

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RICOH AMERICAS CORP.,
Petitioner,

v.

ROUND ROCK RESEARCH LLC,
Patent Owner.

Cases IPR2016-00635 (Patent 6,147,405)
IPR2016-00637 (Patent 6,455,935)
IPR2016-00639 (Patent 6,828,683)
IPR2016-00640 (Patent 6,358,801)
IPR2016-00641 (Patent 5,986,347)¹

Before GRACE KARAFFA OBERMANN, SUSAN L. C. MITCHELL, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

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

¹ This Order addresses issues common to all five proceedings; therefore, we issue a single order to be entered in each case. The parties are authorized to use this style heading when filing an identical paper in the proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

IPR2016-00635 (Patent 6,147,405) IPR2016-00637 (Patent 6,455,935)
IPR2016-00639 (Patent 6,828,683) IPR2016-00640 (Patent 6,358,801)
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A conference call was held on May 24, 2016, among respective counsel for Petitioner and Patent Owner, and Judges Obermann, Mitchell, and Ankenbrand. The parties jointly requested the call to discuss: (1) Patent Owner's request to file a motion to extend the filing date of its Preliminary Response in all five *inter partes* review proceedings ("IPR proceedings"); and (2) Petitioner's request to file a motion for a corrected certificate of service in certain of the IPR proceedings.

During the call, Patent Owner represented that the parties are engaged in settlement negotiations with respect to the IPR proceedings and the concurrently pending district court litigation. Patent Owner further represented that the parties anticipate filing joint motions to terminate the IPR proceedings upon finalizing a settlement agreement. Patent Owner indicated that the Preliminary Responses would be unnecessary if the parties settle the IPR proceedings and requested a three-week extension, to June 20, 2016, to file each Preliminary Response.

Petitioner agreed with Patent Owner's representations regarding the status of the parties' settlement negotiations. Petitioner stated that it would not oppose extending the filing dates of Patent Owner's Preliminary Responses.

Although Patent Owner requested authorization to file a motion to extend the filing date of each Preliminary Response, we treated that request as an oral motion to extend the filing dates and explained that Patent Owner should not file a motion with the Board. Turning to the merits of the motion, and mindful of our duty to secure "the just, speedy, and inexpensive resolution of every proceeding," 37 C.F.R. § 42.1(b), we explained that a

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three-week extension was not warranted. Based on the representations made during the conference call, however, we determined that Patent Owner articulated good cause to extend the filing date of each Preliminary Response to June 14, 2016. *See* 37 C.F.R. § 42.5(c)(2). Counsel for both parties stated that this shorter extension would meet their needs.

As to the second issue discussed, counsel for Petitioner explained that the certificates of service (“Certificates”) filed in certain of the IPR proceedings included an error: the Certificates state that service was made by Express Mail on February 18, 2016, when, in fact, service was made by Federal Express on February 19, 2016. Petitioner requested authorization to file a motion to correct the Certificates to include the proper service method and date. Counsel for Patent Owner stated that it did not oppose the request for authorization and would not oppose a motion to correct.

We treated Petitioner’s request as an oral motion to file the corrected Certificates and explained that Petitioner should not file a motion with the Board. Based on the representations made during the conference call, we ordered Petitioner to file the corrected Certificates within three business days of the date of this Order.

It is, therefore,

ORDERED that the filing date for Patent Owner’s Preliminary Response in each of IPR2016-00635, IPR2016-00637, IPR2016-00639, IPR2016-00640, and IPR2016-00641 is extended to June 14, 2016; and

IPR2016-00635 (Patent 6,147,405) IPR2016-00637 (Patent 6,455,935)
IPR2016-00639 (Patent 6,828,683) IPR2016-00640 (Patent 6,358,801)
IPR2016-00641 (Patent 5,986,347)

FURTHER ORDERED that Petitioner shall file a corrected certificate of service in each of the applicable IPR proceedings within three business days of the date of this Order.

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IPR2016-00640 (Patent 6,358,801)

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