

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

TOUTVIRTUAL, INC.,
Patent Owner.

Case IPR2026-00297
U.S. Patent No. 12,079,667

**DECLARATION OF JAMES HANNAH IN SUPPORT OF
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

I, James Hannah, declare as follows:

1. I am a partner at the law firm of Herbert Smith Freehills Kramer (US) LLP, attorneys for Patent Owner ToutVirtual, Inc. (“Patent Owner”), in the above-captioned *inter partes* review proceeding involving Petitioner Microsoft Corporation (“Petitioner”). I provide this Declaration in support of Patent Owner’s Request for Discretionary Denial. I have personal knowledge of the facts set forth in this Declaration and, if called as a witness, could and would testify competently to such facts under oath.

2. In the co-pending litigation, *ToutVirtual, Inc. v. Microsoft Corp.*, No. 2:25-cv-00943-RWS (E.D. Tex.), Patent Owner is currently asserting infringement of Claims 1-2, 4-7, 9-13, 17-18, 20, and 22-23 of U.S. Patent No. 8,799,431 (“’431 Patent”); Claims 1-3, 6-11, 14, 16, and 20 of U.S. Patent No. 9,444,762 (“’762 Patent”); Claims 1-3, 5-6, 9-11, and 13-14 of U.S. Patent No. 10,810,050 (“’050 Patent”); Claims 1-3 and 9-14 of U.S. Patent 11,656,915 (“’915 Patent”); and Claims 1-3, 5, 7-12, and 14-19 of U.S. Patent No. 12,079,667 (“’667 Patent”).

3. The claims challenged in the ’667 Patent IPR (IPR2026-00297) are the same as those challenged in Petitioner’s March 12, 2026, invalidity contentions: Claims 1-3, 5, 7-12, and 14-19.

4. Patent Owner filed its complaint on September 8, 2025. The complaint was served on September 8, 2025, in the Eastern District of Texas and

assigned to District Judge Schroeder. Petitioner filed its IPR Petition for the '667 Patent (IPR2026-00297) on March 7, 2026.

5. The scheduled trial date in the District Court litigation is June 21, 2027. The median time to trial in the Eastern District of Texas is 24 months (approximately September 8, 2027), as shown in Exhibits 2004 and 2005. This lends credibility to the median time to trial date.

6. Discovery in the co-pending litigation is well underway as both Patent Owner and Petitioner have served and responded to multiple sets of discovery requests. Patent Owner served its preliminary infringement contentions and asserted claims on January 15, 2026, and Petitioner served its preliminary invalidity contentions on March 12, 2026. The parties served initial disclosures beginning on February 19, 2026, that identified relevant witnesses and categories of documents. Patent Owner's is expected to review the source code from May 20 to May 21.

7. There are over 450 forward citations, including Microsoft's patent applications that cite to the '667 Patent family portfolio, as the screenshot depicts below:

US12079667B2

United States

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Inventor: Vipul Pabari

Current Assignee : TOUTVIRTUAL Inc

Worldwide applications

2006 • ~~WO~~ US 2014 • US 2016 • US 2020 • US 2023 • US
2024 • US

Application US18/135,007 events ⓘ

• PTAB case IPR2026-00297 filed (Pending) ⓘ

2023-04-14 • Priority to US18/135,007

2023-04-14 • Application filed by TOUTVIRTUAL Inc

2023-08-10 • Publication of US20230251911A1

2024-09-03 • Publication of US12079667B2

2024-09-03 • Application granted

Status • Active

2026-08-10 • Anticipated expiration

Show all events ▾

Info: Patent citations (22), Cited by (456), Legal events, Similar documents, Priority and Related Applications

External links: USPTO, USPTO PatentCenter, USPTO Assignment, Espacenet, Global Dossier, Discuss

This screenshot was captured from Google Patents at the following link:

<https://patents.google.com/patent/US12079667B2/>.

8. As the table below shows, 17 Microsoft patent applications referenced the '667 Patent family portfolio during prosecution, five of which had the portfolio applied in office action rejections:

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Patent Owner, ToutVirtual - Ex. 2003, p. 4

No.	MSFT's Patent App./Patent	Citation to '667 Patent Family Portfolio	Citations in Prosecution History
1	US20090006503 A1	'431 Pat. Pub.	Non-Final Rejection, dated Oct. 1, 2009
	US9870263 B2	'431 Pat. Pub.	Non-Final Rejection, dated Oct. 1, 2009
2	US20090199175 A1	'431 Pat. Pub.	Non-Final Rejection, dated Aug. 18, 2011
3	US20090265707 A1	'431 Pat. Pub.	Cited in IDS, dated Apr. 21, 2008
4	US20100312809 A1	'431 Pat. Pub.	Cited in Notice of References, dated April 29, 2015
	US10127295 B2	'431 Pat. Pub.	Cited in Notice of References, dated April 29, 2015
5	US20100325727 A1	'431 Pat. Pub.	Cited in Notice of References, dated Oct. 1, 2012
	US8955108 B2	'431 Pat. Pub.	Cited in Notice of References, dated Oct. 1, 2012
6	US8751656 B2	'431 Pat. Pub.	Cited in IDS, dated Aug. 26, 2013
7	US8799453 B2	'431 Pat. Pub.	Cited in IDS, dated Oct. 24, 2013
8	US20120102199 A1	'431 Pat. Pub.	Non-Final Rejection, dated Aug. 16, 2013
	US9075661 B2	'431 Pat. Pub.	Non-Final Rejection, dated Aug. 16, 2013
9	US9721030 B2	'431 Pat. Pub.	Cited in IDS, dated Aug. 27, 2013
10	US9015177 B2	'431 Pat. Pub.	Cited in IDS, dated Sept. 30, 2013
11	US9043370 B2	'431 Pat. Pub.	Cited in IDS, dated Nov. 15, 2013
12	US20150172106 A1	'762 Pat. Pub.	Non-Final Rejection, dated April 6, 2018
13	US20150317187 A1	'431 Pat. Pub.	Cited in IDS, dated Aug. 6, 2015
14	US10467315 B2	'431 Pat. Pub.	Cited in IDS, dated Nov. 6, 2017

No.	MSFT's Patent App./Patent	Citation to '667 Patent Family Portfolio	Citations in Prosecution History
15	US10565021 B2	'762 Pat. Pub. & '762 Patent	Cited in IDS, dated Oct. 17, 2019
16	US10656930 B2	'431 Pat. Pub.	Cited in IDS, dated Jan. 14, 2020
17	US20200036613 A1	'431 Pat. Pub.	Non-Final Rejection, dated Aug. 13, 2020
	US10992559 B2	'431 Pat. Pub.	Non-Final Rejection, dated Aug. 13, 2020

To the best of my knowledge, the above referenced table represents a true and accurate description of the forward citations to the '667 Patent family portfolio during the prosecution of Microsoft's patent applications.

I declare that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code. Executed on May 18, 2026, in Redwood Shores, CA.

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner