

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
Petitioner,

v.

AT HOME BONDHOLDERS' LIQUIDATING TRUST,  
Patent Owner.

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Case CBM2016-00036  
Patent 6,286,045 B1

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Before JUSTIN T. ARBES and MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

On June 10, 2016, Judges Easthom, Arbes, and Quinn held a conference call with counsel for the parties to discuss a request for authorization of a Petitioner Reply to Patent Owner's Preliminary Response and a Patent Owner Sur-Reply, in accordance with an agreement between the parties. In particular, the request is limited to addressing two recently issued decisions: *Enfish, LLC, v. Microsoft Corporation*, No. 2015-1244, (Fed. Cir. May 12, 2016) ("*Enfish*"); and *TLI Communications LLC, v. AV Automotive, L.L.C., et al.*, Nos. 2015-1372, -1376, -1377, -1378, -1379, -1382, -1383, -1384, -1385, -1417, -1419, -1421 (Fed. Cir. May 17, 2016) ("*TLI*"). According to Petitioner, the *Enfish* and *TLI* decisions issued after Petitioner filed its Petition, and Patent Owner addressed *Enfish* in its Preliminary Response. Patent Owner stated that it would not oppose Petitioner's Reply, if it would be allowed to file a Sur-Reply. The parties proposed a 7-page Reply, and a 5-page Sur-Reply.

During the call, we stated that we did not recognize a need for Patent Owner to have the last word or otherwise be entitled to a sur-reply given that a preliminary response is optional and that Patent Owner addressed *Enfish* in its brief without the expectation that it would have an opportunity for additional briefing. Upon consideration of the timing of the filing of the Petition and the failure of Patent Owner to address *TLI* in its Preliminary Response, we nevertheless allowed additional briefing as stated in this Order. The parties' request is, therefore, *granted*, as stated hereunder.

### ORDER

Having considered the parties' request, the timing between the parties' filings and the issuance of *Enfish* and *TLI*, the parties' agreement, and the deadline for issuing a decision on institution, it is hereby,

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ORDERED that Petitioner is authorized to file, by June 17, a Reply, limited to addressing *Enfish* and *TLI*, and limited to 4 pages; and

FURTHER ORDERED that Patent Owner is authorized to file, by June 24, a Sur-Reply, limited to addressing Petitioner's Reply, and limited to 2 pages.

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