Trials@uspto.gov
571-272-7822

Paper 34
Entered: March 19, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

X1 DISCOVERY, INC.,
Patent Owner.

IPR2025-00253 (Patent 7,370,035 B2)
IPR2025-00254 (Patent 10,552,490 B2)
IPR2025-00255 (Patent 9,633,139 B2)

Before WILLIAM V. SAINDON, SCOTT C. MOORE, and LISA A. MURRAY, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge*.

ORDER
Denying Authorization to File Motion to Terminate
37 C.F.R. §§ 42.05, 42.20(b)

On February 20, 2026, Patent Owner's lead counsel sent an e-mail to the Board requesting authorization to file a motion to terminate. Ex. 3001.[1] Patent Owner explained that its proposed motion would be based on Petitioner's alleged decision to "advance[] different claim construction positions before the Board and a district court," which allegedly contravened the Director's precedential decision in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 4 (Nov. 3, 2025).

The argument that Patent Owner wishes to raise does not relate to the merits of the grounds set forth in the Petition, i.e., whether Petitioner met the statutory standard of showing "a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." *See* 35 U.S.C. § 314(a). Rather, granting the relief that Patent Owner requests would require us to invoke the Director's discretion over institution under 35 U.S.C. §§ 314(a) and/or 35 U.S.C. § 325(d).

On March 26, 2025, then-Acting Director Stewart issued a memorandum bifurcating Board proceedings. *See* Interim Process for PTAB Workload Management ("Interim Process"), 1.[2] Pursuant to that memorandum, these proceedings were "bifurcated between (i) discretionary considerations and (ii) merits and other non-

[1] For purposes of expediency, we cite to papers and exhibits filed in IPR2025-00253. Substantively similar papers and exhibits were filed in IPR2025-00254 and IPR2025-00255.
[2] Available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf

discretionary statutory considerations," with the Director deciding all discretionary institution arguments. The Acting Director subsequently decided not to invoke the Director's discretion to deny institution under either 35 U.S.C. § 314(a) or 325(d), and referred the petitions to the Board with instructions to "issu[e] a decision on institution addressing the merits and other non-discretionary considerations, as appropriate." Paper 13.

Patent Owner, apparently recognizing that its present arguments are founded on the Director's statutory discretion under 35 U.S.C. §§ 314(a) and/or 325(d), initially requested authorization to raise these arguments with the Director. *See* Ex. 3102. That request was denied on November 21, 2025. *See id*. Patent Owner then waited for more than three months before attempting to raise substantively similar arguments with us.

As Patent Owner likely recognized back in November, discretionary considerations are beyond the scope of the Acting Director's referral to the Board. Thus, this panel lacks authority to grant the relief Patent Owner seeks to request in its motion. Patent Owner's request also appears to be untimely. Even if the panel had authority to grant the relief that Patent Owner seeks—which we do not—Patent Owner should have raised this dispute with us promptly, rather than waiting for more than three months. For each of these reasons, we deny Patent Owner's request to now file a motion to terminate.

For the foregoing reasons, it is hereby ORDERED that Patent

Owner's request for authorization to file a motion to terminate is denied.

For Petitioner:

Todd Siegel
Amy Haspel
Andrew Mason
Samuel Thacker
KLARQUIST SPARKMAN, LLP
todd.siegel@klarquist.com
amy.haspel@klarquist.com
andrew.mason@klarquist.com
samuel.thacker@klarquist.com

For Patent Owner:

Lori Gordon
Christie Larochelle
Sanjeet Dutta
GOODWIN PROCTER LLP
gordon-ptab@goodwinlaw.com
clarochelle@goodwinlaw.com
sdutta@goodwinlaw.com