

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PROXENSE, LLC
Patent Owner

U.S. Patent No. 8,886,954
IPR Case No.: IPR2024-00846

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STAY THE *EX PARTE* REEXAMINATION OF US PATENT NO. 8,352,730**

Petitioner’s Motion to Stay has a fatal flaw and is effectively dead-on arrival. It cites nothing—no statute, no rule, no regulation—because nothing gives the Board jurisdiction over U.S. Patent No. 8,352,730 (the “730 Patent”). No authority means no motion. Accordingly, Petitioner’s motion must be denied as a matter of law.

To be clear, the Director has no authority to stay the 052 Re-Exam. Under 35 U.S.C. § 315(d), “during the pendency of an inter partes review, if ***another proceeding or matter involving the patent*** is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.” (Emphasis added.) Thus, the authority granted to the Director is limited to situations in which there is “another proceeding or matter ***involving the patent.***” (Emphasis added.) However, this proceeding involves U.S. Patent No. 8,886,954 (“954 Patent”). The 052 Re-Exam involves the 730 Patent. Therefore, this proceeding and the 052 Re-Exam involve two different patents, which means the 052 Re-Exam is not “another proceeding or matter ***involving the patent.***” Accordingly, 35 U.S.C. § 315(d) does not provide the Director the authority to stay the 052 Re-Exam.

The Director, of course, has delegated the authority granted under 35 U.S.C. § 315(d) to the Board. However, the Director cannot delegate authority she does not possess. In that regard, the Director has only “authorized the Board to enter an order

to effect a stay, transfer, consolidation, or termination of parallel Office proceedings ***involving the same patent*** during the pendency of an AIA trial proceeding”. *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,656 (2019) (emphasis added). This delegation of authority was codified in 37 C.F.R. §§ 42.3(a) and 42.122(a). Both sections limit the Board’s ability to issue a stay to proceedings involving the 954 Patent.

For instance, 37 C.F.R. § 42.3(a) states:

“The Board may exercise exclusive jurisdiction within the Office over ***every involved application and patent*** during the proceeding, as the Board may order.” (Emphasis added.)

Thus, the Board’s jurisdiction is limited to patents directly ***involved*** in the proceeding. But, as mentioned, the 730 Patent is not involved in this proceeding. Therefore, 37 C.F.R. § 42.3(a) does not give the Board jurisdiction over the 730 Patent.

Similarly, 37 C.F.R. § 42.122(a) states:

“Where ***another matter involving the patent*** is before the Office, the Board may during the pendency of the inter partes review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.” (Emphasis added.)

Accordingly, the Board's power to stay is limited to *another matter involving the patent*. But again, the 052 Re-Exam does not involve the patent at issue in this proceeding. Thus, 37 C.F.R. § 42.122(a) does not give the Board the authority to stay the 052 Re-Exam.

Petitioner's Motion for Stay fails to cite any statute or regulation superseding the above. In fact, Petitioner fails to cite any authority under which the Board may grant the Motion for Stay. Accordingly, Petitioner's Motion for Stay must be denied as a matter of law.

Dated: June 30, 2025

Respectfully submitted, by

/David L. Hecht/

David L Hecht

Reg. No 61,618

Hecht Partners LLP

125 Park Avenue, 25th Floor

New York, NY 10017

Tel: 212-851-6821

E: dhecht@hechtpartners.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that Patent Owner Proxense, LLC's Opposition to Petitioner's Motion to Stay the *Ex Parte* Reexamination of US Patent No. 8,352,730 was served on Petitioner by e-mailing copies to the e-mail addresses provided in Petitioner's Petition:

Dated: June 30, 2025

Respectfully submitted, by

/David L. Hecht/

David L Hecht

Reg. No 61,618

Hecht Partners LLP

125 Park Avenue, 25th Floor

New York, NY 10017

Tel: 212-851-6821

E: dhecht@hechtpartners.com

Counsel for Patent Owner