

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A., PNC FINANCIAL SERVICES, INC.,
and PNC BANK, N.A.,
Petitioners,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case CBM2014-00028 (Patent 8,083,137)
Case CBM2014-00029 (Patent 7,664,701)
Case CBM2014-00030 (Patent 7,603,382)
Case CBM2014-00031 (Patent 6,182,894)
Case CBM2014-00032 (Patent 7,757,298)
Case CBM2014-00033 (Patent 7,260,587)¹

Before THOMAS L. GIANNETTI, HYUN J. JUNG, and
GREGG I. ANDERSON, Administrative Patent Judges.

ANDERSON, Administrative Patent Judge.

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

¹ This Order addresses issues common to all these cases. The parties are not authorized to use this caption for any subsequent papers without authorization from the Board.

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A telephone conference in the above proceedings was held on February 7, 2014. Present on the phone call were respective counsel for Petitioners and Patent Owner, and Judges Giannetti, Jung, and Anderson. Patent Owner arranged for a court reporter and will file the transcript with the Board when it is available.

Patent Owner requested the conference call to seek authorization to file motions for time extensions in all six cases. The motions would extend time to file the Patent Owner's preliminary response, currently due on February 25, 2014, in each case. The motion would extend time to some unspecified date after the decision of the Supreme Court of the United States in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l.*, Case No. 13-298 ("*CLS Bank*"). The issue before the Supreme Court in *CLS Bank* is whether claims to computer-implemented inventions are directed to patent-eligible subject matter within the meaning of 35 U.S.C. § 101. Oral argument is set for March 31, 2014, and a decision is expected by the end of June, 2014. For the reasons that follow, Patent Owner's request is denied.

Patent Owner stated that the Supreme Court's decision would be helpful to the Board in deciding how to proceed in the case, and that it would benefit the parties as well. Patent Owner represented that there are eleven cases before the Board where 35 U.S.C. § 101 is the only ground of unpatentability asserted in the petition, and a Patent Owner preliminary statement has not yet been filed. Therefore, a time extension in the six cases here would not have a significant impact on other cases before the Board, at least according to Patent Owner. The requested extensions would be in place prior to filing of the preliminary response; thus the three-month deadline under 35 U.S.C. § 324(c) for deciding whether to institute trial would not be jeopardized.

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The Board pointed out that should trials be instituted here, according to the schedule presented by Patent Owner, the *CLS Bank* Supreme Court decision would be available prior to final decisions, and therefore, the parties and the Board could have the benefit of the decision at that time. Patent Owner agreed that this is a likely scenario.

Petitioners responded that they do not agree to an extension as it would delay the proceedings at least 4-5 months. Petitioners pointed out that there has been some development of the case law since the Federal Circuit's en banc decision in *CLS Bank*, placing the Board in a position to determine whether a trial should be instituted. Petitioners agreed that if there is a change in the law as a result of the Supreme Court's ruling, there will be ample time to address that before the Board's final decision. It is, therefore, not necessary to delay further.

DISCUSSION

Our rules and practices are formulated to expedite proceedings. Thus, 37 C.F.R. § 42.1(b) provides that the rules “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” And 37 C.F.R. § 42.107(b) sets a three-month time limit for filing the preliminary response by the Patent Owner. To waive these rules requires a showing of good cause. *See* 37 C.F.R. § 42.5(b); IPR2013-00584, Paper 20, at 4 (requiring a showing of special circumstances to waive one month time limit for joinder under 37 C.F.R. § 42.122(b)). We do not see how this standard is met here. We are not persuaded that these proceedings will benefit by waiting for the Supreme Court's decision in *CLS Bank*. We are informed by Patent Owner that a district court has stayed a case waiting for the Supreme Court's decision in *CLS Bank*. On the other hand, the

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Federal Circuit has continued to decide cases under 35 U.S.C. § 101 without waiting for the *CLS Bank* decision from the Supreme Court. *See, e.g., Smartgene, Inc. v. Advanced Biological Labs.* No. 2013-1186, 2014 WL 259824 (Fed. Cir. Jan. 24, 2014) (non-precedential) (method, system and computer program claims not patent eligible).

The circumstances here do not justify a 4-5 month delay in these proceedings. The effect of the Supreme Court's decision in *CLS Bank* on the proceedings is uncertain. And in any event, the Board is likely to have the benefit of the Supreme Court's decision before reaching the final decision in the proceedings, should trials be instituted.

ORDER

In view of the above, it is hereby ORDERED that Patent Owner's request for authorization to file motions seeking an extension to file preliminary responses to the petitions in these cases is denied.

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