

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SECURUS TECHNOLOGIES, INC.,
Petitioner,

v.

JOHN D. PROFANCHIK, SR.,
Patent Owner.

Case IPR2016-00268
Patent 8,315,367 B2

Before KEVIN F. TURNER and GEORGIANNA W. BRADEN,
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 August 16, 2016 between Jason E. Stach and Kevin D. Rodkey for Petitioner, Brian C. McCormack and Charles Lu for Patent Owner, and Judges Braden and Turner. The call was initiated by Patent Owner to inform the Board that it will not file a Patent Owner's Response or otherwise continue participating in this proceeding. Although Patent Owner does not plan to participate in the proceeding, it does not concede the unpatentability of the challenged claims, it is not cancelling the challenged claims, and it is not requesting adverse judgment under 37 C.F.R. 42.73(b).

We informed Petitioner that Patent Owner's participation is not required for the proceeding to continue, because Petitioner bears the burden to show by a preponderance of the evidence that the challenged claims are unpatentable. *See* 35 U.S.C. § 316(e). The burden of proof never shifts to Patent Owner. *See In re Magnum Oil Tools Int'l, Ltd.*, No. 2015-1300, slip op. at 25 (Fed. Cir. July 25, 2016); *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review). We also informed Petitioner that due to Patent Owner's withdrawal from the proceeding, we will not hold an oral hearing and the proceeding will be decided based on the briefing.

Accordingly, unless the parties either (i) settle their dispute and file settlement agreements with the Board as required under 35 U.S.C. § 317(b), or (ii) Petitioner files a request for adverse judgment under 37 C.F.R. 42.73(b) indicating that it is abandoning the proceeding, then a Final Written Decision will issue by the statutory deadline. *See* 35 U.S.C. § 318. Any filings under 35 U.S.C. § 317(b) or 37 C.F.R. 42.73(b) should be received by the Board no later than November 18, 2016, to potentially avert the issuance a Final Written Decision.

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It is

ORDERED that Patent Owner is not required to participate in the instant proceeding;

FURTHER ORDERED that Due Date 7 listed the Scheduling Order (Paper 12) is cancelled; and

FURTHER ORDERED that the parties are required to submit any filings under 35 U.S.C. § 317(b) or 37 C.F.R. 42.73(b) to the Board no later than November 18, 2016 to potentially prevent the issuance of a Final Written Decision.

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