

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TWILIO INC.,
Petitioner,

v.

TELESIGN CORPORATION,
Patent Owner.

IPR2016-00450 (US 8,462,920 B2)
IPR2016-00451 (US 8,867,038 B2)¹

Before SALLY C. MEDLEY, JUSTIN T. ARBES, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

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

¹ This Order addresses issues common to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any papers.

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In email correspondence to the Board dated May 16, 2016, counsel for Petitioner (1) requested permission to file a reply brief to Patent Owner's Preliminary Response to address whether the patents at issue are entitled to claim priority to an application with an earlier filing date and (2) asked when and how Petitioner should submit evidence that one of the asserted prior art references allegedly is entitled to prior art status as of the filing date of its provisional application. A conference call was held on May 19, 2016 to address these issues. Counsel for Patent Owner, Jesse Camacho and Elena McFarland, counsel for Petitioner, Wayne Stacy and Britton Davis, and Judges Arbes, McGraw, and Medley participated in the call. A transcript of the conference call has been filed. IPR2016-00450, Ex. 1022; IPR2016-00451, Ex. 1024.

Regarding the first issue, Petitioner stated that it believes that the issue of whether the challenged claims are entitled to claim priority back to the parent application is "properly decided in the final written decision, but if the [B]oard is inclined to deal with the issue at institution, we would like to be able to file a short reply addressing the legal requirements, the standard, and the burden that Patent Owner must meet to show it's entitled to the earlier priority date." IPR2016-00450, Ex. 1022 5:2-9. Counsel for Patent Owner opposed Petitioner's request.

Generally, a petitioner is not authorized to file a reply to a patent owner preliminary response. Based on the record before us, we determine that Petitioner has not demonstrated sufficiently that we should deviate from the normal procedure for these proceedings. We determine that we are capable of applying the indicated facts to the indicated statutes, rules, and case law and are not persuaded that the Board would benefit from additional

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briefing or supplementation. Upon consideration of the positions of the parties, Petitioner is not authorized at this time to file a reply to the Preliminary Response in the instant proceedings.

Regarding the second issue, Petitioner specifically asks if the Board would like Petitioner to submit evidence allegedly showing one of the asserted prior art references is entitled to prior art status as of the filing date of its provisional application either (1) prior to the Board's decisions on institution or (2) in reply to Patent Owner's Response. To the extent Petitioner is asking for permission to submit such evidence prior to the Board's decisions on institution, Petitioner's request is denied. Petitioner may revisit this issue if the cases are instituted.

For the foregoing reasons, it is

ORDERED that Petitioner's request to file a reply to the Preliminary Response in the instant proceedings is denied; and

FURTHER ORDERED that Petitioner's request to file evidence, prior to the Board's decisions on institution, alleged to show that an asserted prior art reference is entitled to the filing date of its provisional application is denied.

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