

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS, LLC
Patent Owners

Cases IPR2013-00596
Patent 7,802,310 B2

Before KEVIN F. TURNER, JONI Y. CHANG, and MICHAEL R. ZECHER,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

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

IPR2013-00596
Patent 7,802,310 B2

A conference call in *inter partes* review IPR2013-00596, involving of U.S. Patent No. 7,802,310 B2 (“the ’310 patent,” Ex. 1001), occurred on June 21, 2017. Respective counsel for Petitioner and Patent Owner, and Judges Turner, Chang, and Zecher were in attendance. A court reporter was present on the call, which was provided by Patent Owner. The purpose of the call was to discuss briefing in response to the remand by the U.S. Court of Appeals for the Federal Circuit of this case for further proceedings. *See PersonalWeb Tech., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017).

Our reviewing court found that “[t]he Board did not sufficiently explain and support the conclusions that (1) Woodhill and Stefik disclose all of the elements recited in the challenged claims of the ’310 patent and (2) a relevant skilled artisan would have been motivated to combine Woodhill and Stefik in the way the ’310 patent claims and reasonably expected success.” *Id.* at 993. To fulfill such considerations, we request briefing specifically pointing out where Petitioner made out a proper case of obviousness on the instituted ground, or where Petitioner failed to make out such a case. Emphasis should be placed on elucidating whether the Petition explains and supports the conclusions enumerated as (1) and (2) of the above citation.

Each brief is limited to fifteen (15) pages and is due on July 12, 2017; on the conference call, the parties agreed to set a common time on that day for near simultaneous submission. At this time, the panel does not deem it necessary to receive responsive briefs from either side, but may revisit such considerations after receipt and review of each parties’ briefs. No new evidence of any kind may be proffered in each of the parties’ briefs.

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Accordingly, it is

ORDERED that both parties shall file briefs, limited to fifteen (15) pages by July 12, 2017, as outlined above;

FURTHER ORDERED that neither party may submit new evidence of any kind, and neither party's brief may contain or cite to new evidence outside of the record of this proceeding; and

FURTHER ORDERED that Patent Owner will file a copy of the court reporter's transcript of the conference call, separately as an exhibit, once it is available.

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