requesting authorization to file a motion to deem the filing of its Preliminary Response and exhibits as timely, as well as a supporting declaration. On June 10, 2024, via email, we authorized Patent Owner to file a motion to deem the filing timely and the supporting declaration. On the same day, June 10, 2024, Patent Owner filed the Motion (Paper 8 (Mot.)) along with a Patent Owner Preliminary Response (Paper 7 (PO Resp.)), exhibits (Exs. 2001–2012), and Declaration of David L. Hecht (Ex. 2013) supporting the Motion.

Upon consideration of the arguments presented and for the reasons discussed below, we grant Patent Owner’s motion to deem the filings timely.

II. DISCUSSION

On February 15, 2024, Microsoft Corporation (Petitioner) filed a Petition for *Inter Partes* Review (IPR). Paper 2 (Pet.). The deadline for Patent Owner to file a preliminary response and exhibits had passed on May 15, 2024. Patent Owner now seeks for the Board to deem the filing of the Preliminary Response (Prelim. Resp.) and exhibits (Ex. 2001–2012) timely. Mot. 2.

Our Rules provide that a “late action will be excused upon a showing of good cause or upon a Board decision that consideration of the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

Patent Owner represents in its Motion that delay in filing “was due to human error that resulted from an unexpected series of coincidences,” in particular “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 “Petitioner served former prosecution counsel with the petition and did not serve undersigned counsel, who had appeared in all prior IPRs for [Patent Owner].”

Mot. 2. According to Patent Owner, these unexpected series of coincidences “resulted in human error wherein Patent Owner internally marked this Preliminary Response as timely filed with the other response even though it was not.” *Id.* at 3 (citing Ex. 2013 ¶ 4). Patent Owner represents that, “[o]n June 5, immediately upon realizing that the response was not timely filed, Patent Owner provided [Petitioner] with a copy of its Preliminary Response and began drafting the instant motion.” *Id.* (citing Ex. 2013 ¶ 5). Patent Owner further represents that “Petitioner has not objected nor asserted any prejudice arising from the delay in Patent Owner’s filing.” *Id.* (citing Ex. 2013 ¶ 5).

On this record, we find that Petitioner suffered no prejudice resulting from Patent Owner’s late filing. Patent Owner represents that the Preliminary Response and all supporting exhibits were provided to Petitioner “immediately upon realizing that the response was not timely filed.” Mot. 3. As Patent Owner represents, “[t]he 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.” *Id.* at 4 (citing Ex. 2013 ¶ 3). We are persuaded that “Petitioner was thus on notice of all of Patent Owner’s arguments,” and “will not be prejudiced in any way if it chooses to request a reply in this case.” *Id.* at 5.

Under the facts and circumstances present here, we determine that it would be in the interests of justice to consider Patent Owner’s Preliminary Response and supporting exhibits in our decision on institution. An institution decision that considers Patent Owner’s arguments will benefit both parties by providing clarity as to the Board’s view of the evidence and arguments.

The parties are cautioned, however, that the Board expects compliance in the future with all deadlines, page limits, word limits, and formatting requirements.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner's motion to deem the filing timely is *granted* pursuant to 37 C.F.R. § 42.5(c)(3), and the Board will treat Patent Owner's Preliminary Response and supporting exhibits as if they had been timely filed.

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PETITIONER

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