

From: [Director Discretionary Decision](#)
To: [Usman Khan](#); [Director Discretionary Decision](#); [Director DI](#)
Cc: [Hannah, James](#); [Kastens, Kris](#); [Price, Jeffrey H.](#); [Eng, Jeffrey](#); [Fuller, Jenna](#); [Santos, Elisa](#); [IPR42342-0155IP1](#); [David Holt](#)
Subject: RE: IPR2026-00295, -00296, -00297 (Microsoft v. ToutVirtual): Requesting Authorization to File Motion for Additional Discovery or Motion to Strike
Date: Monday, June 8, 2026 11:38:15 AM

Petitioner's request for authorization to submit a motion for additional discovery or a motion to strike is denied.

From: Usman Khan <khan@fr.com>
Sent: Thursday, June 4, 2026 11:07 PM
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Subject: IPR2026-00295, -00296, -00297 (Microsoft v. ToutVirtual): Requesting Authorization to File Motion for Additional Discovery or Motion to Strike

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Honorable Director Squires:

Petitioner (Microsoft) writes to request authorization to submit a motion for additional discovery and, in the alternative, a motion to strike. If authorized, the motion for additional discovery would be narrowly tailored to move for a pre-institution deposition of Mr. Pabari on a declaration furnished by Patent owner with its Request for Discretionary Denial of petitions advanced in the above-noted proceedings. As this testimony is offered by Patent Owner to inform a decision on institution, petitioner's due process rights are not safeguarded by routine discovery that is made available only after institution.

If granted authorization to file the motion, petitioner will use that motion to address the Garmin factors and to demonstrate how its request is consistent with 35 U.S.C. § 316(a)(5), 37 C.F.R. § 42.51(b)(2), and other cases in which pre-institution discovery was granted to allow the record to further develop on issues impacting institution. And, in the alternative, the motion will address due process concerns implicated by maintaining Mr. Pabari's testimony on the record in the absence of petitioner being granted access to question him on testimony that was offered by patent owner to inform an institution decision, given the unavailability of deposition through routine discovery until after a decision on institution is reached.

Consistent with standard practice encouraged by the Board, as reflected in *Samsung Electronics Co., Ltd., et al. v. Black Hills Media, LLC*, Cases IPR2014-00717; IPR2014-00735 (PTAB, July 10, 2014) (McNamara, APJ.) (see also email from the Board <https://ptacts.uspto.gov/ptacts/public-informations/petitions/1549987/download-documents?artifactId=rbGqtrzOuiRz72d0EE40MFZTXyQwrtXkLmLhQfAFfBUuQi7n696K0hg>), petitioner leaves to the motion its arguments on these issues.

Beginning on May 21, Petitioner and Patent Owner met and conferred several times on these issues, and Patent Owner opposes both motions. Patent Owner's response is provided below.

ToutVirtual opposes Microsoft's request to file a motion for additional discovery. Pre-institution depositions are unauthorized "as a general matter" and require "special circumstances." *T-Mobile USA, Inc. v. Traxcell Tech., LLC*, IPR2022-00669, Paper 10 at 2 (P.T.A.B. Apr. 22, 2022)("[A]lthough cross-examination of pre-institution testimony might be helpful in a few cases, as a general matter, the Office believes that its benefits will be outweighed by the greater expense to the Office and the parties, where the Board is able to reach a decision on institution based on the briefs and documents as submitted by the parties." (quoting 85 F.R. 79125)). Microsoft has not identified any instance where the Board granted a pre-institution deposition of a patent owner's fact witness or explained what "special circumstances" warrant a pre-institution deposition in this case. Aside from not meeting the "special circumstances" standard, the prejudice Microsoft alleges is illusory. Microsoft can file new evidence with its pre-authorized Opposition to ToutVirtual's Discretionary Denial Brief.

ToutVirtual also opposes Microsoft's conditional request to submit a motion to strike Mr. Pabari's declaration. ToutVirtual told Microsoft that it would make Mr. Pabari available for a deposition during the period of routine discovery or following an order granting a motion for additional discovery. The only authority Microsoft provided in support of its requested motion to strike, *1964 Ears, LLC v. Jerry Harvey Audio Holding, LLC*, IPR2016-00494, Paper 37 (P.T.A.B. Jan. 10, 2017), is inapposite because that case dealt with a witness who was not available for deposition during routine discovery. *Id.* at 2 (requesting authorization to strike the expert's declaration because the expert "was not available for deposition prior to the due date for Petitioner's Reply"). Routine discovery has not opened yet in this case, and there is no order granting the additional discovery that Microsoft now seeks.

If the Director or a panel of judges believes a call would be helpful to address this request, the parties can be available at a time of the Office's convenience.

Regards,

Usman Khan, Ph.D., J.D.

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