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IPR2025-00253

IPR2025-00254

IPR2025-00255

Your Honors,

Patent Owner in the above-captioned IPR proceedings respectfully requests authorization to file Motions to Terminate for Failure to Disclose Contradictory Claim Construction Positions Taken in District Court. Patent Owner submits that good cause exists to grant this request. The parties have conferred. Petitioner opposes and submits that no good cause exists for the Motion sought by Patent Owner. The parties' positions are provided below, and the parties can be available at the Board's convenience should a call be necessary.

Patent Owner's Position

Patent Owner seeks authorization to file Motions to Terminate based on Petitioner's failure to disclose and justify contradictory claim construction positions taken in parallel district court litigation.

This request concerns Petitioner's failure to comply with the Director's precedential clarification in *Revvo Technologies* that when a petitioner advances different claim construction positions before the Board and a district court, the petitioner must, "at a minimum, explain why alternative positions are warranted" in the Petition itself. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–4 (Nov. 3, 2025) (precedential). Where that explanation is absent, the Director has made clear that "the appropriate course of

action ... is to deny institution,” and that a petitioner “can’t have it both ways and certainly not without a sufficient explanation.” *Id.*, Paper 36 at 3–4 (Jan. 26, 2026). The procedural defect identified here is therefore not a minor pleading issue, but one that, under Director precedent, warrants denial or, at this stage, termination of the proceeding.

Since the Petitions were instituted on July 22, 2025, the Director issued a precedential decision vacating institution or terminating proceedings when petitioners propose different claim constructions in post-grant reviews than those advocated in district court. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 4 (Nov. 3, 2025) (Order Vacating the Decision Granting Institution, and Remanding to the Board for Further Proceedings after Sua Sponte Director Review) (quoting 83 Fed. Reg. at 51, 342-43). In view of these precedential clarifications - and the Board’s subsequent authorization of termination motions under materially similar circumstances in *Savant Technologies LLC v. Feit Electric Co., Inc.*, IPR2024-01357, Paper 56 (Feb. 6, 2026) - good cause plainly exists to permit Patent Owner to move to terminate here.

Here, Microsoft argued in the district court that the term “string separator character” is indefinite under 35 U.S.C. § 112. Microsoft’s Invalidity Contentions, dated Aug. 1, 2025. In the Petitions, however, Microsoft represented that no claim terms require construction and proceeded under the alleged plain and ordinary meaning of all claim terms. IPR2025-00253, Paper 1 at 15 (“Petitioner applies the plain and ordinary meaning of all claim terms below.”); IPR2025-00254, Paper 1 at 11 (same); IPR2025-00255, Paper 1 at 12 (same).

Microsoft also advocated different claim constructions in district court for other terms that appear in every claim of the challenged U.S. Patent Nos. 7,370,035, 9,633,139, and 10,552,490, as shown in the table below:

Term	Microsoft’s proposed district court construction
“identified one or more documents that are included in each of the first and second groups of documents” (‘035 patent, claims 1 and 10)	“identified one or more documents as a result of three distinct processes: first identifying a first group of documents, second identifying a second group of documents, and third identifying one or more documents found in each of the first two groups.”
“identifying one or more documents included in both the first one or more documents and the second one or more documents” (‘139 patent, claims 1 and 23)	“identifying one or more documents as a result of three distinct processes: first identifying a first one or more documents, second identifying a second one or more documents, and third identifying one or more documents found in each of the first one or more documents and the second one or more documents.”
“non-adjacent in at least one of the identified documents” (‘139 patent, claims 1 and 23)	Plain and ordinary meaning, which is “non-adjacent within the content of at least one of the identified documents.”
“identifying any of the plurality of files included in both the first one or more of the plurality of files and the second one or more of the plurality of files” (‘490 patent, claim 1)	“identifying any of the plurality of files as a result of three distinct processes: first identifying a first one or more of the plurality of files, second identifying a second one or more of the plurality of files, and third identifying any of the plurality of files included in both the first one or more of the plurality of files and the second one or more of the plurality of files.”
“non-adjacent in at least one of the matching files” (‘490 patent, claim 1)	Plain and ordinary meaning, which is “non-adjacent within the content of at least one of the identified documents.”

See *X1 Discovery, Inc. v. Microsoft Corporation*, Case No. 8:23-cv-02415-GW-JDE, Dkt. 86 (Joint Claim Construction Statement).

The Petitions are silent as to Microsoft's narrower district court constructions and its indefiniteness arguments. They do not identify the divergent positions, nor do they provide any explanation for why alternative constructions would be warranted before the Board. That omission is dispositive under *Revvo*. The procedural requirement applies at the time of filing the Petition; it is not dependent on whether Patent Owner raised the issue earlier. Further, contrary to Petitioner's assertion, the precedential *Revvo* decision does mark a change in policy, requiring Petitioner to justify in the Petition any inconsistent claim construction positions. Petitioner here did not do so.

Further, the Board recently granted a similar patent owner request for authorization to file a motion to terminate based on inconsistent claim constructions in *Savant Techs. LLC v. Feit Electric Co., Inc.*, IPR2024-01357, Paper 56 (Feb. 6, 2026). As in *Savant*, the inconsistency here concerns terms that appear in every challenged claim and directly infects the institution decision. The Director has emphasized that the Board's claim construction rules are designed to minimize inconsistent outcomes and prevent forum hedging. *Revvo Techs.*, Paper 20 at 4.

In light of the Board's decisions in *Revvo* and *Savant*, good cause exists for allowing Patent Owner to move to terminate. Because Microsoft did not identify or explain its divergent constructions and indefiniteness arguments in the Petitions, the institution decisions rest on a procedurally deficient foundation. Authorization to file a motion to terminate is therefore warranted so that the Board may address this threshold defect consistent with Director precedent.

