

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEXTEL OPERATIONS, INC., SPRINT SPECTRUM L.P., BOOST MOBILE,  
LLC AND VIRGIN MOBILE USA, L.P.,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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Case CBM2016-00052  
Patent 5,339,352

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Before GEORGIANNA W. BRADEN, FRANCES L. IPPOLITO, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on July 15, 2016 between Robert C. Hilton and Rachelle H. Thomson for Petitioner, Lori A. Gordon and Robert E. Sokohl for Patent Owner, and Judges Braden, Cherry, and Ippolito. The call was initiated by Petitioner to request authorization to file supplemental information. Specifically, Petitioner seeks to file rebuttal invalidity statements made by Patent Owner's expert in a related district court litigation. According to Petitioner the statements made by Patent Owner's expert support Petitioner's position that the claims challenged in its Petition in CBM2016-00052 are directed a financial activity, thus, the claims qualify for a covered business method review. Patent Owner opposes Petitioner's request and explained that the statements by Patent Owner's expert are duplicative to statements in the specification and prosecution history of U.S. Patent No. 5,339,352.

The panel and the parties discussed whether there was authority under 37 C.F.R. § 42.223(a) for submission of supplemental information prior to the institution of a trial proceeding. The panel determined that, in this circumstance, there was no authority under the rules for such a submission.

Therefore, it is

ORDERED that Petitioner's request to file supplemental information prior to the institution of a trial proceeding is denied.

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