

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

J. CARL COOPER,
Patent Owner.

Case IPR2014-00157
Patent 7,828,207

Before JAMESON LEE, GEORGE R. HOSKINS, and
KRISTINA M. KALAN, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

Order
Conduct of Proceedings
37 C.F.R. § 42.5

Introduction

On June 3, 2014, an initial conference call was held. The participants of the call were respective counsel for the parties and Judges Lee, Hoskins, and Kalan. Counsel for Petitioner arranged for the services of a court reporter to transcribe the call. Counsel for Patent Owner had objected to the use of a court reporter but withdrew the objection after a brief non-transcribed discussion with the panel. Petitioner should provide a copy of the transcript to Patent Owner as soon as a copy is provided to Petitioner's counsel.

Discussion

Only Petitioner filed a list of proposed motions prior to the initial conference call. In its motions list, Petitioner stated that it "reserves the right to seek authorization from the Board, if required, should the need later arise for filing a motion." (Paper 11) The panel explained to the parties that such language is not helpful and should be avoided. Whatever right a party possesses under the law need not be reserved. Whatever right a party does not possess cannot be created by "reservation." Inclusion of such "reservation" language causes unnecessary concern for the other party as well as requires effort on all readers to decipher whether anything meaningful has been said. Petitioner agreed to refrain from making such "reservations" in the future in this proceeding.

The only item contained in Petitioner's proposed motions list is a motion to change the date of oral hearing from December 17, 2014, on the basis that the date presents a conflict for the lead attorney for Petitioner. We asked counsel for the parties to present three alternative dates for selection by the Board based on the availability of the judges on the panel and also on the availability of hearing rooms. Counsel for the parties presented these alternative dates: December 10, 2014,

January 12, 2015, and January 14, 2015. None of the proposed alternative dates, however, is available, based on the schedule of the Board's hearing rooms.

The oral hearing will be rescheduled to January 9, 2015. Neither party expressed an issue with respect to Due Dates 1-6 in the Scheduling Order dated May 15, 2014 (Paper 9).

Patent Owner's counsel sought authorization to file a motion for the Board to require mandatory initial disclosures in this proceeding. Mandatory initial disclosures are mandatory in nature and thus require no motion. We asked counsel for Petitioner to initiate a call with counsel for Patent Owner, following the conference call with the Board, to discuss what disclosures counsel for Patent Owner believes should be forthcoming as a part of mandatory initial disclosures. Counsel for Petitioner agreed to make that effort.

We raised for discussion the matter of potential expiration of the involved patent during this trial. It was indicated to the parties that it appears Patent 7,828,207 will expire in November 2014, prior to the date of any final written decision in this proceeding. We asked the parties to indicate to the Board, in a filing within ten days of the date of this Order, what they jointly regard as the date of expiration of Patent 7,828,207.

The claims of an *unexpired* patent are given their broadest reasonable interpretation in an *inter partes* review. 37 C.F.R. § 42.100(b). We instituted this trial applying the broadest reasonable interpretation for claim construction. If Patent 7,828,207 expires prior to our rendering of a final written decision, however, the broadest reasonable interpretation should not apply for purposes of the final written decision. In that circumstance, the Board's review of the claims is similar to that of a district court's review. *In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, claim terms are given their ordinary and customary

meanings, as would be understood by a person of ordinary skill in the art, at the time of the invention, having taken into consideration the language of the claims, the specification, and the prosecution history of record. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

To ensure that the parties will not be caught by surprise late in this trial, and to provide an opportunity for briefing by the parties within the Patent Owner Response and the Petitioner's Reply, we asked the parties to indicate whether they agree with our view that if Patent 7,828,207 expires prior to rendering of the final written decision, the rule of broadest reasonable interpretation does not apply. Instead, the manner of claim construction would be the same as that applied by the district courts, albeit there still would be no presumption of validity in this proceeding and Petitioner's burden of proof is still by a preponderance of the evidence. Also, we will not be applying a rule of construction with an aim to preserve the validity of claims.

We indicated to the parties that upon initial review, it appears to us that whether or not the rule of broadest reasonable interpretation is applied, the construction of each claim term as expressed in the decision instituting trial is the same, although we have not yet made an official determination in that regard. Counsel for the parties were informed that after receiving the parties' indication of their positions, we will issue an updated claim construction which indicates the construction that is not according to the broadest reasonable interpretation rule.

Finally, counsel for Patent Owner requested authorization to file an opposition to Petitioner's Request for Rehearing (Paper 10) of our Decision (Paper 8) instituting *inter partes* review. We denied that request and explained that if we need input from the Patent Owner we will notify the parties. We further indicated that an order granting Petitioner's Request for Rehearing will not be

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issued without Patent Owner having an opportunity to respond to the Petitioner's Request for Rehearing.

Order

It is

ORDERED that Due Date 7, the date of oral hearing, is changed to January 9, 2015; and

FURTHER ORDERED that within ten days of the date of this Order, the parties shall file a joint paper indicating: (1) the date of expiration of Patent 7,828,207; and (2) whether they agree that the rule of broadest reasonable interpretation does not apply at the time of final written decision of this proceeding if Patent 7,828,207 expires before that time; and

FURTHER ORDERED that Patent Owner is not authorized to file an opposition to Petitioner's Request for Rehearing.

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