

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2017-00896 (Patent 8,659,571 B2)
Case IPR2017-00897 (Patent 8,773,356 B2)¹

Before MICHAEL R. ZECHER, BRYAN F. MOORE,
NEIL T. POWELL, and MINN CHUNG, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42(a)

¹ This Order applies to both cases. The parties are not authorized to use this style heading for any subsequent papers.

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In IPR2017-00896 and IPR2017-00897, Apple, Inc. (“Petitioner”) has filed Petitions requesting *inter partes* reviews of U.S. Patent No. 8,659,571 B2 (“the ’571 patent”) and U.S. Patent No. 8,773,356 B2 (“the ’356 patent”), respectively. *See* IPR2016-00896, Paper 1; IPR2017-00897, Paper 1. Both Petitions have been accorded a filing date of February 12, 2017. *See* IPR2017-00896, Paper 3; IPR2017-00897, Paper 3.

On April 6, 2017, a telephone conference was held with the parties at the request of Immersion Corporation (“Patent Owner”). During the conference, Patent Owner alleged certain problems with Petitioner’s service of the Petitions on Patent Owner. Based on this, Patent Owner contended that the Petitions are not entitled to the February 12, 2017, filing date that they have been accorded. Additionally, Patent Owner contended that Petitioner was served with a complaint asserting the ’571 patent and the ’356 patent in the District Court of Delaware on February 12, 2016. Based on these assertions, Patent Owner indicated that *inter partes* review is barred by 35 U.S.C. § 315(b), which states, in relevant part, “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” Additionally, Patent Owner sought leave to file a motion for additional discovery regarding the service of the Petitions.

In response, Petitioner disputed Patent Owner’s contention that service of the Petitions was insufficient to support the February 12, 2017, filing dates the Petitions have been accorded. Additionally, given that February 12, 2017, was a Sunday, Petitioner asserted that, even if service did

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not occur until Monday, February 13, 2017, service was timely under the Board's rules.

The parties' contentions warrant briefing. Petitioner shall file, by Tuesday, April 18, 2017, a brief supporting its contentions. Petitioner's brief shall address its contention that service of the Petitions was effected properly on February 12, 2017. Petitioner's brief shall also address its contention that, even if service did not occur until Monday, February 13, 2017, service was timely, such that the Petitions are properly accorded the filing date of February 12, 2017, under the Board's rules and no time bar is triggered under 35 U.S.C. § 315(b). Patent Owner may file, by Tuesday, April 25, 2017, a brief responding to Petitioner's brief. Each party's brief shall not exceed 5 pages. Each party may submit evidence with its brief in support of its position regarding whether service of the Petitions was effected properly on February 12, 2017.

At this time, a motion by Patent Owner for additional discovery is not warranted.

Order

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner shall file, by Tuesday, April 18, 2017, a brief addressing (1) Petitioner's contention that service of the Petitions was effected properly on February 12, 2017, and (2) Petitioner's contention that, even if service did not occur until Monday, February 13, 2017, service was timely, such that the Petitions are properly accorded the filing date of February 12, 2017, under the Board's rules and no time bar is triggered under 35 U.S.C. § 315(b);

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FURTHER ORDERED that Patent Owner may file, by Tuesday, April 25, 2017, a brief responding to Petitioner's brief;

FURTHER ORDERED that each party's brief shall not exceed 5 pages;

FURTHER ORDERED that each party may submit evidence with its brief in support of its position regarding whether service of the Petitions was effected properly on February 12, 2017; and

FURTHER ORDERED that, at this time, Patent Owner is not authorized to file a motion seeking additional discovery.

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