

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

I. BACKGROUND

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. Petitioner filed a Request for Rehearing (Paper 10) on the issue of the denial of review institution for claims 1–6, 12–14, and 21–24, and that Request was denied (Paper 11).

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 did not seek to file additional expert declaration(s) nor additional evidence. Patent Owner did not want to file any additional briefing, and opposed any additional briefing by Petitioner. Neither party indicated that a schedule extension was necessary.

We considered Petitioner's request for supplemental briefing and allowed the filing of a ten (10) page brief by Petitioner in a May 18, 2018 Order.¹ Paper 16.

On May 24, 2018, the Board received an email from Petitioner requesting that it be permitted to file a supplemental expert declaration and supporting evidence, in addition to the supplement brief. *See* Ex. 3001. The Board directed that the parties meet and confer on the issues that Petitioner was proposing to include in any additional expert declaration and any evidence.

On June 1, 2018, we held a conference call to discuss Petitioner's additional request. Although Petitioner had indicated an intention to provide a court reporter for the conference (*see* Ex 3001), Petitioner, in fact, did not arrange for a reporter, so we will summarize the issues discussed.

Petitioner indicated that a meet and confer had been conducted. Petitioner asserted that it now seeks to file a supplemental expert declaration to provide additional testimony of the view of one of ordinary skill in the art at least on the issue of the prior art (e.g., Cheriton) teachings regarding the alleged use of rows in

¹ Paper 16 erroneously bears the date of "May 16, 2018;" the Order was instead docketed and mailed on May 18, 2018.

cached, as well as how the prior art teaches the comparison of the alleged rows. Petitioner also seeks leave to file at least additional evidence consisting of dictionary definitions to support the expert's interpretations of the prior art references. Petitioner alleges that, as a matter of due process, it should be permitted to file an additional declaration and evidence to the extent that such evidence would have been permitted had all the claims been originally instituted on. Petitioner also asserts that it should be permitted to respond to Patent Owner Preliminary Response under 37 C.F.R. § 42.23(b), and referred to pages 6–8 of Patent Owner Preliminary Response as examples of portions to which it wants to provide responsive evidence. Petitioner argues that it had established a *prima facie* case of obviousness for the claims not instituted upon, and also contends that Patent Owner's arguments presented in its Preliminary Response could not have been reasonably anticipated.

Patent Owner objects to allowing filing of additional expert declarations and evidence by the Petitioner, alleging that Petitioner cannot seek to impermissibly supplement a deficient Petition that failed to make a *prima facie* showing of unpatentability for some of the claims. Patent Owner re-confirmed that it does not want, at this time, to file any additional briefing.

II. DISCUSSION

Here, we have already permitted Petitioner to file a supplemental brief to address the claims and grounds on which the Board had previously denied institution, even with Patent Owner declining additional briefing. *See* Paper 16. There is no specific authorization under our rules for additional Petitioner briefing, but we nonetheless allowed the briefing, in light of the circumstances and in an abundance of fairness.

The issue of allowing additional expert testimony and evidence under these circumstances is also one on which there is no specific authorization under our rules. That said, we consider the issue of whether the additional filings would be permissible to the extent that such evidence would have been permitted had all the claims been originally instituted on.

In the Decision to Institute, we determined that the Petition, and the evidence relied upon, failed to demonstrate that Cheriton, the main prior art reference relied upon for the un-instituted claims, failed to explicitly disclose “row” limitations of the claims at issue. Paper 8, 14–15. In the Petition, Petitioner additionally alleged that “[t]o the extent Cheriton does not explicitly state that the lookup or indexing was done by comparing the virtual path cache index to a value associated with a row in the cache” that “it would have been obvious to a person of ordinary skill in the art to compare the virtual path cache index in such a fashion.” *See id.* at 15 (citing Paper 3, 30). We determined that the Petition failed to demonstrate, and more particularly Petitioner’s expert failed to adequately explain, why one of skill in the art would have viewed or implemented Cheriton in the manner claimed. *See id.* at 15–16.

Our Office Patent Trial Practice Guide states that with regard a reply, it “may only respond to arguments raised in the corresponding opposition,” and further states that:

While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.

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