

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

EDGE NETWORKING SYSTEMS, LLC,  
Patent Owner.

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IPR2025-00618  
Patent 11,695,823 B1

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Before NABEEL U. KHAN, STACY B. MARGOLIES, and  
JASON M. REPKO, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

ORDER  
Granting Stay of Reexamination  
*35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)*

## I. INTRODUCTION

With our authorization, Petitioner filed a Motion to Stay *Ex Parte* Reexamination Control No. 90/019,948 (“the ’948 Reexam”) of U.S. Patent No. 11,695,823 (“the ’823 patent”) in view of the presently instituted *inter partes* review of the same patent. Paper 16 (“Motion” or “Mot.”). Patent Owner does not oppose Petitioner’s Motion. Mot. 1.

The Board may enter an order staying a reexamination proceeding. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a) “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654, 16,656 (Apr. 22, 2019) (“Notice”). “Good cause for staying a case may exist if, for example, an on-going AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.” *Id.* The Notice outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. *Id.* at 16,657. We analyze these factors below.

## II. ANALYSIS

### A. *Whether the Claims Challenged in the AIA Proceeding are the Same as or Depend Directly or Indirectly from Claims at Issue in the Reexamination*

The Board instituted *inter partes* review of challenged claims 1–5, 7, 8, 12–15, 18, and 19 in the instant proceeding. Paper 14. The ’948 Reexam involves claims 1–4, 8, 15, and 19. Mot. 2 (citing Ex. 1084, 445–476). Every claim being reexamined in the ’948 Reexam is challenged in this IPR. This factor, therefore, weighs in favor of a stay.

*B. Whether the Same Grounds of Unpatentability or the Same Prior Art are at Issue in Both the IPR and the Reexamination*

Petitioner acknowledges that there is no overlap in the prior art references relied upon in this proceeding and in the '948 Reexam. Mot. 3 (citing Ex. 1084, 15–16). This factor, therefore, weighs against a stay.

*C. Whether Simultaneously Conducting the Reexamination and IPRs Will Duplicate Efforts Within the Office*

Petitioner argues that because all of the claims at issue in the '948 Reexam are at issue in this proceeding, allowing the '948 Reexam to proceed would duplicate efforts within the Office. Mot. 3. We note that both the '948 Reexam and this IPR are in their early stages and it would be speculative at this stage to consider whether there will be an overlap in any specific issues between the two. Still, because all claims being reexamined are also challenged in this IPR, we agree that allowing the '948 Reexam to proceed would duplicate at least some efforts with those in this IPR. This factor, therefore, weighs in favor of a stay.

*D. Whether the Reexamination Could Result in Inconsistent Results Between Proceedings*

Petitioner argues that because of the overlap in claims, allowing the '948 Reexam to go forward could lead to inconsistent results if, for example, Patent Owner proposes amendments in the '948 Reexam that change the scope of the claims while the IPR proceeds. Mot. 4. We agree that because of the overlap in challenged claims there is a likelihood of inconsistent results between the two proceedings. This factor weighs in favor of a stay.

*E. Whether Amending Claim Scope in One Proceeding Would Affect the Claim Scope in Another Proceeding*

Petitioner makes the same argument here as it did for the prior factor, emphasizing that because of the overlap in claims, amending the claims in

the '948 Reexam would change their scope in this IPR. Mot. 4–5. Because of the degree of overlap in the claims at issue in each proceeding, an amendment in the '948 Reexam would certainly affect the scope of the claims challenged in this IPR, and an amendment in this IPR would very likely affect the scope of the claims being reexamined in the '948 Reexam. This factor, therefore, weighs in favor of a stay.

*F. The Respective Timeline and Stage of Each Proceeding*

This inter partes review is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). The '948 Reexam is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305. We instituted *inter partes* review of the challenged claims in this proceeding on September 30, 2025 and a final written decision is expected on or before September 30, 2026. Mot. 5; Paper 14. In the '948 Reexam, a first Office Action has only recently been issued. Ex. 3002. Both proceedings are in their early stages but the IPR will likely proceed to its conclusion earlier than the '948 Reexam. This factor, therefore, weighs in favor of a stay.

*G. Whether a Decision in One Proceeding Would Likely Simplify Issues in the concurrent parallel Office proceeding or Render it Moot*

Petitioner argues that because all of the claims being reexamined in the '948 Reexam are challenged in this IPR, a final written decision will likely simplify or render moot the '948 Reexam. Mot. 6–7. We agree. All of the claims at issue in the '948 Reexam are at issue in this IPR. A final written decision here could render moot the '948 Reexam. Some dependent claims being challenged in this IPR are, however, not at issue in the '948 Reexam. Thus, a decision in the '948 Reexam could simplify issues in this IPR but may not render it moot. This consideration, in addition to the

current stages of the proceedings and the statutory deadline for this IPR, weigh in favor of a stay.

### III. CONCLUSION

After considering all the factors, we find good cause exists for staying the '948 Reexam pending resolution of this *inter partes* review.

### IV. ORDER

For the foregoing reasons, it is

ORDERED that that Reexamination Control No. 90/019,948 is stayed pending the termination or completion of IPR2025-00618;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,948 are tolled for the duration of the stay, and no further papers shall be filed without authorization in the reexamination while this stay remains in place; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting time periods for responding to any outstanding papers in Reexamination Control No. 90/019,948.

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FOR PETITIONER:

Christopher Tyson  
John Baird  
Glenn Richeson  
Patrick McPherson  
DUANE MORRIS LLP  
cjtyson@duanemorris.com  
jmbaird@duanemorris.com  
gdricheson@duanemorris.com  
pdmcpherson@duanemorris.com

FOR PATENT OWNER:

Brandon Theiss  
Daniel Golub  
VOLPE KOENIG  
btheiss@vklaw.com  
dgolub@vklaw.com

David Hecht  
HECHT PARTNERS LLP  
dhecht@hechtpartners.com