Trials@uspto.gov
571-272-7822

Paper 28
Entered: December 3, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC.,
Petitioner,
v.
CELLSPIN SOFT, INC.,
Patent Owner.

IPR2019-00127
Patent 9,258,698 B2

PANASONIC CORPORATION OF NORTH AMERICA *et al.*,
Petitioners,
v.
CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-00131
Patent 9,258,698 B2

GOPRO, INC., GARMIN INT'L, INC., AND GARMIN USA, INC.,
Petitioners,
v.
CELLSPIN SOFT, INC.,
Patent Owner.

IPR2019-01107
Patent 9,258,698 B2

GOPRO, INC., GARMIN INT'L, INC., AND GARMIN USA, INC.,
Petitioners,
v.
CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-01108
Patent 9,258,698 B2[1]

Before GREGG I. ANDERSON, DANIEL J. GALLIGAN, and STACY B. MARGOLIES, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

A joint conference call for all of the above-captioned proceedings (respectively "'127 IPR," "'131 IPR," "'1107 IPR," "'1108 IPR") was held on November 26, 2019. Judges Anderson, Galligan, and Margolies participated along with counsel for petitioners Canon U.S.A., Inc. ('127 IPR), Panasonic Corporation of North America *et al*. ('131 IPR), GoPro, Inc. and Garmin Int'l, Inc. *et al*. ('1107 and '1108 IPRs) (collectively "Petitioners"), and Cellspin Soft, Inc. ("Patent Owner"). The call was requested in an email dated November 24, 2019, from Patent Owner. In the email, Patent Owner requested a briefing schedule for filing a Response to the Institution

[1] This caption is not authorized for use by the parties.

Decisions ("Decisions") filed in the '1107 and '1108 IPRs. '1107 IPR, Paper 19; '1108 IPR, Paper 15.

During the call, it was determined that Patent Owner misunderstood the claim construction standard that applies in the joined proceedings. Patent Owner understood that the claim construction standard of *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) would be applied to further proceedings regarding the '1107 and '1108 IPRs. This is contrary to the Decisions, in which we explained that the broadest reasonable interpretation ("BRI") standard would be applied to the joined proceedings. '1107 IPR, Paper 19, 9–10 n.11, 29; '1108 IPR, Paper 15, 8 n.6, 35. The preceding portions of the Decisions were identified for Patent Owner. The Board restated that the '1107 and '1108 IPR Petitioners are now joined respectively to the '127 and '131 IPRs under the BRI standard for claim construction. *See, e.g.*, '1107 IPR, Paper 19, 29 (stating that "the '1107 Petitioners are joined as parties to the '127 IPR, in which the BRI claim construction standard applies").

After confirming its misunderstanding, Patent Owner stated that it would not need to file Responses to the petitions in the '1107 and '1108 IPRs. Patent Owner's request for a briefing schedule is therefore moot.

Patent Owner stated it may want to file an objection to proceeding under BRI. Patent Owner was directed to the Decisions for the requirements for filing any paper not authorized by the governing statute or rules. *See* '1107 IPR, Paper 19, 26 n.23; '1108 IPR, Paper 15, 33 n.19. Petitioners had nothing further to add. No order is made in connection with the call.

’127 PETITIONER:

Jared Newton
QUINN EMANUEL URQUHART & SULLIVAN
jarednewton@quinnemaneul.com

’131 PETITIONER:

Timothy V. Pearce, Jr.
Christopher J. Higgins
ORRICK, HERRINGTON & SUTCLIFFE LLP
tvpptabdocket@orrick.com
0chptabdocket@orrick.com

’1107, ’1108 PETITIONER:

David Xue
RIMÔN LAW
david.xue@rimonlaw.com

Jennifer C. Bailey
Adam P. Seitz
ERISE IP, P.A.
jennifer.bailey@eriseip.com
adam.seitz@eriseip.com

PATENT OWNER:

John J. Edmonds
Stephen F. Schlather
EDMONDS & SCHLATHER, PLLC
pto-edmonds@ip-lit.com
sschlather@ip-lit.com

Eric Carr
COLLINS EDMONDS & SCHLATHER, PLLC
ecarr@ip-lit.com