
From: Steve Sereboff <SSereboff@socalip.com>
Sent: Monday, June 22, 2020 11:40 AM
To: trials@uspto.gov
Cc: PTAB Rich Giunta; Hunt, Elisabeth; Giunta, Richard F.; PTAB Elisabeth Hunt; PTAB Randy Pritzker; PTAB Mike Rader; Jonathan Pearce; Anneliese Lomonaco
Subject: RPX v. AIT remand: IPR2015-01750, -01751, -01752 [SoCal IP file A213.L18F23]

Dear Board,

Patent Owner AIT requests an expedited decision. These cases have been on remand for more than 18 months, and awaiting a decision for more than 12 months. This delay is far beyond the 6 month guideline of Standard Operating Procedure 9. This pendency is contrary to the statutory mandate of an 18 month time limit (i.e., 6 months to an initial determination, 35 USC 314(b), plus 12 months to a final written decision, 35 USC 316(a)(11)). Patent Owner has suffered great prejudice in that the Board's delaying a decision is preventing a lift in the stay of the related district court case. Patent Owner has also been prejudiced by the passage of time in that one of its patents expired during these post-remand proceedings, and the other will expire in January 2021.

If the current panel is unable to expedite its decision, Patent Owner requests that the Board request an expanded panel under Standard Operating Procedure 1, to include the Chief Judge and the Director, or in the alternative, authorize Patent Owner to file a motion for such a request. An expanded panel is appropriate because of the considerable delay of the current panel in reaching a decision. Furthermore, these are important cases as reflected by the Federal Circuit's precedential opinion which has been highly cited by the Board, various parties in other AIA trials, and in federal court. The Board's decision here should be consistent with its precedent, especially *Ventex Co., Ltd. v. Columbia Sportswear North America, Inc.*, IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019). Thus, as stated in SOP 1, an expanded panel will "secure and maintain uniformity of the Board's decisions." To the extent the delay is due to the current panel's efforts in making sure it is properly applying the RPI/privity standard, Patent Owner believes that having more judges, and especially senior judges, might help reach a decision expeditiously and in accordance with precedent.

Petitioner RPX neither joins nor opposes AIT's request for an "expedited" decision. RPX eagerly awaits the Board's decision as soon as it is ready, but disagrees with AIT's assertion that there has been delay or prejudice, and notes that the statutory deadlines cited in AIT's e-mail are inapplicable to these remand proceedings.

RPX opposes AIT's request for an expanded panel. RPX believes that SOP 1 makes clear that expanded panels are "not favored" and there is no basis for expanding the panel in these proceedings. The current panel, in RPX's view, is fully capable of issuing a decision consistent with Board precedent. RPX disagrees with AIT's suggestion that the quoted section of SOP 1 mentioning "uniformity" suggests panel expansion to ensure that the panel follows precedent; it instead addresses ensuring uniformity among "related cases ordinarily involving different three judge panels."

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RPX Exhibit 1106
RPX v. AIT
IPR2015-01751