

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00846
Patent 8,886,954 B1

Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE,
Administrative Patent Judges.

McKONE, *Administrative Patent Judge.*

ORDER
Denying Stay of Reexamination
35 U.S.C. § 325(d)

Microsoft Corp. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–29 of U.S. Patent No. 8,886,954 B1 (Ex. 1001, “the ’954 patent”). Pet. 1. We instituted a trial on November 18, 2024. Paper 8 (“Inst. Dec.”). In a final written decision in a different proceeding, *Apple Inc. v. Proxense LLC*, IPR2024-00233, Paper 35 (PTAB June 17, 2025), we determined that claims 1–7, 10, 12–19, and 22–27 of the ’954 patent are unpatentable.

U.S. Patent No. 8,352,730 B2 (“the ’730 patent”)¹ is related to the ’954 patent. The ’730 patent is the subject of *ex parte* reexamination in *In re Proxense, LLC*, Application No. 90/015,052 (filed June 8, 2022) (“the ’052 reexam”). Paper 16, Motion to Stay the *ex parte* Reexamination of US Patent No. 8,352,730 (“Mot.”) 1. Petitioner moves to stay the ’052 reexam. Mot. Proxense, LLC (“Patent Owner”) opposes a stay. Paper 19, Patent Owner’s Opposition to Petitioner’s Motion to Stay (“Opp. to Mot.”).

Petitioner contends that the claims of the ’730 patent and the ’954 patent are “almost identical.” Mot. 5. Petitioner argues that staying the ’052 reexam would avoid inconsistencies between this proceeding and the ’052 reexam, including avoiding the possibility that the Examiner makes findings as to prior art references raised in both proceedings that differ from our findings on records that are substantially similar. *Id.* at 1–3. Petitioner argues that, armed with such inconsistencies, Patent Owner might raise, here or on appeal, Administrative Procedure Act (APA) concerns and attempt to bind us to the Examiner’s findings. *Id.* at 3–4. Petitioner argues that

¹ The ’730 patent was the subject of *Apple Inc. v. Proxense, LLC*, IPR2024-00232 and *Microsoft Corp. v. Proxense, LLC*, IPR2024-00775, both of which were terminated after Patent Owner requested adverse judgment against itself, resulting in the cancellation of all claims of the ’730 patent.

“findings and conclusions in the [’052 reexam] could be used to pressure the Board under threat of appeal from issuing a decision that deviates in any way from the [Central Reexamination Unit’s (“CRU”)] decision,” and that staying the ’052 reexam would “prevent circumvention of the Board.” *Id.* at 4–5.

Patent Owner argues that we have no authority to stay the ’052 reexam because it does not involve the same patent at issue in this proceeding. Opp. to Mot. 1–3 (citing 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)); 37 C.F.R. § 42.122(a) (“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)); 37 C.F.R. § 42.3(a) (“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))).

We agree with Patent Owner. In addition to Section 315(d), quoted above, 35 U.S.C. § 325(d) states (emphasis added):

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter *involving the patent* is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding.

Sections 315(d) and 325(d) and Rules 42.3(a) and 42.122(a) make clear that the Director (and, by Delegation, the Board) may stay the reexamination of the patent at issue in an *inter partes* review. But none of these statutes or rules purports to authorize us to stay the reexamination of a patent not involved in the *inter partes* review. This proceeding involves the '954 patent, while the '052 reexam involves a different patent, the '730 patent. Petitioner has offered no authority for us to stay the reexamination of a patent not at issue in this proceeding. Accordingly, we deny Petitioner's Motion.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Stay the *ex parte* Reexamination No. 90/015,052 (Paper 16) is denied.

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