

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN MULTI-CINEMA, INC.; AMC ENTERTAINMENT HOLDINGS, INC.; BOSTON MARKET CORPORATION; MOBO SYSTEMS, INC.; MCDONALD'S CORPORATION; MCDONALD'S USA; PANDA RESTAURANT GROUP, INC.; PANDA EXPRESS INC.; PAPA JOHN'S INTERNATIONAL, INC.; STAR PAPA LP; and PAPA JOHN'S USA, INC.

Petitioner,

v.

FALL LINE PATENTS, LLC
Patent Owner.

Case IPR2019-00610
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

Via email, the parties requested a teleconference regarding the remand from the Federal Circuit. Ex. 3004. With their request, the parties submitted a joint proposal for additional briefing. *Id.* On December 17, 2021, we held

the requested teleconference with the parties. Ricardo Bonilla and Robert Reckers appeared on behalf of Petitioner. Matthew Antonelli appeared on behalf of Patent Owner.

During the teleconference, the parties disputed the scope of the briefing to be authorized. Patent Owner argued the briefing should be limited to the prior art teachings related to limitation 7(b). Petitioner argued that the briefing should also include issues related to limitation 7(f).

Patent Owner asserted that there would be no need to address limitation 7(f) because the Federal Circuit did not provide guidance on that limitation. Further, Patent Owner expressed concern that the new briefing would only be used to present new arguments. Petitioner argued that it would be helpful to address limitation 7(f) in order to address all issues that may later be the subject of appeal to the Federal Circuit and additionally asserted that it would not present new arguments on that limitation.

We will limit the authorized briefing to limitation 7(b). At this time, we see no need for further briefing on limitation 7(f) because we have not received any guidance from the Federal Circuit on that limitation, other than the instruction to address it if we alter our conclusion regarding limitation 7(b).

During the teleconference, we addressed briefing of the term “executable.” *See AMC Multi-Cinema, Inc. v. Fall Line Patents, LLC*, 2021-1051, 2021 WL 4470062 at *8 (Fed. Cir. Sep. 30, 2021). We noted that the parties may want to consider the definitions provided by the Microsoft

Computer Dictionary (5th Ed. 2002).¹ One party indicated that there may not be a disagreement regarding the meaning of that term.

After considering the parties' joint proposal and arguments, we set the following schedule for additional briefing:

(i) within two weeks from the issuance of this Order, the parties shall meet and confer regarding the meaning of the term "executable";

(ii) within three weeks from the issuance of this Order, the parties shall submit a joint paper setting forth their proposed definitions for the term "executable." If all parties are in agreement on a definition, the agreed-upon definition shall be included. If there is no agreement, the joint paper shall set forth each side's proposed definition, with citations to support for that definition. The parties may cite and submit new non-testimonial exhibits to support their proposed definitions. Any new exhibits, however, may only be submitted for the purpose of defining the term "executable" and will not be considered for other purposes. Arguments concerning a disputed definition should not be included in the joint paper;

(iii) within four weeks from the issuance of this Order, each side shall file an opening brief of no more than ten pages addressing the Federal Circuit's remand decision regarding limitation 7(b). Each opening brief may also address any proposed definition for "executable" and the definitions for that term in Exhibit 3005; and

(iv) within six weeks from the issuance of this Order, each side may file a responsive brief of no more than ten pages responding to the other side's opening brief.

¹ Exhibit 3005 includes these definitions.

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The parties may not submit any new exhibits, other than non-testimonial exhibits used to support a definition of the term “executable.” Further, the parties may not make any new arguments regarding the underlying issues of patentability.

It is so ORDERED.

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