After Patent Owner notified Petitioner about ~~on~~ this proposed motion, Petitioner's counsel in the district court litigation purported to "clarif[y]" its district court positions by withdrawing its indefiniteness defense for "string separator character" and inserting the words "plain and ordinary meaning" for the "identified" terms in the table above. But the district court case is stayed (at Petitioner's request) and Petitioner cannot do anything during the stay to "clarify" or otherwise modify the positions it has already taken. Furthermore, even after inserting "plain and ordinary" into its "identified" terms, Petitioner is still taking different claim construction in the district court and its Petition as evidenced by the fact that the Petition never discusses whether any prior art discloses or renders obvious the "three distinct processes" that are required by the claim element under Petitioner's district court construction. As to Petitioner's purported withdrawal of indefiniteness, Patent Owner expressly asked Petitioner during claim construction, before the stay, whether it was withdrawing its indefiniteness position as to a different term. Petitioner declined to do so and instead stated that it would not raise indefiniteness "at this stage" (i.e., during claim construction). That response makes clear that Petitioner was reserving indefiniteness arguments for later in the district court proceedings. Having expressly preserved indefiniteness as to one term for a later stage, it is reasonable to infer that Petitioner likewise intended to preserve indefiniteness as to the "string separator" term—an issue it did not raise at claim construction but could assert later in the case. Moreover, the fact that Petitioner's inconsistent positions in the district court came after the Petition was filed does not excuse Petitioner's decision to proceed under different constructions in the two forums and its failure to explain that decision to the Board.

Patent Owner respectfully requests authorization to file Motions to Terminate for Failure to Disclose Contradictory Claim Construction Positions Taken in District Court limited to 10 pages within five business days of the Board's approval of this request. This brief would explain the different claim construction positions that Petitioner has taken and their relevance to the institution decision. To ensure fairness, Patent Owner would not oppose Petitioner submitting a responsive brief of equal length within five business days of Patent Owner's submission.

Petitioner's Position

Even though the Board already denied Patent Owner's request to present its inconsistent claim construction theory (see EX3102 in IPR2025-00253, -00254, and -00255), Patent Owner attempts to present this belated theory again, this time adding a new and even more belated theory based on Microsoft's Preliminary Invalidity Contentions. This renewed request should be denied for the same reasons as Patent Owner's earlier request.

Patent Owner's request should be denied because there are no inconsistent claim construction positions. As to Patent Owner's new indefiniteness argument, Microsoft preliminarily identified "string separator character" in "Defendant Microsoft's **Preliminary** Invalidity Contentions" as a potentially indefinite term in the district court litigation but did not include the term in the joint claim construction statement in that litigation, indicating it does not maintain any indefiniteness argument on that term. Microsoft has also confirmed in correspondence to X1 that it withdrew the indefiniteness argument in district court. Patent Owner's allegation that Microsoft declined to withdraw this indefiniteness position relates to a different term in different patents that does not appear in the challenged claims. Patent Owner's repeat arguments based on the joint claim construction statement from the district court, lack merit for the same reasons as before. See EX3102. Microsoft's positions in the joint claim construction statement are consistent with the Petition, which shows how the prior art satisfies the claim terms under those constructions. For the "non-adjacent" term, the joint claim construction statement expressly states that the term should be given its plain and ordinary meaning, consistent with the IPR Petition. For the "identified"/"identifying" term, the joint claim construction statement also offers a construction that is the plain and ordinary meaning of the term, which Microsoft has confirmed in correspondence to X1 in the district court proceeding. The Petition's prior art mappings are consistent with this construction, as they show how prior art references Baeza-Yates and Wu locate files/documents containing two search strings in a three-step process: by locating documents containing the first search string, locating documents containing the second search string, and then intersecting the results. *E.g.*, IPR2024-00254, Paper 1 at 16-19, 25-26, 28-29, 51-54, 70-72.

Patent Owner's inconsistent claim construction theory is also belated, as explained in the November 20, 2025, joint email to the Board regarding Patent Owner's Request for Extension of Time to File Director Review Requests. See Ex. 3102. And in this renewed request, Patent Owner seeks to add an even more belated basis for its inconsistent claim construction theory, rooted in preliminary invalidity contentions served before the joint claim construction statement. As with the constructions offered in the joint claim construction statement, Petitioner could not have addressed this indefiniteness argument in the petitions because it arose nearly eight months after the petitions were filed, and after institution of the IPRs. Patent Owner, however, has had ample time and opportunity to raise these issues, including in its November 3 Patent Owner Responses, yet failed to do so. Patent Owner also could have raised this indefiniteness issue in its earlier request for Director Review—before Petitioner filed its Reply—but failed to do so. Moreover, this indefiniteness argument is a non-issue, as Microsoft has not raised this argument in the joint claim construction statement. Patent Owner's cited *Savant* case is inapposite because there, Petitioner Savant had argued indefiniteness in an actual *Markman* brief. *Savant Technologies LLC v. Feit Electric Co., Inc.*, IPR2024-01357, Paper 56 at 5 (citing EX2054, Savant's Opening Claim Construction Brief) (Feb. 6, 2026). Here, Microsoft has not.

Patent Owner's second bite at the apple should be denied because it lacks merit and is tardy. If Patent Owner thought that Petitioner's claim construction positions were inconsistent, it could have argued as much in the November 3 Patent Owner Responses (Paper 21 in each IPR) or promptly raised the issue with the Board in September. Patent Owner's many-month delay in raising this issue alone shows that X1's request lacks good cause.

Regards-
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Lead Counsel – Patent Owner

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