

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

SURFCAST, INC.
Patent Owner.

Case IPR2014-00271
Patent 6,724,403

Before JONI Y. CHANG and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On April 16, 2014, a conference call was held between respective counsel for Petitioner and Patent Owner, and Judges Chang and Clements. The stated purpose of the call was to discuss Petitioner's request for authorization to withdraw its Motion for Joinder.

BACKGROUND

On November 19, 2013, in IPR2013-00292, the Board denied *inter partes* review of, *inter alia*, (1) claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43, and 46-50 of U.S. Patent No. 6,724,403 ("the '403 patent") as unpatentable under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 6,118,493 ("Duhault I"); and (2) claims 1, 17, 20, 22, 25, and 28 as unpatentable under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,819,284 ("Farber"). IPR2013-00292, Paper 19, at 38-40.

On December 19, 2013, in IPR2013-00292, Petitioner filed a Request for Rehearing in IPR2013-00292, arguing that the Board erred in denying as redundant the ground of unpatentability based on Duhault I and the ground of unpatentability based on Farber. IPR2013-00292, Paper 23.

Also on December 19, 2013, Petitioner filed a new Petition (Paper 1) in the instant proceeding seeking *inter partes* review based on the same grounds of unpatentability on which it sought rehearing: (1) claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43, and 46-50 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by Duhault I; and (2) claims 1, 17, 20, 22, 25 and 28 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by Farber. Petitioner also filed a Motion for Joinder with IPR2013-00292, which also involves the '403 patent. Paper 2.

On January 9, 2014, Petitioner filed a corrected Petition. Paper 8.

On January 21, 2014, Patent Owner filed an Opposition to Petitioner's Motion for Joinder. Paper 14.

On January 29, 2014, in IPR2013-00292, the Board issued its Decision on Request for Rehearing. IPR2013-00292, Paper 29, "Decision Request for Rehearing." In its Decision, the Board denied Petitioner's Request for Rehearing.

On February 21, 2014, Petitioner filed a Reply in support of its Motion for Joinder. Paper 16.

On April 7, 2014, Patent Owner filed its Preliminary Response. Paper 17.

REQUEST FOR AUTHORIZATION TO WITHDRAW
MOTION FOR JOINDER

According to Petitioner, Patent Owner, in its Preliminary Response, proposes joining the instant proceeding with IPR2013-00292 and extending the schedule of IPR2013-00292 by approximately five months. Petitioner explained that it wants IPR2013-00292 to proceed expeditiously to a final outcome as currently scheduled, it believes that the merits of the instant petition have become a sideshow, and, therefore, it seeks guidance on whether it is appropriate to withdraw the Motion for Joinder. Petitioner believes authorization to withdraw the Motion for Joinder is warranted because (1) Patent Owner has taken a different stance in its Preliminary Response in the instant proceeding than it did in its Preliminary Response in IPR2013-00292, which is an unwarranted complication that raises estoppel questions; and (2) joining the proceedings would delay the schedule for trial in IPR2013-00292.

Patent Owner acknowledged that it opposed Petitioner's Motion for Joinder in its Opposition to Joinder (Paper 14), filed January 21, 2014, but argued that its basis for opposing at that time was that it did not feel that it was appropriate to enlarge the scope of the IPR2013-00292. After reading the Board's Decision on Request for Rehearing in IPR2013-00292, however, Patent Owner seeks an opportunity to have those issues addressed because otherwise, it believes, there will be confusion about the Board's claim construction of the "simultaneously updating" limitation. Patent Owner added that it is unaware of any procedural rules that permit a party to withdraw a motion; otherwise, it would have withdrawn its Opposition to Joinder (Paper 14). Patent Owner also argued that, if Petitioner is allowed to withdraw its Motion for Joinder, the Petition will then be untimely filed and must be denied. In that case, Patent Owner would be denied the opportunity to further address the Board's construction of "simultaneously updating" as applied to Duhault I. According to Patent Owner, it does not seek a new construction of that term.

Upon consideration of the parties' arguments, we determined that Petitioner has not shown good cause for withdrawing the Motion for Joinder after briefing is complete. The Board reminded the parties that even though we do not authorize Petitioner to withdraw the Motion for Joinder, the Board has yet to decide whether to grant the Motion for Joinder.

ORDER

It is ORDERED that Petitioner's request for authorization to withdraw its Motion for Joinder is DENIED.

IPR2014-00271
Patent 6,724,403

For PETITIONER:

Jeffrey P. Kushan, Esq.
Joseph Micallef, Esq.
JKushan@sidley.com
JMicallef@sidley.com

For PATENT OWNER

Richard G. A. Bone, Esq.
James M. Heintz, Esq.
RBone@VLPLawGroup.com
Patents@VLPLawGroup.com
292_IPR_DLAteam@dlapiper.com