

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2016-01441
Patent 8,225,408 B2

Before JAMES B. ARPIN, PATRICK M. BOUCHER, and
ZHENYU YANG, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

A conference call was held on December 21, 2016, among representatives of the parties and Judges Arpin, Boucher, and Yang. The call was requested by Patent Owner to address aspects of the Reply filed on December 16, 2016 (Paper 9). Under our regulations, authorization to file a Reply to a Preliminary Response is not granted as of right. In our Order of December 13, 2016, we, nevertheless, authorized the parties to file “a Reply and Sur-reply addressing *the estoppel aspects* of [Patent Owner’s argument that the Petition is procedurally barred].” Paper 7, 1 (emphasis added). Because the filed Reply addresses issues beyond that limited scope, we order Petitioner to file, today, a revised version of the Reply that removes material outside that scope, i.e., any material that is not strictly responsive to the estoppel issues under 35 U.S.C. § 315(e)(1) argued in the Preliminary Response. Thus, no material related to 35 U.S.C. § 325(d) is appropriate or permitted in the Reply, and material related to 35 U.S.C. § 312 is appropriate only to the extent that it is responsive to arguments raised by Patent Owner in the Preliminary Response in support of Patent Owner’s estoppel arguments under 35 U.S.C. § 315(e)(1). The briefing schedule is unchanged.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner shall file, today, a revised version of the Reply (Paper 9) that removes material outside the scope identified above;

FURTHER ORDERED that Patent Owner is authorized to file, by December 21, 2016, a Sur-reply, limited to five pages, that responds to Petitioner’s arguments in the redacted Reply; and

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FURTHER ORDERED that Paper 9 is expunged.

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