

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.
Petitioner

v.

CLOUDING IP, LLC
Patent Owner

Case IPR2013-00586
Patent 6,738,799

Before JAMESON LEE, RAMA G. ELLURU, and JUSTIN BUSCH,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

INTRODUCTION

A conference call was held on January 10, 2014, between respective counsel for the parties and Judges Lee, Elluru, and Busch. Counsel for Petitioner initiated the conference call to request authorization to file a reply to Patent Owner's preliminary response, prior to the Board's deciding whether to institute review. The conference call was transcribed by a court reporter arranged by Petitioner.

DISCUSSION

The Patent Owner's preliminary response asserts that Petitioner failed to identify Google Inc. as a real party-in-interest. According to Patent Owner, because Google Inc. is a real party-in-interest which had been served, on May 24, 2012, with a complaint alleging infringement of Patent 6,738,799, Petitioner's petition is barred by the one-year time bar under 35 U.S.C. § 315(b). Paper 5, 20. According to counsel, Petitioner seeks an opportunity to respond to Patent Owner's assertion that Google Inc. is a real party-in-interest, prior to the Board deciding whether to institute review.

No rule automatically provides for a reply to a Patent Owner's preliminary response. Where appropriate, however, the Board may authorize the filing of such a reply. *See* 37 C.F.R. § 42.5(a). During the conference call, upon inquiry from the Board, counsel for Petitioner indicated that the Petitioner is not without opportunity to address the issue concerning whether the petition is barred under 35 U.S.C. § 315(b) and whether Google Inc. is a real party-in-interest, if the Board institutes *inter partes* review. Counsel for Petitioner explained that Petitioner's concern is that based on Patent Owner's unilateral assertion on these issues, the Board would regard Google Inc. as a real party-in-interest and treat the petition as barred under 37 C.F.R. § 315(b).

The Board indicated that on the issue of whether the petition is barred under 35 U.S.C. § 315(b), Petitioner does have a right to respond prior to any denial of the Petition on the basis of 35 U.S.C. § 315(b), but no such reply is necessary at this time.

Conclusion

It is

ORDERED that Petitioner is not authorized to file a reply to Patent Owner's preliminary response;

FURTHER ORDERED that if the Board deems necessary to consider a reply from Petitioner regarding whether the petition is barred under 35 U.S.C. § 315(b), prior to rendering a decision on whether to institute *inter partes* review, the parties will be notified by the Board; and

FURTHER ORDERED that Petitioner shall file a copy of the conference call transcript as an exhibit as soon as it is available.

For Petitioner:

Michael Kiklis
Scott McKeown
CPdocketkiklis@oblon.com
cpdocketmckeown@oblon.com

For Patent Owner:

Tarek Fahmi
Amy Embert
tarek.fahmi@fseip.com
amy.embert@fseip.com