

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENT INC.,
Petitioner

v.

PLECTRUM LLC,
Patent Owner

IPR2017-01430
Patent 5,978,951

Before KEN B. BARRETT, MIRIAM L. QUINN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

ORDER

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

Unified Patents Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6, 8, 11–14, and 21–24 of U.S. Patent No. 5,978,951 (“the ’951 patent”). Paper 3. There were four (4) obviousness grounds on which institution was requested. *Id.* at 4, 21–71. Plectrum LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7. On November 14, 2017, we issued a Decision instituting *inter partes* review of claims 8 and 11 of the ’951 patent under one (1) of the four (4) asserted grounds for unpatentability. Paper 8. A Scheduling Order was entered, with an oral hearing date set on August 2, 2018. Paper 9.

On April 24, 2018, the U.S. Supreme Court held that a final written decision under 35 U.S.C. § 318(a) shall be with respect to the patentability of all of the claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348, 1358 (2018). As noted above, although Petitioner challenged claims 1–6, 8, 11–14, and 21–24 of the ’951 patent, we did not institute review on claims 1–6, 12–14, and 21–24. By May 3, 2018 Order, we modified our Decision on Institution to institute on all of the challenged claims and on all of the grounds asserted in the Petition. Paper 15. In that Order, we requested that the parties confer on any impact of the modification of the Decision on Institution on briefing and scheduling, and, if any, request a conference call with the Board. *Id.* at 1.

Pursuant to a further request, we held a conference call with the parties on May 17, 2018, to discuss how the parties sought to proceed in the case in light of *SAS* and the modified Decision on Institution. Petitioner requested additional briefing on the newly-instituted claims and grounds to provide a supplemental reply, and proposed that Patent Owner be provided the opportunity to provide a response to the additional briefing, with Petitioner then providing a surreply. Petitioner stated that it sought approximately ten (10) pages of additional briefing,

and scheduling allowing four (4) weeks for the additional briefing filing, one (1) week for Patent Owner response, and one week (1) week for Petitioner surreply. Patent Owner did not want to file additional briefing, and opposed any additional briefing by Petitioner. Neither party indicated that a schedule extension was necessary.

We have considered the parties' positions on additional briefing and authorize Petitioner to file a supplemental brief addressing the claims and grounds on which the Board had previously denied institution. The supplemental brief is limited to the existing record in the proceeding, and shall address only the arguments and evidence in the Petition and the portions of the Decision to Institute related to the newly-instituted claims and grounds. Petitioner may not raise new arguments or submit new evidence. Petitioner's supplemental brief shall be no more than ten (10) pages to be filed within three (3) weeks of the date of this order. Patent Owner, at this time, is not authorized to file a response.

ORDER

Accordingly, it is hereby:

ORDERED that Petitioner may file a supplemental brief addressing the newly-instituted claims and ground, limited to ten (10) pages, within three (3) weeks of the date of this order.

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Patent 5,978,951

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