

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORPORATION
Petitioner,

v.

MOBILEMEDIA IDEAS LLC
Patent Owner.

Case IPR2013-00016 (JYC)
Patent 6,441,828

Before SALLY C. MEDLEY, KEVIN F. TURNER, and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge*

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

On April 1, 2013, the initial conference call for this trial was held between respective counsel for the parties and Judges Medley, Turner, and Chang. The Board instituted the instant *inter partes* review on March 18, 2013. (Paper 16.) The purpose of the call was to discuss the motions that

the parties intend to file and any proposed change to the Scheduling Order (Paper 17).

During the conference call, the parties did not request any change to the Scheduling Order. MobileMedia stated that it may file a motion to amend claims under 37 C.F.R. § 42.221.

RIM requested authorization to submit additional grounds of unpatentability or, alternatively, to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) to present the additional grounds of unpatentability. *See* Paper 18.¹ RIM indicated that in a concurrent litigation², the District Court of Delaware granted summary judgment of invalidity of dependent claims 17 and 18 of the '828 patent as anticipated by U.S. Patent No. 6,563,535 (“Anderson ’535”). RIM proposed to submit the same grounds from that decision.

In response, MobileMedia indicated that RIM could have submitted the grounds based on Anderson ’535 with its petition because the grounds, with the corresponding claim charts, were presented in the concurrent litigation on March 26, 2012. According to MobileMedia, presenting the new grounds in this proceeding after institution would place an unnecessary burden on the patent owner while it is preparing to file a patent owner response. MobileMedia further stated that the summary judgment granted

¹ On March 29, 2013, RIM filed a notice of petitioner’s request for authorization to submit additional grounds for unpatentability.

² *MobileMedia Ideas, LLC v. Apple Inc.*, Case No. 10-cv-258-SLR (D. Del.).

by the district court is not a final decision, and its appeal rights have not been exhausted.

The Board explained that the original petition should have included all of the asserted grounds of unpatentability. *See* 37 C.F.R. § 42.104(b). The Board expressed the concerns that the additional grounds would place an unnecessary burden on the patent owner and Board, and would impact the ability of the Board to timely complete the review.

Finally, the Board observed that the new grounds proposed by RIM seem to be redundant in light of the instituted grounds of unpatentability. RIM appeared to agree with the Board's observation.

Upon consideration of the parties' contentions, the Board denies RIM's request for authorization to submit additional grounds of unpatentability.

Accordingly, it is

ORDERED that RIM's request for authorization to submit additional grounds of unpatentability after institution is denied; and

FURTHER ORDERED that RIM is not authorized to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) to present additional grounds of unpatentability.

Case IPR2013-00016
Patent 6,441,828

PETITIONER:

Robert C. Mattson
Oblon Spivak
CPdocketMattson@oblon.com

PATENT OWNER:

Anthony C. Coles
PROSKAUER ROSE LLP
acoles@proskauer.com