

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

EDGE NETWORKING SYSTEMS, LLC,
Patent Owner.

Case No. IPR2025-00618
Patent No. 11,695,823

**PETITIONER’S UNOPPOSED MOTION TO STAY CONCURRENT
EX PARTE REEXAMINATION PROCEEDING PURSUANT TO
35 U.S.C. § 315(d), 37 C.F.R. § 42.3(a) AND 37 C.F.R. § 42.122(a)**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. GOOD CAUSE EXISTS TO STAY THE ’948 REEXAM.....	1
A. Background of the Parallel Office Proceedings Involving the ’823 Patent.....	1
B. Notice Factor 1: Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding	2
C. Notice Factor 2: Whether the same grounds of unpatentability or the same prior art are at issue in both the IPRs and the Reexamination	3
D. Notice Factor 3: Whether the concurrent parallel Office proceeding will duplicate efforts within the Office	3
E. Notice Factor 4: Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding).....	4
F. Notice Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding	4
G. Notice Factor 6: The respective timeline and stage of each proceeding	5
H. Notice Factor 7: The statutory deadlines of the respective proceedings.....	6
I. Notice Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.....	6

*Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination
Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)*

III. CONCLUSION7

PETITIONER’S EXHIBIT LIST

<i>Exhibit #</i>	<i>Description</i>
1001	U.S. Patent No. 11,695,823 (the “’823 Patent”).
1002	Prosecution history of the ’823 Patent (“’823 File History”).
1003	Declaration of Petitioner’s Expert Dr. Erez Zadok (“Zadok”).
1004	U.S. Patent No. 6,496,575 to Vasell (“Vasell Patent”).
1005	File history of the parent patent to the ’823 Patent, U.S. Patent No. 9,843,624 (the “’624 Patent”).
1006	File history of the patent from which the ’823 Patent was filed as a continuation application, U.S. Patent No. 10,893,095 (the “’095 Patent”).
1007	File history of the other patent from which the ’823 Patent claims priority in a chain of continuation applications, U.S. Patent No. 10,686,871 (the “’871 Patent”).
1008	Excerpts from A. de Castro Alves, “OSGi in Depth”, Manning Publications Company, 2012 (“Alves”).
1009	Excerpts from R. Hall, et al., “OSGi in Action - Creating Modular Applications in Java”, Manning Publications Company, April 2011 (“Hall”).
1010	J. E. Kim, et al., “Seamless Integration of Heterogeneous Devices and Access Control in Smart Homes,” 2012 Eighth International Conference on Intelligent Environments, Guanajuato, Mexico, June 26-29, 2012, pp. 206-213 (“Kim”).
1011	J. S. Rellermeyer and S. Bagchi, “Dependability as a cloud service - a modular approach,” IEEE/IFIP International Conference on Dependable Systems and Networks Workshops (DSN 2012), Boston, MA, USA, 2012, pp. 1-6 (“Rellermeyer”).
1012	S. Kächele, et al., “Component-based scalability for cloud applications”, Proceedings of the 3 rd International Workshop on Cloud Data and Platforms (CloudDP ‘13), April 14, 2013, Prague, Czech Republic, 19–24 (“Kächele”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1013	OSGi Alliance, “About the OSGi Service Platform”, Technical Whitepaper, Revision 4.1, November 11, 2005, archived on November 30, 2005 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20051130032628/http://www.osgi.org/documents/collateral/TechnicalWhitePaper2005osgi-spooverview.pdf (“OSGi 2005 Whitepaper”).
1014	Declaration of June A. Munford.
1015	U.S. Provisional Patent Application No. 60/088,437, filed on June 8, 1998, claimed as a priority application in, and incorporated by reference into, EX1004 (“1 st Vasell Provisional”) (collectively, with EX1004 and EX1016, “Vasell”).
1016	U.S. Provisional Patent Application No. 60/123,971, filed on March 12, 1999, claimed as a priority application in, and incorporated by reference into, EX1004 (“2 nd Vasell Provisional”) (collectively, with EX1004 and EX1015, “Vasell”), which includes a copy of the article published as Idermark, T., Lilliestråle, M., & Vasell, J., “Ericsson’s e-box system—An electronic services enabler”, Ericsson Review, (1), 1999, 38-44, as confirmed by Ericsson’s website archived, for example, on March 3, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000303195310/http://www.ericsson.se/review/issues.taf and, for example, on February 16, 2003 and November 27, 2004 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20030216191220/http://www.ericsson.com/about/publications/review/1999_01/23.shtml and https://web.archive.org/web/20041127035720/http://www.ericsson.com/about/publications/review/1999_01/files/1999015.pdf respectively.
