

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ANDREA ELECTRONICS CORP.,
Patent Owner.

Case IPR2017-00626
Patent 6,363,345 B1

Before MICHAEL R. ZECHER, JEREMY M. PLENZLER, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding—Supplemental Remand Briefing
37 C.F.R. § 42.5(a)

On May 21, 2020, the panel held a conference call with counsel for Apple, Inc. (“Petitioner”) and Andrea Electronics Corp. (“Patent Owner”) to discuss Patent Owner’s request for authorization to file a motion to strike or, alternatively, its request for supplemental briefing. A court reporter transcribed the call and a copy of the transcript will be included in the record when available.

As indicated in an email correspondence to the Board, and discussed during the call, Patent Owner requested authorization to file a motion to strike certain portions of Petitioner’s Responsive Remand Brief (Paper 44) directed to claim 9, asserting that page 5 of Petitioner’s Responsive Remand Brief raised a new issue regarding the unpatentability of claim 9. As an alternative to striking the portion of Petitioner’s Responsive Remand Brief noted above, Patent Owner proposed briefing responsive to the alleged new issue. The issue presented is whether the teachings of Martin relied on by Petitioner, in its Petition (Paper 1), meet the “periodically” limitation of claim 9.¹

During the call, the parties agreed to brief the issue raised by Patent Owner, obviating Patent Owner’s request for authorization to file a motion to strike. As discussed during the call, each party is authorized to file a three page brief addressing the original arguments presented in the Petition regarding claim 9 with no new evidence presented. Petitioner will file its brief first, due June 2, 2020. Patent Owner will respond to that brief no later than June 9, 2020.

¹ Petitioner’s Reply (Paper 18) did not address claim 9.

As explained during the call, in its brief, Petitioner should focus on how the portions of Martin discussed in the Petition meet the “periodically” limitation of claim 9. Petitioner’s argument should be directed to the teachings from Martin relied upon in the Petition and should not introduce any new theory of unpatentability based on other disclosures from Martin. Petitioner’s brief should focus on the merits of the challenge, and should make clear how the explanation provided in the brief is further explanation of the original challenge to claim 9 and not a new argument. If relying on portions of the Petition not specially directed to claim 9, Petitioner should explain clearly why those portions of the Petition are relevant to its original challenge to claim 9.

Patent Owner’s brief should focus on whether the teachings from Martin relied on by Petitioner meet the “periodically” limitation of claim 9, and may also address why any portion of Petitioner’s supplemental briefing is a change in its theory of unpatentability.

ORDER

Petitioner is authorized to file a three page supplemental brief, limited to the issues outlined above, by June 2, 2020; and

Patent Owner is authorized to file a three page supplemental brief, limited to the issues outlined above and responsive to Petitioner’s supplemental brief, by June 9, 2020.

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PETITIONER:

Jeffrey P. Kushan
jkushan@sidley.com

Steven S. Baik
sbaik@sidley.com

Thomas A. Broughan III
tbroughan@sidley.com

PATENT OWNER:

William D. Belanger
belangerw@pepperlaw.com

Andrew Schultz
schultza@pepperlaw.com

Griffin Mesmer
mesmerg@pepperlaw.com

Frank D. Liu
liuf@pepperlaw.com

Andrew Zappia
liuf@pepperlaw.com