

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA, INC.  
Petitioner

v.

PI-NET INTERNATIONAL, INC.  
Patent Owner

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Case CBM2014-00018  
Patent 8,037,158

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Before KARL D. EASTHOM, JONI Y. CHANG, and  
BRIAN J. McNAMARA.

McNAMARA, *Administrative Patent Judge.*

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

On October 21, 2013, SAP America, Inc. (Petitioner) filed a Petition For Covered Business Method Patent Review of claims 4-6 and 9-10 of U.S. Patent 8,037,158 (the '158 Patent).<sup>1</sup> On November 4, 2013, a telephone conference was held with the parties concerning CBM2014-00018 and Petitioner's Motion For Joinder with CBM2013-00013.

The '158 Patent is the subject of CBM2013-00013 in which Petitioner challenged the patentability of claims 1-6 and 11 of the '158 Patent. CBM2013-00013, Corrected Petition For Covered Business Method Patent Review, Paper No. 7. In CBM2013-00013, the Board instituted a trial on Petitioner's challenges to all the challenged claims on various grounds, but on the basis that the cited references did not disclose the claimed limitation of object routing, the Board declined to institute a trial on Petitioner's challenges to claims 4-6 under 35 U.S.C. § 101 and 35 U.S.C. § 103. *Id.*, Decision To Institute, Paper No. 15.<sup>2</sup> On October 15, 2013, the Board denied Petitioner's request for rehearing on Petitioner's challenges to claims 4-6 under 35 U.S.C. § 103. *Id.*, Decision Denying Request For Rehearing, Paper No. 23.

The Petition For Covered Business Method Patent Review in CBM2014-00018 (Petition) cites additional references as a basis for challenging the patentability of claims 4-6 of the '158 Patent under 35 U.S.C. § 103. Pet. 10-11. The Petition also contends, for the first time, that claims 9 and 10 of the '158 Patent do not recite statutory subject matter under 35 U.S.C. § 101. *Id.* at 10.

In CBM2014-00018, Petitioner timely filed a Motion For Joinder with CBM2013-00013, arguing that, while the Petition introduces new prior art, its

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<sup>1</sup> A Corrected Petition filed on October 31, 2013 is under review.

<sup>2</sup> In CBM2013-00013, the Board instituted a trial on Petitioner's challenges to claims 4-6 under 35 U.S.C. § 112(b).

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proposed challenges are based on the Board's claim interpretation in CBM2013-00013 and that claims 9 and 10 are similar to claim 11.

During the teleconference, the relationship between the challenges in each case and the status of CBM2013-00013 were discussed. In CBM2013-00013, the parties have already agreed to delay the date for the Patent Owner Response and Motion To Amend (Due Date 1) from December 20, 2013 to January 3, 2014 and the date for Petitioner to file a Reply To The Patent Owner Response and/or an opposition to a Motion To Amend from March 20, 2014 to April 3, 2014. CBM2013-00013, Stipulated Motion To Adjust Dates, Paper No. 27. The parties have also stipulated to the same extension in related IPR2013-00194, Paper No. 25, and IPR2013-00195, Paper No. 19, which involve different patents and are on the same schedule as CBM2013-00013.

Times set by rules are default and may be modified by order of the Board, taking into account applicable statutory pendency goals. 37 C.F.R. § 42.5(c)(1). During the teleconference, the Board proposed setting an expedited date of November 25, 2013 for Pi-Net International, Inc. (Patent Owner) to file a Patent Owner Preliminary Response and an Opposition to Petitioner's Motion For Joinder in CBM2014-00018, if Patent Owner so chooses. Patent Owner noted that the newly cited prior art is lengthy, that the Petition includes a new 76 page declaration, the technical issues are complex and Patent Owner's resources are limited. In view of these circumstances Patent Owner requested 3 months to file a Patent Owner Preliminary Response.

A review of the record indicates that Petitioner's new challenges to claims 4-6 assert art Petitioner previously asserted in CBM2013-00013 in combination with additional art to address claim limitations related to object routing. While the Exhibits attached to the Petition are somewhat lengthy, the subject matter of the challenges is relatively focused to a few issues. Much of the first 44 pages of

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Dr. Sirbu's new 76 page declaration relates to the previously asserted prior art. Petitioner's challenges to claims 9 and 10 under 35 U.S.C. § 101 are similar to challenges Petitioner asserted in CBM2013-00013 against claim 11. In addition, during the call, the parties noted that the corresponding district court litigation has been stayed. In view of these circumstances, an expedited date for the Patent Owner Preliminary Response and an Opposition to Petitioner's Motion For Joinder is not unduly burdensome.

The trial in CBM2013-00013, which includes other challenges to claims 4-6, is currently scheduled to coincide with the trial in IPR2013-00194 and IPR2013-00195. There is no basis for extending these *inter partes* reviews. However, there is a strong rationale for maintaining the schedule for CBM2013-00013 consistent with IPR2013-00194 and IPR2013-00195, because the patents are related. During the teleconference, both parties discussed that joinder of CBM2014-00018 with CBM2013-00013 might be appropriate, although no agreement was reached. A realistic consideration of the possibility of joinder requires setting the date for Patent Owner Preliminary Response to be slightly more than one month from now.

Inconsideration of the above,

It is ORDERED that Patent Owner may file a Patent Owner Preliminary Response not later than December 9, 2013;

It is FURTHER ORDERED that Patent Owner may file an Opposition to Petitioner's Motion For Joinder with CBM2013-00013 not later than December 9, 2013.

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