1017	“About Gatespace”, Gatespace AB website, archived on January 6, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000106145021/http://www.gatespace.com/ (“About Gatespace 2000”).
1018	“Carlstedt Research & Technology Forms New Company for Developing Software for ‘The Intelligent Home’ in Cooperation with Ericsson”, September 30, 1999, Gatespace AB website, archived on February 12, 2001 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20010212054449/http://www.gatespace.com/news/archive/19990930_en_v3.shtml (“Gatespace Formation Press Release”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1019	“Ericsson e-services is a part of the Open Services Gateway Initiative (OSGI)”, Ericsson e-services website, archived on February 29, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000229111550/http://www.ericsson.com:80/wireless/products/ebox/links/osgi.shtml (“Ericsson E-Services WebPage”).
1020	“Fifteen industry leaders to create standard for bringing Internet-based services to the networked home”, March 1, 1999, Ericsson e-services website, archived on May 28, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000528223608/http://www.ericsson.com/wireless/products/ebox/news/990301.shtml (“OSGi Announcement on Ericsson E-Services WebPage”).
1021	“People”, Carlstedt Research & Technology AB website, archived on January 6, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000106204945/http://www.crt.se/about/people.en.html (“CR&T People 2000”).
1022	“Open Services Gateway Initiative: Charter”, OSGi website, archived on April 19, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000419181219/http://www.osgi.org/about/charter.html (“OSGi Charter 2000”).
1023	“Open Services Gateway Initiative: Officers”, OSGi website, archived on April 14, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000414133426/http://www.osgi.org/about/officers.html (“OSGi Officers 2000”).
1024	“Open Services Gateway Initiative Elects New Leadership”, Home Toys Inc. website, May 23, 2001, archived on July 8, 2001 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20010708123711/http://www.hometoys.com/releases/jun01/osgi01.htm (“OSGi Leadership 2001”).
1025	“Management Team”, Gatespace AB website, archived on February 8, 2002 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20020208031748/http://www.gatespace.com/company/management.shtml (“Gatespace Management 2002”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1026	“About Us: Background”, Gatespace AB website, archived on February 6, 2002 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20020206205742/http://www.gatespace.com/company/ (“About Gatespace 2002”).
1027	“About Makewave: History in Making”, Makewave AB website, archived on August 16, 2007 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20070816163615/http://www.makewave.com/site.en/about/history.shtml (“About Makewave 2007”).
1028	The OSGi Alliance, “OSGi Service Platform Enterprise Specification”, Release 4, Version 4.2, March 2010 (“OSGi Enterprise Specification”).
1029	T. Forst, “Cisco Application eXtension Platform – OSGi Add-on as universal Middleware for Your Applications”, May 2008, AutomatedBuildings.com, archived on May 17, 2008 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20080517111602/www.automatedbuildings.com/news/may08/articles/prosyst/080427034829prosyst.htm (“Forst”).
1030	U.S. Patent Publication No. 2013/0086147 to Kashyap, filed October 3, 2011, published April 4, 2013 (“Kashyap”).
1031	Excerpts from A.S. Tanenbaum, “Modern Operating Systems”, Prentice Hall, 3 rd edition, 2008 (“Tanenbaum 2008”).
1032	Excerpts from A.S. Tanenbaum, “Computer Networks”, Prentice Hall, 3 rd edition, 1996 (“Tanenbaum 1996”).
1033	Excerpts from D. Downing, et al., “Dictionary of Computer and Internet Terms”, Barron’s Educational Series, Inc., 11 th edition, 2013 (“Downing”).
1034	Excerpts from E. Cole, et al., “Network Security Bible”, Wiley Publishing, Inc., 2 nd edition, 2009 (“Cole”).
1035	Curriculum Vitae (CV) of Petitioner’s Expert Dr. Erez Zadok.
1036	S. Soltesz, et al., “Container-based Operating System Virtualization: A Scalable, High Performance Alternative to Hypervisors”, In Proceedings of the 2 nd ACM SIGOPS/EuroSys European Conference on Computer Systems (EuroSys ‘07), March 21-23, 2007, Lisbon, Portugal, pp. 275-287, 2007 (“Soltesz”).

*Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination
Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)*

<i>Exhibit #</i>	<i>Description</i>
1037	<i>Intentionally Left Blank</i>
1038	<i>Intentionally Left Blank</i>
1039	Li, et al., “ExpoNet: A Flexible Platform for Concurrent Experiments on Programmable Infrastructure”, 2011 IEEE Global Telecommunications Conference - GLOBECOM 2011, Houston, TX, USA, 2011, pp. 1-5 (“Li”).
1040	<i>Intentionally Left Blank</i>
1041	P. Kriens, “The Bundle Repository”, OSGi Alliance Blog, April 7, 2006, archived on May 4, 2006 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20060504203641/http://www.osgi.org/blog/2006/04/bundle-repository.html (“Kriens OSGi Blog”).
1042	“Knoplerfish Pro Premium” and “Knoplerfish Pro Enterprise” Data Sheets, Makewave AB, 2010, respectively archived on February 20, 2011 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20110220123804/http://www.makewave.com:80/resources/docs/datasheets/MD-042-A1-knoplerfish_pro_premium_osgi.pdf and https://web.archive.org/web/20110220123819/http://www.makewave.com:80/resources/docs/datasheets/MD-047-A1-knoplerfish_pro_enterprise_osgi.pdf (“Knoplerfish”).
1043	R. Kawashima, “vNFC: A Virtual Networking Function Container for SDN-enabled Virtual Networks”, 2012 Second Symposium on Network Cloud Computing and Applications, London, UK, 2012, pp. 124-129 (“Kawashima”).
1044	Excerpts from A.S. Tanenbaum, “Modern Operating Systems”, Prentice Hall, 2 nd edition, 2001 (“Tanenbaum 2001”).
1045	Excerpts from S. Garfinkel, et al., “Web Security & Commerce”, O’Reilly & Associates, 1997 (“Garfinkel”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1046	<p>Oasis Standard Specification, “Web Services Security: SOAP Message Security 1.1 (WS-Security 2004), February 1, 2006, archived on February 6, 2007 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20070206143722/http://www.oasis-open.org/committees/download.php/16790/wss-v1.1-spec-os-soapmessagesecurity.pdf, and accessible from OASIS Web Services Security (WSS) Technical Committee web page, as archived on December 5, 2006 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20061205032600/http://oasis-open.org/committees/tc_home.php?wg_abbrev=wss#technical (“Oasis - SOAP Security”).</p>
1047	<p>“Web Service Security Cheat Sheet”, The Open Web Application Security Project (OWASP), archived on June 12, 2012 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20120612205800/https://www.owasp.org/index.php/Web_Service_Security_Cheat_Sheet, and accessible from OWASP’s (the free and open software security community) web pages, as archived on June 10, 2012 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20120610001928/https://www.owasp.org/index.php/Main_Page, and as archived on June 10, 2012 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20120610091415/https://www.owasp.org/index.php/Cheat_Sheets (“OWASP - WSS Security”).</p>
1048	<p>“REST Security Cheat Sheet”, The Open Web Application Security Project (OWASP), archived on January 15, 2013 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20130115190935/https://www.owasp.org/index.php/REST_Security_Cheat_Sheet, and accessible from OWASP’s (the free and open software security community) web pages, as archived on January 4, 2013 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20130104230717/https://www.owasp.org/index.php/Main_Page, and as archived on January 15, 2013 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20130115215253/https://www.owasp.org/index.php/Cheat_Sheets (“OWASP – REST Security”).</p>

