

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00319
Patent 8,923,941 B2

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

ORDER

Extending One-Year Pendency for Good Cause
35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c)

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–13 of U.S. Patent No. 8,923,941 B2 (Ex. 1001, “the ’941 patent”). On June 6, 2017, the Board instituted an *inter partes* review of claims 1, 2, and 6–13 of the ’941 patent, but did not institute an *inter partes* review of claims 3–5 of the ’941 patent, and instituted an *inter partes* review on less than all of the grounds asserted in the Petition. Paper 10, 6–7, 55–56. Thereafter, on April 24, 2018, the U.S. Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) (“*SAS Institute* decision”). The one-year period normally available to issue a Final Written Decision expires on June 6, 2018.

Pursuant to 35 U.S.C. § 316(a)(11), “the final determination in an *inter partes* review [shall] be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months” The Director has delegated the authority to extend the one-year period to the Chief Administrative Patent Judge. *See* 37 C.F.R. § 42.100(c). In particular, 37 C.F.R. § 42.100(c) provides:

An *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge

In accordance with 37 C.F.R. § 42.100(c), the Chief Administrative Patent Judge has determined that good cause exists to extend the one-year period for issuing a Final Written Decision here. Paper 37; 37 C.F.R.

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§ 42.100(c). Accordingly, the time to administer the present proceeding is extended by up to six months.

The panel and the parties held a conference call on May 4, 2018, to discuss the impact of the *SAS Institute* decision on this proceeding. We are entering a separate order adding claims 3–5 and the associated grounds to this proceeding and authorizing the parties to file limited, additional briefing with respect to those added claims and grounds.

ORDER

It is

ORDERED that good cause exists to extend the time to administer this proceeding; and

FURTHER ORDERED that the time to administer this proceeding is extended by two months until **August 6, 2018**.

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