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Paper No. 8
Entered: December 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

VELOCITY PATENTS LLC,
Patent Owner.

Case IPR2017-01723
Patent 5,954,781

Before JAMESON LEE, RAMA G. ELLURU, and CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a) and 37 C.F.R. § 42.108(c)

On July 26, 2017, Petitioner Unified Patents filed a Petition challenging claims 1, 7, 13, 17, and 60 of U.S. Patent No. 5,954,781. Paper 2. On November 8, 2017, Patent Owner Velocity Patents LLC filed a Preliminary Response. Paper 7. On December 6, 2017, Petitioner emailed the Board to request permission to file a 5-page reply to the Preliminary Response. According to Petitioner, the reply would address statements in the Preliminary Response alleging that Petitioner had implicitly invoked 35 U.S.C. § 112, ¶ 6, and failed to comply with 37 C.F.R. § 42.104(b)(3), in Petitioner's discussion of the term "processor subsystem," which appears in each of the claims challenged in the Petition. In the email requesting a reply, Petitioner stated that the Petition does not argue that § 112, ¶ 6 applies; that Patent Owner does not argue that § 112, ¶ 6 applies; and that decisions from both the Federal Circuit (*e.g.*, *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015)) and the Board (a family of cases titled *HTC America, Inc. v. Virginia Innovation Sciences, Inc.*, IPR2017-00870 through -00879) confirm that § 112, ¶ 6 does not apply.

The same day that Petitioner submitted its email, Patent Owner submitted a responsive email and requested a 5-page sur-reply if Petitioner's request to file a reply brief is granted. Patent Owner reiterated the position in the Preliminary Response that the Petition implicitly invoked § 112, ¶ 6 with respect to the term "processor subsystem" and failed to comply with 37 C.F.R. § 42.104(b)(3).

On December 13, 2017, a conference call was held with Judges Lee, Elluru, and Kennedy, and respective counsel for the parties. Petitioner maintained that § 112, ¶ 6 does not apply to the term "processor subsystem," and Patent Owner maintained that the Petition implicitly invokes § 112, ¶ 6.

Patent Owner also stated that Patent Owner does not believe that § 112, ¶ 6 applies to the term "processor subsystem."

The rules applicable to *inter partes* review do not, as of right, provide an opportunity for a petitioner to file a reply to a preliminary response. *See* 37 C.F.R. § 42.108(c). However, a petitioner "may seek leave to file a reply," and "[a]ny such request must make a showing of good cause." *Id.*

Upon consideration of the positions of the parties, we determine that Petitioner has not established good cause for further briefing. The parties agree that the term "processor subsystem" does not invoke § 112, ¶ 6. The Board is familiar with the Federal Circuit and Board decisions referenced by Petitioner. The Board can resolve the issues, including the issue of whether the Petition implicitly invoked § 112, ¶ 6, without additional briefing.

For the reasons set forth above, it is:

ORDERED that Petitioner's request for permission to file a reply brief is *denied*.

IPR2017-01723
Patent 5,954,781

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