

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION and
PANASONIC CORPORATION OF NORTH AMERICA,
Petitioner,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-00131
Patent 9,258,698 B2

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. § 42.108(c)

INTRODUCTION

A telephone conference call in the above captioned case was held on February 25, 2019. Counsel for Panasonic Corporation and Panasonic Corporation of North America (“Petitioner”), counsel for Cellspin Soft, Inc. (“Patent Owner”), and Judges Anderson, Galligan, and Margolies participated. Petitioner retained a court reporter who transcribed the call.

The call was held at the request of Petitioner. *See* Ex. 3001 (email dated February 14, 2019). Petitioner sought authorization to file a reply brief to the Patent Owner’s Preliminary Response (“Prelim. Resp.,” Paper 7). In its Preliminary Response, Patent Owner argues that all of the challenged claims “have been held unpatentable” by a district court and “[b]ecause the Petition was filed on an *already invalidated* patent, Petitioner fails to show . . . standing for institution.” Prelim. Resp. 42. If authorized, Petitioner represented “the reply would be limited to addressing the lack of standing argument.” Ex. 3001. Patent Owner is appealing the district court decision to the Federal Circuit. *Id.* (citing Prelim. Resp. 42). The parties reported that oral argument on the appeal to the Federal Circuit will be held on April 5, 2019.

DISCUSSION

On the call, Petitioner argued that the standing issue is a legal issue and that the authority cited in the Preliminary Response does not support denial of the Petition for *inter partes* review. Patent Owner opposed authorizing a reply, arguing that Petitioner has been on notice of the standing issue and has not shown good cause.

Patent Owner has not identified any prejudice to it in allowing the relief requested. A decision on institution is not due until April 30, 2019.

Case IPR2019-00131
Patent No. 9,258,698

Patent Owner's entire argument on the standing issue is less than a page in length. *See* Prelim. Resp. 42. The status of the appeal of the district court ruling may impact the course of this proceeding.

On the call, Petitioner requested it be authorized to file a three page reply. Petitioner also confirmed that the reply could be filed on or before March 4, 2019. Because of the narrow issue presented and the brevity and timing of the reply, this proceeding will not be unduly delayed.

Under the circumstances presented here, we authorize the filing of a reply to the standing issue. *See* 37 C.F.R. § 42.108(c).

ORDER

It is

ORDERED that on or before March 4, 2019, Petitioner may file a reply to the Preliminary Response limited to the issue of standing as set forth at page 42 of the Preliminary Response;

FURTHER ORDERED that the Reply will be limited to three (3) pages, and no new evidence shall be introduced;

FURTHER ORDERED that no sur-reply is authorized at this time;

FURTHER ORDERED that Petitioner will file the transcript of the call as an exhibit in this case; and

FURTHER ORDERED that the parties will inform the Board of any further developments in the appeal to the Federal Circuit.

PETITIONER:

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