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1049	<i>Intentionally Left Blank</i>
1050	The Open Services Gateway Initiative, “Specification Overview”, Version 1.0, January 2000, archived on August 31, 2000 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20000831061202/http://www.osgi.org/about/specoverview.pdf (“OSGi 2000 Overview”).
1051	R. Hall, “Oscar Bundle Repository”, archived on June 30, 2004 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20040630163519/http://oscar-osgi.sourceforge.net:80/ (“OBR 2004”).
1052	Excerpts from B. Sosinsky, “Cloud Computing Bible”, Wiley Publishing, Inc., 2011 (“Sosinsky”).
1053	“Java Secure Socket Extension (JSSE) Reference Guide for Java Platform Standard Edition 7”, Oracle Java SE Documentation, archived on November 25, 2011 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20111125044243/http://docs.oracle.com/javase/7/docs/technotes/guides/security/jsse/JSSERefGuide.html (“JSSE Guide”).
1054	“Java™ Remote Method Invocation API (Java RMI)”, Oracle Java SE Documentation, archived on November 27, 2011 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20111127072151/http://docs.oracle.com/javase/7/docs/technotes/guides/rmi/index.html (“Java RMI Overview”).
1055	“Using Custom Socket Factories with Java RMI”, Oracle Java SE Documentation, archived on April 3, 2012 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20120403095031/https://docs.oracle.com/javase/7/docs/technotes/guides/rmi/socketfactory/index.html (“Java RMI Socket Overview”).
1056	“Using Java™ RMI with SSL”, Oracle Java SE Documentation, archived on July 3, 2012 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20120703221253/https://docs.oracle.com/javase/7/docs/technotes/guides/rmi/socketfactory/SSLInfo.html (“Java RMI SSL Overview”).
1057	Microsoft Computer Dictionary, 3rd ed., 1997, excerpts (“Microsoft Computer Dictionary”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

Exhibit #	Description
1058	Usenix Jails in FreeBSD for Fun and Profit, Paco Hope, USENIX ;login: The Magazine of Usenix & Sage, vol. 27, number 3, June 2002 (“Hope”), archived on March 16, 2003 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20030316225604/http://www.usenix.org/publications/login/2002-06/pdfs/hope.pdf .
1059	Excerpts from Silberschatz et al., Operating System Concepts (8 th Ed. 2009) (“Silberschatz 2009”).
1060	Excerpts from Silberschatz et al., Operating System Concepts (9 th Ed. 2012) (“Silberschatz 2012”).
1061	Excerpts from McKusick and Neville-Neil, “The Design and Implementation of the FreeBSD Operating System” (2005) (“McKusick”).
1062	Excerpts from Benevenuti, “Understanding Linux Network Internals” (2006) (“Benevenuti”).
1063	Excerpts from Stallings, “Operating Systems Internals and Design Principles” (7 th ed. 2012) (“Stallings”).
1064	“apache_1.3.19.tar.gz.md5” Hash File, Apache Software Foundation, archived on June 28, 2001 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20010628043950/http://www.apache.org/dist/httpd/apache_1.3.19.tar.gz.md5 .
1065	“apache_1.3.19.tar.gz.asc” Signature File, Apache Software Foundation, archived on June 28, 2001 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20010628043146/apache.org/dist/httpd/apache_1.3.19.tar.gz.asc .
1066	“Apache Archive Distribution Directory”, Apache Software Foundation, available at https://archive.apache.org/dist/httpd (“Apache Archive”).
1067	U.S. Department of Commerce, FIPS PUB 186-2, Digital Signature Standard (DSS) (January 27, 2000) (“DSS FIPS PUB”).
1068	J. Preshing, “Hash Collision Probabilities”, Preshing on Programming, May 4, 2011, archived on September 27, 2011 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20110927200414/preshing.com/20110504/hash-collision-probabilities (“Preshing Hash Collision Probabilities”).

