

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner,

v.

FALL LINE PATENTS, LLC
Patent Owner.

Case IPR2018-00043
Patent 9,454,748 B2

Before MICHELLE N. WORMMEESTER, SHEILA F. McSHANE, and
JOHN R. KENNY, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

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

This Order concerns an issue that arose at the December 14, 2018 oral hearing in this case. At the oral hearing, Patent Owner raised the issue of whether the Petition properly identified all real parties-in-interest. Patent Owner raised this issue in its Preliminary Response by presenting arguments and evidence concerning the identification of Petitioner's real party in interest (PO's "Preliminary Response RPI Arguments and Exhibits"). *See*

Preliminary Response (Paper 5), 28–33; Exs. 2001–2005. Patent Owner, however, did not raise this issue during the trial: in the Patent Owner Response, Patent Owner did not present its Preliminary Response RPI Arguments, did not cite its Preliminary Response RPI Exhibits, and did not present any other arguments or evidence relating to the identification of Petitioner’s real party in interest. *See* Paper 9. At the oral hearing, Patent Owner, nevertheless, contended that it had not waived its Preliminary Response RPI Arguments by not including them in the Patent Owner Response because those arguments do not concern patentability and, thus, were not required to be raised in the Patent Owner Response under the Scheduling Order (Paper 7). Patent Owner further contended that these arguments could not be waived because a challenge to the Petition’s identification of a real party in interest is not waivable. Patent Owner, at the oral hearing, presented arguments on the issue of real party in interest, with Petitioner objecting based on waiver.

At the oral hearing, Patent Owner argued that Patent Owner’s Preliminary Response RPI Arguments and Evidence should be considered, presented additional arguments concerning real party in interest at the oral hearing with associated demonstratives, and asserted that these arguments and evidence should be addressed in our Final Written Decision. Petitioner disagreed, but requested that, in light of Patent Owner’s failure to raise the issue of real party in interest in its Response, Petitioner should be given an opportunity to respond to Patent Owner’s RPI Arguments and Evidence, if we were to consider those arguments and evidence.

At the oral hearing, we indicated that we were not persuaded by Patent Owner’s contentions regarding waiver. Nevertheless, we now

authorize Patent Owner, if it wishes, to file a Motion, of no more than five pages, requesting that we address, in our Final Written Decision, the Preliminary Response RPI Arguments and Exhibits and the arguments regarding real party in interest Patent Owner made at the oral hearing with the associated demonstratives. The Motion shall only (i) address Patent Owner's request that we consider its Preliminary Response RPI Arguments and Exhibits and the arguments regarding real party in interest that Patent Owner made at the oral hearing and set forth in its demonstratives; and (ii), if Patent Owner desires, further address the case law Patent Owner presented at the oral argument and in its demonstratives concerning real party in interest as applied to this case. No new evidence shall be filed with the Motion.

Given the late stage of the proceedings, expedited briefing is required. If Patent Owner elects to file the Motion, it shall, via email, notify Petitioner of its intent to file this Motion within fourteen days¹ from the issuance of this Order. Patent Owner's Motion shall be due within twenty-one days from the issuance of this Order.

Petitioner may file an Opposition to Patent Owner's Motion, of no more than five pages, within forty-two days from the issuance of this Order. No reply to Petitioner's Opposition to Patent Owner's Motion is authorized. We recognize that Petitioner did not have an opportunity to respond to Patent Owner's Preliminary Response RPI Arguments and Exhibits in its Reply to Patent Owner's Response (Paper 10). Given the late stage of the proceedings, we do not anticipate ruling on Patent Owner's Motion prior to

¹ The term "days" refers to calendar days.

the issuance of a Final Written Decision. Thus, if the Motion is filed, Petitioner is authorized to file a Reply to Patent Owner's Preliminary Response RPI Arguments and Exhibits ("RPI Reply"), of no more than ten pages, responding only to (i) Patent Owner's Preliminary Response RPI Arguments and Exhibits, (ii) the arguments regarding the issue of real party in interest that Patent Owner presented at the oral hearing and in Patent Owner's demonstratives addressing real party in interest; and (iii) any further elaboration Patent Owner provides in its Motion addressing the case law it cited at oral hearing and in its demonstratives concerning the real party in interest. The RPI Reply shall be filed within forty-two days from the issuance of this Order. Patent Owner shall have two days from the filing of the RPI Reply to serve any objections under 37 C.F.R. § 41.155(b)(1) to any new evidence submitted with the RPI Reply. Petitioner shall have four days from the filing of those objections to serve and file any supplemental evidence under 37 C.F.R. § 41.155(b)(2).

If Petitioner relies upon new testimonial evidence in the RPI Reply, Patent Owner may cross examine the declarant(s) concerning that testimonial evidence. *See* 37 C.F.R. § 41.157. Patent Owner also may file RPI Observations concerning that RPI cross examination within twenty-one days of the filing of the RPI Reply. The Scheduling Order sets forth the requirements for observations and responses and the permissible dates for cross examination. Paper 7, 5. Patent Owner shall file the transcripts of its RPI cross examinations with its RPI Observations, and, in light of the late presentation of the RPI issue, Patent Owner shall be responsible for the court reporter fees for the RPI cross examinations.

Petitioner may file responses to the RPI Observations and, if necessary, any errata sheets for the cross examinations within seven days of the filing of the RPI Observations.

It is hereby ORDERED:

If Patent Owner decides to file the Motion, it shall notify Petitioner via email of its intent to file this Motion within fourteen days from the issuance of this Order.

Patent Owner shall have twenty-one days from the issuance of this Order to file the Motion. The Motion will be no more than five pages. If Patent Owner files the Motion, Petitioner shall have forty-two days from the issuance of this Order to file (a) an Opposition to the Motion of no more than five pages and (b) an RPI Reply, of no more than ten pages. No reply to Petitioner's Opposition to the Motion is authorized.

Patent Owner shall have two days from the filing of the RPI Reply to file any objections to any new evidence submitted with the RPI Reply. Petitioner shall have four days from the filing of those objections to serve and file any supplemental evidence.

If Petitioner cites new testimonial evidence in the RPI Reply, Patent Owner may (i) cross examine the declarant(s) about that testimonial evidence and (ii) within twenty-one days of the filing of the RPI Reply, file Observations about those RPI cross examinations, Patent Owner shall file transcripts for any RPI cross examinations with its RPI Observations.

If Patent Owner files RPI Observations, Petitioner shall have seven days from the filing of those observations to file responses to those RPI Observations and any errata sheets for the RPI cross examinations.

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