

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.
Petitioner

v.

PARALLEL IRON, LLC
Patent Owner

Case IPR2013-00639
Patent 7,197,662 B2

Before MEREDITH C. PETRAVICK, BRYAN F. MOORE, and
JENNIFER S. BISK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

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

INTRODUCTION

A conference call was held on January 21, 2014, between respective counsel for the parties and Judges Bisk, Moore, and Petravick. Counsel for Petitioner initiated the conference call to request authorization to file a reply to Patent Owner's preliminary response, prior to the Board's deciding whether to institute review. The conference call was transcribed by a court reporter arranged by Petitioner.

DISCUSSION

The Patent Owner's preliminary response asserts that Petitioner failed to identify NetApp, Inc. as a real party-in-interest. According to Patent Owner, because NetApp, Inc. is a real party-in-interest which had been served, on June 21, 2012, with a complaint alleging infringement of Patent 7,197,662 B2, Petitioner's petition is barred by the one-year time bar under 35 U.S.C. § 315(b). Paper 8 at 12. Petitioner seeks an opportunity to respond to Patent Owner's assertion that NetApp, Inc. is a real party-in-interest, prior to the Board deciding whether to institute review.

No rule automatically provides for a reply to a Patent Owner's preliminary response. Where appropriate, however, the Board may authorize the filing of such a reply. *See* 37 C.F.R. § 42.5(a). Counsel for Petitioner indicated that the Petitioner is not without opportunity to address the issue concerning whether the petition is barred under 35 U.S.C. § 315(b) and whether NetApp, Inc. is a real party-in-interest, if the Board institutes *inter partes* review. Counsel for Petitioner explained that Petitioner's concern is that based on Patent Owner's unilateral assertion on these issues, the Board would regard NetApp, Inc. as a real party-in-interest and treat the petition as barred under 37 C.F.R. § 315(b).

The Board indicated that on the issue of whether the petition is barred under 35 U.S.C. § 315(b), Petitioner does have a right to respond prior to any denial of the Petition on the basis of 35 U.S.C. § 315(b), but no such reply is necessary at this time.

CONCLUSION

It is

ORDERED that Petitioner is not authorized to file a reply to Patent Owner's preliminary response;

FURTHER ORDERED that if the Board deems necessary to consider a reply from Petitioner regarding whether the petition is barred under 35 U.S.C. § 315(b), prior to rendering a decision on whether to institute *inter partes* review, the parties will be notified by the Board; and

FURTHER ORDERED that Petitioner shall file a copy of the conference call transcript as an exhibit as soon as it is available.

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