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

Exhibit #	Description
1069	“Avalanche Effect”, Wikipedia, archived on April 30, 2010 at Internet Archive’s Wayback Machine at https://web.archive.org/web/20100430122132/https://en.wikipedia.org/wiki/Avalanche_effect (“Wikipedia Avalanche Effect”).
1070	Plaintiff Edge Networking Systems, LLC’s Opening Claim Construction Brief, filed as Document No. 31, on December 17, 2024, in Case No. 1:24-cv-00215-DAE, captioned as <i>Edge Networking Systems, LLC v. Microsoft Corporation</i> (W.D. Texas).
1071	Defendant Microsoft Corporation’s Responsive Claim Construction Brief, filed as Document No. 32, on January 17, 2025, in Case No. 1:24-cv-00215-DAE, captioned as <i>Edge Networking Systems, LLC v. Microsoft Corporation</i> (W.D. Texas).
1072	Scheduling Order, filed as Document No. 27, on September 4, 2024, in Case No. 1:24-cv-00215-DAE, captioned as <i>Edge Networking Systems, LLC v. Microsoft Corporation</i> (W.D. Texas).
1073	U.S. Patent Publication No. 2014/0241158 (“Anthony”).
1074	Excerpt from Zenious et al., BIODESIGN; THE PROCESS OF INNOVATING MEDICAL TECHNOLOGIES (EX2010 in <i>iRhythm Technologies Inc. v. Welch Allyn Inc.</i> , IPR2025-00363).
1075	March 26, 2025 Email from Petitioner’s Counsel to Patent Owner’s Counsel Containing <i>Sotera</i> Stipulation
1076	April 2025 Emails Between Petitioner’s Counsel and the Board Regarding Petitioner’s Request to File the <i>Sotera</i> Stipulation in the IPRs
1077	Order Setting <i>Markman</i> Hearing for October 7, 2025, filed as Document No. 41, on June 11, 2025, in Case No. 1:24-cv-00215-DAE, captioned as <i>Edge Networking Systems, LLC v. Microsoft Corporation</i> (W.D. Texas).
1078	Amended Scheduling Order, filed as Document No. 43, on June 27, 2025, in Case No. 1:24-cv-00215-DAE, captioned as <i>Edge Networking Systems, LLC v. Microsoft Corporation</i> (W.D. Texas).
1079	Patent Owner’s Certificate of Formation dated March 27, 2023
1080	Inventor Assignment to Patent Owner, dated April 20, 2023, of the Parent ’624 Patent, the ’871 Patent, the child ’095 Patent, and the child application that eventually issues as the child ’823 Patent.
1081	U.S. Patent Publication No. 2012/0300615 (“Kempf”).
1082	U.S. Patent Publication No. 20090276771 (“Nickolov”)

Petitioner’s Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

<i>Exhibit #</i>	<i>Description</i>
1083	McKeown et al, “Open Flow: Enabling Innovation in Campus Networks” March 14, 2008 (cited by Patent Owner as EX2002 in IPR2025-00619) (“ <i>OpenFlow</i> ”).
1084	File History, as of November 20, 2025, of <i>Ex Parte</i> Re-examination No. 90/019,948 (the “’948 Reexam”).

I. INTRODUCTION

Pursuant to the Board's November 19, 2025 email authorizing the filing of this Motion, and pursuant to 35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3(a) and 42.122(a), Petitioner Microsoft Corporation ("Petitioner") moves to stay *Ex Parte* Re-examination No. 90/019,948 (the "'948 Reexam") pending resolution of the instant instituted IPR involving the identical patent -- U.S. Patent No. 11,695,823 (the "'823 Patent"). *See also* Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (the "Notice") (outlining factors the Board may consider in AIA trials in deciding whether to stay a parallel reexamination involving the same patent). Petitioner and Patent Owner have conferred, and Patent Owner has indicated, including in a November 20, 2025 email to the Board, that it does not oppose this Motion.

Based on consideration of each of the Notice factors, and for the reasons detailed below, Petitioner submits that there is good cause to stay the '948 Reexam pending resolution of the instant instituted IPR.

II. GOOD CAUSE EXISTS TO STAY THE '948 REEXAM

A. Background of the Parallel Office Proceedings Involving the '823 Patent

On February 17, 2025, Petitioner filed a petition for *inter partes* review of claims 1-5, 7-8, 12-15 and 18-19 of the '823 Patent in IPR2025-00618 (the "'618

Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

IPR”). On July 31, 2025, after the parties filed competing briefs, the Director denied Patent Owner’s Request for Discretionary Denial of this Petition and referred this Petition to the Board. Paper 13. On September 30, 2025, the Board granted institution of the ’618 IPR (Paper 14) and issued a Scheduling Order (Paper 15) in which, among other deadlines, the Board set a deadline of December 23, 2025 for Patent Owner to file its Patent Owner Response or a Motion to Amend the ’823 Patent, and a deadline of June 30, 2026 for Oral argument (if requested).

