

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018-00817 (Patent 9,445,251 B2)
Case IPR2018-00818 (Patent 9,408,055 B2)
Case IPR2018-00821 (Patent 8,213,970 B2)¹

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO,
and KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this style of caption without prior authorization.

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IPR2018-00818 (Patent 9,408,055 B2)
IPR2018-00821 (Patent 8,213,970 B2)

On July 26, 2018, Apple, Inc. (“Petitioner”) sent an e-mail to the Board requesting a conference call to discuss its request to file a reply, in each of the three above-captioned proceedings (“Instant Proceedings”), to AGIS Software Development, LLC’s (“Patent Owner”) Preliminary Response.

During the conference call on August 3, 2018, Petitioner requested authorization to file a reply addressing the allocation of burdens of proof with regard to the effective priority dates of the patents challenged in IPR2018-00817 and IPR2018-00818. However, during the conference call, Petitioner withdrew its request with regard to this issue in light of the case law cited in the Petitions in those proceedings.

During the conference call, Petitioner also requested authorization to file a reply in each of the Instant Proceedings to address the applicable legal standard to satisfy the requirements under 37 C.F.R. § 42.104(b)(3) to set forth how the challenged claims are to be construed. *See* 37 C.F.R. § 42.104(b)(3). Patent Owner asserts in the Preliminary Response in each of the Instant Proceedings that Petitioner must have a subjective belief that the construction set forth in the Petition is correct under applicable law. Petitioner asserts that Patent Owner is using an incorrect legal standard. Patent Owner objects to Petitioner’s request for a reply.

We determine that under the circumstances presented here, Petitioner has made a showing of good cause, and we, therefore, authorize Petitioner’s request to file a reply in each of the Instant Proceedings. *See* 37 C.F.R. § 42.108(c). The Preliminary Responses raise the issue of whether a Petitioner must have a subjective belief that the claim constructions

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presented in the Petition are correct. *See, e.g.*, IPR2018-00821, Paper 6, 17, 22. The Board finds it may be helpful if Petitioner provides legal authority on this issue. Petitioner's reply is limited to two (2) pages, and is limited to providing the Board with legal authority relevant to the standard to satisfy the requirements under 37 C.F.R. § 42.104(b)(3). The reply may not include evidence or argument, other than citation to legal authority, and may not address any factual issues.

It is

ORDERED that Petitioner's request to file a reply under 37 C.F.R. § 42.108(c), in each of the Instant Proceedings, to Patent Owner's Preliminary Response, is *granted*;

FURTHER ORDERED that the reply is not to exceed two (2) pages, and must be filed no later than August 10, 2018; and

FURTHER ORDERED that the reply is limited to providing the Board with legal authority relevant to the legal standard to satisfy the requirements under 37 C.F.R. § 42.104(b)(3). The reply may not include evidence or argument, other than citation to legal authority, and may not address any factual issues.

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