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Paper 50
Entered: December 28, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BUNGIE, INC.,
Petitioner,

v.

WORLDS INC.,
Patent Owner.

Case IPR2015-01264 (Patent 7,945,856 B2)
Case IPR2015-01319 (Patent 8,082,501 B2)
Case IPR2015-01321 (Patent 8,145,998 B2)

Before KARL D. EASTHOM, KEN B. BARRETT, and JASON J. CHUNG, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge.*

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

We received from Petitioner an email dated December 26, 2018, asserting that the parties are unable to reach complete agreement as to the contents of joint stipulations to be filed in these cases. We authorized, in our Order dated November 29, 2018 (*e.g.*, IPR2015-01264, Paper 48), the parties to file joint stipulations directed to the limited issues remaining to be resolved in these cases, which are on remand from the Court of Appeals for the Federal Circuit. Specifically, we authorized the parties to file joint stipulations regarding two categories of information that Petitioner characterized as noncontroversial, non-testimonial evidence. *Id.* at 6–8, 10. We also authorized and encouraged the parties to include additional stipulations as to factual matters pertaining to the remaining issues in these cases, that of collateral estoppel and real-party-in-interest (RPI). *Id.* at 8.

Petitioner, in its email, seeks our guidance on how to proceed and offers to submit to us the proposed but disputed stipulations. Petitioner represents that the stipulations include quotations from communications exchanged as settlement negotiations between the parties. Petitioner does not indicate that the disputed, proposed stipulations pertain to the categories of information that were the subject of our authorization.

We received from Patent Owner an email also dated December 26, 2018, containing a response to Petitioner's email. Patent Owner states that it understands that the parties have reached agreement regarding stipulations addressing the two authorized categories of information. Patent Owner asserts that the disputed topics are those not raised by Petitioner during the conference call with the Board that resulted in the Order mentioned above. Patent Owner submits that it would be inappropriate to enter into the record

the substance of settlement discussions. Patent Owner further asserts that some disputed, proposed stipulations include Petitioner's characterizations of evidence that is in the record or is authorized to be filed in the record.

Having considered the parties' email submissions, our guidance to Petitioner is to file joint stipulations pertaining to topics for which the parties are willing to jointly stipulate and as limited to topics that were the subject of our authorization in the referenced order. We deny Petitioner's request to submit, and do *not* authorize the submission or filing of, the disputed draft stipulations. We see no need to hold a conference call with the parties regarding the disputed stipulations. To the extent that the disputed stipulations reflect characterizations of record evidence, Petitioner will have the opportunity to present those characterizations via argument in the forthcoming briefing.

This order does not alter the provisions set forth in our Order of November 29, 2018, as modified by the Order of December 20, 2018 (*e.g.*, IPR2015-01264, Paper 49) (revising the briefing schedule per Petitioner's request).

It is so ORDERED.

IPR2015-01264 (Patent 7,945,856 B2)
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IPR2015-01321 (Patent 8,145,998 B2)

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