On May 6, 2025, Unified Patents, LLC filed a Request for *Ex Parte* Reexamination of claims 1-4, 8, 15 and 19 of the ’823 Patent in the ’948 Reexam. EX1084 at 445-476. On July 22, 2025, a USPTO examiner issued an order granting the Request in the ’948 Reexam. EX1084 at 4-20. As of today’s date, the USPTO examiner has not issued an Office Action in the ’948 Reexam.

B. Notice Factor 1: Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding

Every claim challenged in the ’948 Reexam is challenged in the ’618 IPR, and the instant ’618 IPR involves an additional five (5) dependent claims of the ’823 Patent. Accordingly, this factor weighs in favor of a stay of the ’948 Reexam. *See, e.g., Resmed Corp. v. Cleveland Medical Devices, Inc.*, IPR2025-00159, Paper 14 (August 6, 2025) at 2; *Apple Inc. v. Smith Interface Technologies, LLC*,

Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

IPR2024-01115, Paper 18 (April 8, 2025) at 3-4; *Apple Inc. v. Proxense, LLC*,

IPR2024-00232, Paper 27 (March 27, 2025) at 2, 4.

C. Notice Factor 2: Whether the same grounds of unpatentability or the same prior art are at issue in both the IPRs and the Reexamination

The grounds of unpatentability in the instant '618 IPR and in the '948 Reexam are both based on obviousness, but none of the prior art references in the '618 IPR grounds – *Vasell, Alves, Hall, and Rellermeyer* – were relied upon in the '948 Reexam, as noted by the USPTO examiner. EX1084 at 15-16. Accordingly, because different prior art is applied in different obviousness grounds between the instant '618 IPR and the '948 Reexam, this factor weighs against a stay.

D. Notice Factor 3: Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Because all of the claims at issue in the '948 Reexam are at issue in the instant '618 IPR, allowing the '948 Reexam to proceed concurrently with the instant '618 IPR would duplicate efforts within the Office. Accordingly, this factor weighs in favor of a stay of the '948 Reexam. *See, e.g., Resmed*, IPR2025-00159, Paper 14 at 2-3; *Smith Interface*, IPR2024-01115, Paper 18 at 4, 6-7.

E. Notice Factor 4: Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding)

Because all of the claims-at-issue in the '948 Reexam are at issue in the instant '618 IPR, and an additional five (5) dependent claims are at issue in the instant '618 IPR, allowing the '948 Reexam to proceed concurrently with the instant '618 IPR could result in inconsistent results between proceedings. For example, the Patent Owner (or the USPTO examiner) could propose amendments to the '823 Patent independent claims, or other commonly challenged claims, during the '948 Reexam which in turn, absent a stay, could change the scope of the claims while the Board is conducting its review of those same claims during the '618 IPR. *See, e.g., Proxense*, IPR2024-00232, Paper 27 at 2-4; *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033 (November 6, 2012), Paper 15 at 2. Accordingly, this factor weighs in favor of a stay of the '948 Reexam. *Id.*

F. Notice Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

Because all of the claims at issue in the '948 Reexam are at issue in the instant '618 IPR, and because the Patent Owner may propose amendments to the scope of the claims in either proceeding, the Patent Owner (or the USPTO examiner) could propose amendments to the '823 Patent independent claims, or

Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

other commonly challenged claims, during the '948 Reexam which in turn, absent a stay, could change the scope of the claims while the Board is conducting its review of those same claims during the '618 IPR. *See, e.g., Proxense*, IPR2024-00232, Paper 27 at 2-4; *CBS Interactive*, IPR2013-00033, Paper 15 at 2.

Accordingly, this factor weighs in favor of a stay of the '948 Reexam. *Id.*

G. Notice Factor 6: The respective timeline and stage of each proceeding

The Board instituted the instant '618 IPR on September 30, 2025 (Paper 14) and, pursuant to the statutory deadline requiring, absent a good cause extension, a final written decision within one year of institution (*i.e.*, by September 30, 2026), the Board set a deadline of December 23, 2025 for Patent Owner to file its Patent Owner Response or a Motion to Amend the '823 Patent, and a deadline of June 30, 2026 for Oral argument (if requested). Paper 15; 35 U.S.C. § 316(a)(11).

