

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,
v.

X1 DISCOVERY, INC.,
Patent Owner

U.S. Patent No. 10,552,490

Case No. IPR2025-00254

**PATENT OWNER'S REPLY BRIEF
IN SUPPORT OF DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

EXHIBIT LIST

Exhibit No.	Description of Document
2001	Declaration of Mr. Martin Haeberli, dated April 28, 2025
2002	CV of Mr. Martin Haeberli
2003	Revised Stipulation to Stay, <i>XI Discovery, Inc. v. Microsoft Corp.</i> , No. 8:23-cv-02415 (C.D. Cal. Feb 29, 2024), ECF No. 52
2004	Order Granting Revised Stipulation to Stay, <i>XI Discovery, Inc. v. Microsoft Corp.</i> , No. 8:23-cv-02415 (C.D. Cal. Mar. 1, 2024), ECF No. 53
2005	Joint Status Report, <i>XI Discovery, Inc. v. Microsoft Corp.</i> , No. 8:23-cv-02415 (C.D. Cal. Mar. 12, 2025), ECF No. 57
2006	Minutes of Status Conference, <i>XI Discovery, Inc. v. Microsoft Corp.</i> , No. 8:23-cv-02415 (C.D. Cal. Mar. 12, 2025), ECF No. 59
2007	Excerpt of the Initial Determination Granting-In-Part Respondents' Motion for Summary Determination, <i>Certain Computing Devices Utilizing Indexed Search Systems and Components Thereof</i> , ITC-337-TA-1389, at 14 (Sept. 3, 2024)
2008	Excerpt of the Initial Determination of Violation of Section 337 and Recommended Determination on Remedy and Bond , <i>Certain Computing Devices Utilizing Indexed Search Systems and Components Thereof</i> , ITC-337-TA-1389, at 31-32 (Feb. 26, 2025)
2009	Email from counsel for Microsoft to counsel for X1 regarding <i>Sotera</i> stipulation, Apr. 18, 2025
2010	File History of U.S. Patent No. 7,370,035
2011	Information Disclosure Statement for US 12/328,410 dated Dec. 4, 2008 and filing receipt
2012	Information Disclosure Statement for US 11/108,335 dated June 26, 2008

Exhibit No.	Description of Document
2013	Information Disclosure Statement for US 15/199,928 dated June 30, 2016 (now U.S. Patent No. 10,897,443)
2014	Office Action for US 11/128,397 dated May 18, 2007
2015	Office Action for US 11/108,479 dated March 24, 2008
2016	Office Action for US 11/771,554 dated Dec. 23, 2009 (now U.S. Patent No. 8,533,176)
2017	Office Action for US 12/786,246 dated Jan. 10, 2012
2018	Office Action for US 13/918,306 dated June 24, 2015
2019	Information Disclosure Statement for US 15/012,684 dated Feb. 1, 2016 (now U.S. Patent No. 10,546,030) and filing receipt

Patent Owner submits this reply brief pursuant to the Court's June 16, 2025 email. (EX3101.) "Settled Expectations" support discretionary denial. U.S. Patent No. 10,552,490 (the '490 Patent) was filed on April 24, 2017, published on December 14, 2017, and issued on February 4, 2020. (EX1001, 1.) The '490 Patent is a continuation of U.S. Patent No. 7,370,035 (the '035 Patent), which published as U.S. Patent Pub. No. 2004/0133564 (the '564 Publication) on July 8, 2004. Microsoft listed the '035 Patent on an IDS filed during prosecution of U.S. Application No. 12/328,410 on December 4, 2008, over 16 years prior to filing this Petition. (EX2011, 1.) Microsoft listed the '564 Publication on IDS disclosures filed during prosecution of no fewer than 2 of its own applications in 2008 and 2016. (EX2012, 1; EX2013, 1.) The Examiner cited the '564 Publication at least 4 times during prosecution of Microsoft applications either as a basis for a claim rejection or as relevant prior art of record. (EX2014, 13; EX2015, 7-10; EX2016, 8-9, 15; EX2017, 21.) U.S. Patent No. 8,498,977, a continuation of the '035 Patent, was also cited during prosecution of two Microsoft patent applications. (EX2018, 18; EX2019, 1.) Because Microsoft has been aware of, but failed to challenge the validity of, either the '490 Patent or its family members over the last 16 years, the settled expectations regarding the presumed validity and enforceability of the '490 Patent supports denying institution.

Dated: June 17, 2025

By: /Lori A. Gordon/

Lori A. Gordon (Reg. No. 50,633)
GOODWIN PROCTER LLP
1900 N Street, N.W.
Washington, D.C. 20036
Phone: (202) 346 4435
Gordon-ptab@goodwinlaw.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

A copy of this Patent Owner's Reply Brief in Support of Discretionary Denial has been served on Petitioner's attorneys of record as follows via electronic mail:

Todd M. Siegel, Reg. No. 73,232
todd.siegel@klarquist.com

Amy C. Haspel, Reg. No. 78,385
amy.haspel@klarquist.com

Andrew M. Mason, Reg. No. 64,034
andrew.mason@klarquist.com

Samuel B. Thacker, Reg No. 78,633
samuel.thacker@klarquist.com

Msft-X1-IPRs@klarquist.com

KLARQUIST SPARKMAN, LLP
121 SW Salmon Street, Suite 1600
Portland, Oregon, 97204
503-595-5300 (phone)
503-595-5301 (fax)

Attorneys for Microsoft Corporation

Dated: June 17, 2025

By: /Lori A. Gordon/

Lori A. Gordon (Reg. No. 50,633)
GOODWIN PROCTER LLP
1900 N Street, N.W.
Washington, D.C. 20036
Phone: (202) 346 4435
Gordon-ptab@goodwinlaw.com

Attorney for Patent Owner