

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)
IPR2016-00641 (Patent 5,986,347)

On May 25, 2016, we entered an Order extending the filing date for Patent Owner’s Preliminary Response in each of the above-referenced proceedings to June 14, 2016. Paper 8 (“CP Order”), 2–3. On June 13, 2016, counsel for Patent Owner sent an email communication to the Board, on behalf of both parties, seeking an additional two-week extension of the filing deadline for Patent Owner’s Preliminary Response in each of the above referenced cases, given the “imminent settlement of the litigation underlying the . . . IPR[] [proceedings].” Attachment 1 (copy of email requesting extension to June 28, 2016). In the email communication, counsel for Patent Owner states that Patent Owner has signed the settlement agreement, but that, “due to the process by which signatures on such agreements are obtained by Japanese companies,” counter signatures by Petitioner “will take another two weeks.” *Id.*

As explained in our previous Order extending the deadline to file each preliminary response, we are “mindful of our duty to secure ‘the just, speedy, and inexpensive resolution of every proceeding.’” Conduct of Proceeding Order, 2 (quoting 37 C.F.R. § 42.1(b)). Given the facts and circumstances of this case, including the representations in the email communication regarding the status of the settlement agreement and the signature process, we are persuaded that good cause exists to extend the filing date of each Preliminary Response to June 28, 2016. *See* 37 C.F.R. § 42.5(c)(2). We will not entertain any further requests to extend the due date of Patent Owner’s Preliminary Responses. We also note that the filing of a preliminary response is optional and that Patent Owner may waive such a filing. 37 C.F.R. § 42.107.

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)

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 28, 2016; and

FURTHER ORDERED that the Board will not entertain any further requests to extend the due date of Patent Owner's Preliminary Responses.

IPR2016-00635 (Patent 6,147,405)
IPR2016-00639 (Patent 6,828,683)
IPR2016-00641 (Patent 5,986,347)

IPR2016-00637 (Patent 6,455,935)
IPR2016-00640 (Patent 6,358,801)

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Subject: Re: IPR2016-00635 IPR2016-00637 IPR2016-00639 IPR2016-00640 IPR2016-00641

Re: IPR2016-00635
IPR2016-00637
IPR2016-00639
IPR2016-00640
IPR2016-00641

Dear Sirs:

Due to the imminent settlement of the litigation underlying the above-referenced IPRs, the Patent Trial and Appeal Board previously extended the time for filing Patent Owner's Preliminary Responses to June 14, 2016. Patent Owner Round Rock Research has signed the Settlement Agreement, which has been approved pending signature by Petitioner Ricoh.

However, due to the process by which signatures on such agreements are obtained by Japanese companies, counter signatures by Petitioner on the underlying Settlement Agreement will take another two weeks. Attorneys for Patent Owner and Petitioner respectfully request that the Patent Trial and Appeal Board defer any action on the above IPRs until the fully signed Settlement Agreement is obtained and the joint motions to terminate the above IPRs are filed.

Representatives for Petitioner and Patent Owner further respectfully request that the time for Patent Owner to file the Preliminary Responses be extended to June 28th to preserve the current status of the IPRs until the joint motions to terminate them are filed with the Patent Trial and Appeal Board.

Respectfully submitted,

Respectfully submitted,

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