In the '948 Reexam, the USPTO examiner has not yet issued a first Office Action and, although *ex parte* reexaminations are required to be “conducted with special dispatch,” they are not subject to a specific deadline. *See EX1084*; 35 U.S.C. § 305. Moreover, although the USPTO's official reexamination statistics have not yet been published for quarters after March 2025, the number of reexaminations filed in the second half of 2025 is widely expected to have risen, which could result in reexaminations of even longer duration than the USPTO-

Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

published 25.7 month average as of September 30, 2024. *See, e.g.,*

https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_.pdf

(viewed November 21, 2025); <https://www.rpxcorp.com/data-byte/reexams-rose-as-discretionary-denial-changes-constrained-iprs/>.

Accordingly, this factor weighs in favor of a stay of the '948 Reexam. *See, e.g., Toshiba Memory Corporation v. Anza Technology, Inc.*, IPR2018-01598, Paper 35 (July 10, 2019); *Cf. Resmed*, IPR2025-00159, Paper 14 at 4; *Smith Interface*, IPR2024-01115, Paper 18 at 3, 8.

H. Notice Factor 7: The statutory deadlines of the respective proceedings

The instant '618 IPR 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. Accordingly, this factor weighs in favor of a stay of the '948 Reexam. *See, e.g., Resmed*, IPR2025-00159, Paper 14 at 4.

I. Notice Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot

Because all of the claims at issue in the '948 Reexam are at issue in the instant '618 IPR, a final written decision in this IPR will likely simplify issues in,

Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)

or render moot, the '948 Reexam. Accordingly, and also given the current stages of the proceedings and the statutory deadline for the instant '618 IPR (*see* Notice Factors 6-7 *supra*), this factor weighs in favor of a stay of the '948 Reexam. *See, e.g., Resmed*, IPR2025-00159, Paper 14 at 4; *Proxense*, IPR2024-00232, Paper 27 at 4-5; *Cf. Smith Interface*, IPR2024-01115, Paper 18 at 3, 9.

III. CONCLUSION

For the foregoing reasons, Petitioner submits that, because Notice factors 1 and 3-8 weigh in favor of a stay of the '948 Reexam and only Notice factor 2 weighs against a stay, good cause exists for staying the '948 Reexam pending resolution of the instant '618 IPR. *See also* Notice, 84 Fed. Reg. at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing 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.”).

*Petitioner's Unopposed Motion to Stay Concurrent Ex Parte Reexamination
Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a)*

Respectfully submitted,

DUANE MORRIS LLP

/Christopher J. Tyson/

Christopher J. Tyson, Reg. No. 63,850

901 New York Avenue, N.W.

Suite 700 East

Washington, D.C. 20001-4795

P: (202) 776-7851

F: (202) 478-2620

CJTyson@duanemorris.com

ATTORNEY FOR PETITIONER

Dated: November 24, 2025

CERTIFICATION OF SERVICE ON PATENT OWNER

I hereby certify that on November 24, 2025, a copy of Petitioner's Unopposed Motion to Stay a Concurrent Ex Parte Reexamination Proceeding Pursuant to 35 U.S.C. § 315(d), 37 C.F.R. §§ 42.3(a) and 42.122(a) was filed by filing this document through the PTACT's System as well as delivering a copy via electronic mail upon lead and backup counsel for the Patent Owner as follows:

Brandon R. Theiss
VOLPE KOENIG
BTheiss@vklaw.com

Daniel H. Golub
VOLPE KOENIG
DGolub@vklaw.com

David L. Hecht
HECHT PARTNERS LLP
dhecht@hechtpartners.com

 /Christopher J. Tyson/
Christopher J. Tyson, Reg. No. 63,850
901 New York Avenue, N.W.
Suite 700 East
Washington, D.C. 20001-4795
P: (202) 776-7851
F: (202) 478-2620
CJTyson@duanemorris.com

ATTORNEY FOR PETITIONER