

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMTOM, INC., Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES, LLC
Patent Owner.

Case IPR2017-02023
Patent 6,434,212

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and CHRISTA P.
ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

AMENDED SCHEDULING ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

I. BACKGROUND

On June 7, 2018, a conference call was held between counsel for the parties and Judges Stephens and Zado.

The conference call was convened to discuss changes to the Scheduling Order sought by the parties in view of our Order of May 16, 2018 (Paper 10) expanding the grounds of institution in this proceeding in light of *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). Patent Owner requests changing Due Dates 1, 2, 4, and 5 to July 13, 2018; October 5, 2018; October 26, 2018; and November 9, 2018, respectively (Exhibit 3001; see Paper 8 (Scheduling Order) and Paper 9 (Joint Stipulation to Modify the Scheduling Order)) setting forth the Due Dates in this proceeding). Petitioner opposes Patent Owner's proposed schedule changes, except for an offer to shift Due Date 1 to June 27, 2018 (*id.*). Specifically, Petitioner contends Due Date 1 and Due Date 2 have already been adjusted once (Paper 9) and Patent Owner was on notice of SAS).

II. ANALYSIS

We initially instituted trial on Petitioner's asserted ground that claims 1–5 are unpatentable under 35 U.S.C. § 103(a) over Jimenez,¹ Levi,² and “knowledge of a person having ordinary skill in the art” (Paper 1, 5–6). Our Order of May 16, 2018 expanded the trial from one ground addressing claims 1–5 to two different grounds addressing claims 1–8 (Paper 10). Specifically, we modified our decision to institute trial on Petitioner's asserted grounds

¹ Jimenez et al., U.S. Patent 4,367,752 (Ex. 1002) (hereinafter “Jimenez”)

² Levi et. al., U.S. Patent 5,583,776 (Ex. 1003) (hereinafter “Levi”)

IPR2017-02023
Patent 6,434,212

that claims 1–8 are unpatentable over (i) Jimenez, Levi, and “knowledge of a person having ordinary skill in the art” and (ii) claims 1–8 are unpatentable over Jimenez, Ebeling,³ and “knowledge of a person having ordinary skill in the art” (*id.*).

Petitioner contends that each ground has a similar first reference (Jimenez) and thus, the work required due to our Order is not significant enough to warrant Patent Owner’s proposed changes to the schedule. Petitioner further expresses concern that Patent Owner’s proposed changes to the schedule would result in only one week between Due Date 5 and Due Date 6, whereas under the current schedule there are two weeks between these due dates.

³ Ebeling et. al., U.S. Patent 6,145,389 (Ex. 1004)

We are not persuaded by Petitioner's argument based on *SAS*. The Joint Stipulation to Modify the Scheduling Order (Paper 9) was filed on April 4, 2018, *before* the Supreme Court decision in *SAS* and *before* our May 16, 2018 Order.

In our Order, we not only expanded the number of claims on which we instituted trial, but also the grounds. Thus, Patent Owner's request for more time is reasonable. Petitioner has not identified any undue prejudice it would suffer if we grant Patent Owner's request. To the extent Petitioner is concerned about having only one week, instead of two, between Due Date 5 and Due Date 6, our the amended schedule (set forth below in the Amended Due Date Appendix) maintains the original two weeks between these due dates.

In light of the foregoing, Patent Owner's request is granted and the current Scheduling Order is replaced by the Amended Due Date Appendix. We note we have amended other dates to account for the changes to Due Date 1. We have not changed Due Date 7, the date for the final argument.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the schedule set forth in the original Scheduling Order (Paper 8) as amended (Paper 9) is reset as set forth in the following Amended Due Date Appendix.

IPR2017-02023
Patent 6,434,212

AMENDED DUE DATE APPENDIX

INITIAL CONFERENCE CALL OPTIONAL

DUE DATE 1 July 13, 2018

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 October 5, 2018

Petitioner's reply to patent owner's response to petition

Petitioner's opposition to motion to amend

DUE DATE 3 October 12, 2018

Patent owner's reply to petitioner's opposition to motion to amend

DUE DATE 4 October 26, 2018

Motion for observation regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 November 9, 2018

Response to observation

Opposition to motion to exclude

DUE DATE 6 November 23, 2018

Reply to opposition to motion to exclude

DUE DATE 7 December 11, 2018

Oral argument (if requested)

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