Trials@uspto.gov
Tel: 571-272-7822

Paper 11
Entered: June 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., SAMSUNG ELECTRONICS CO. LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

ROSETTA-WIRELESS CORPORATION,
Patent Owner.

Case IPR2016-00616 (Patent 7,149,511 B1)
Case IPR2016-00622 (Patent 7,149,511 B1)[1]

Before JUSTIN T. ARBES, PATRICK R. SCANLON, and JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

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

[1] This Order pertains to both of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On June 14, 2016, a conference call was conducted between respective counsel for the parties and Judges Arbes, Scanlon, and Hudalla. Petitioner was represented by Megan Raymond, Anish Desai, and Brian Ferguson. Patent Owner was represented by Miranda Jones, Allan Bullwinkel, and Michael Ng. This call dealt with Petitioner's request for authorization to submit a reply in each case to Patent Owner's Preliminary Response. Patent Owner opposes Petitioner's request.

Generally, a petitioner is not authorized to file a reply to a patent owner preliminary response. *See* 37 C.F.R. § 42.108(c). In this case, Petitioner seeks to file a reply in each case in order to respond to certain claim term constructions proposed by Patent Owner in the Preliminary Response papers. Petitioner did not propose constructions of these terms in the Petitions, as it could have under 37 C.F.R. § 42.104(b)(3), and Petitioner contends that Patent Owner's proposed constructions were unforeseeable. Yet patent owners in their preliminary responses commonly seek construction of terms that were not addressed by a petitioner in a corresponding petition. We are not persuaded by Petitioner's arguments that Patent Owner's proposed constructions were unforeseeable, and the mere fact that Patent Owner seeks construction of a different set of claim terms, or that Petitioner does not agree with the arguments behind Patent Owner's proposed constructions of these different terms, does not strike us as worthy of additional briefing.

Petitioner also seeks to file a reply in Case IPR2016-00622 to respond to Patent Owner's arguments on whether the Goggin reference qualifies as prior art to the challenged patent. Petitioner foresaw that qualifying Goggin as prior art would be an issue in this case, because Petitioner filed a

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declaration and other exhibits in support of the alleged prior art status of Goggin (and certain other references). *See* Case IPR2016-00622, Ex. 1029 ¶¶ 10–20.[2] In its Preliminary Response, Patent Owner argues that Petitioner has not made a threshold showing that Goggin qualifies as prior art. *See* Case IPR2016-00622, Paper 8, 28–32. Petitioner now seeks to respond to Patent Owner's arguments in a reply to the Preliminary Response.

Although the Petition only makes brief mentions of Goggin's status as prior art, Petitioner's supporting declaration indicates Petitioner's cognizance of the issue. *See* Case IPR2016-00622, Ex. 1029. And, in any event, Petitioner was required to set forth in the Petition the specific statutory grounds for its challenge under 37 C.F.R. § 42.104(b)(2). In our view, the fact that Petitioner may now wish to respond to Patent Owner's arguments—and to potentially augment the basis of its prior art showing—does not warrant additional briefing on this issue.[3]

Based on the record before us, we determine that Petitioner has not demonstrated good cause for us to deviate from the normal briefing procedure for these proceedings. *See* 37 C.F.R. § 42.108(c). Accordingly,

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[2] Petitioner filed Exhibit 1029 with certain lettered "exhibits" as a single document. The parties are reminded that individual documents must be filed as separate exhibits, numbered sequentially in the appropriate range. *See* 37 C.F.R. § 42.63.

[3] Patent Owner argued during the call that Petitioner is seeking, in effect, to change its asserted basis for qualifying Goggin as prior art from 35 U.S.C. § 102(b) to 35 U.S.C. § 102(a). *See* Case IPR2016-00622, Paper 4, 15 (arguing that Goggin "is prior art under at least pre-AIA § 102(b)"). Petitioner, however, did not seek authorization to file a motion to correct the Petition as containing a "clerical or typographical mistake" under 37 C.F.R. § 42.104(c).

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Petitioner is not authorized at this time to file replies to Patent Owner's Preliminary Response papers in these cases.

Accordingly, it is

ORDERED that Petitioner's request for authorization to submit a reply in each case to Patent Owner's Preliminary Response is *denied*.

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PETITIONER:

Brian Ferguson
Brian.ferguson@weil.com

Megan Raymond
Megan.raymond@ropesgray.com

Anish Desai
Anish.desai@weil.com

PATENT OWNER:

Miranda Jones
mjones@hpcllp.com

Michael Heim
mheim@hpcllp.com

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