

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY INC., ALIBABA.COM HONG KONG LTD., AND
BOOKING.COM B.V.,

Petitioner,

v.

GLOBAL EQUITY MANAGEMENT (SA) PTY. LTD.,

Patent Owner.

Case IPR2016-01828
Patent 6,690,400 B1

Before KARL D. EASTHOM, MATTHEW R. CLEMENTS, and
KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Withdraw Ground 2
37 C.F.R. § 42.71

Pursuant to 37 C.F.R. § 42.71 and the Board’s July 17, 2018, email authorizing the filing of a Joint Motion (Paper 67), Petitioner eBay Inc., Alibaba.com Hong Kong Ltd., Booking.com B.V. (collectively “Petitioner”), and Patent Owner, Global Equity Management (SA) Pty. Ltd., jointly request that the Board withdraw Ground 2 of the Petition (Paper 1). Paper 67, 2–3. For the reasons explained below, the Joint Motion is *granted*.

BACKGROUND

Petitioner filed the Petition on September 22, 2016, requesting review of claims 1, 2, 16 and 28 of U.S. Patent No. 6,690,400 in view of PartitionMagic 3.0 User Guide (Ground 1) and PartitionMagic 4.0 User Guide (Ground 2). Paper 1, 18. On April 21, 2017, we instituted a review of claims 1 and 2 based on Ground 1, but did not institute as to claims 16 and 28, or as to Ground 2. Paper 14. A hearing was held on January 22, 2018, a transcript of which has been made part of the record. Paper 60. On April 17, 2018, we issued a Final Written Decision holding claims 1 and 2 unpatentable based on Ground 1. Paper 64.

On April 24, 2018, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) (“SAS”).

On May 17, 2018, Patent Owner filed a Motion for Rehearing arguing that denial of institution as to claims 16 and 28 under Ground 1 and as to Ground 2 was improper under *SAS*, and asking us to set a schedule to deal with the previously non-instituted claims and ground. Paper 65. That Motion is still pending.

ANALYSIS

Pursuant to the Board’s April 26, 2018, “Guidance on the impact of SAS on AIA Trial Proceedings,” the parties have met, conferred, and agreed

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(i) to withdraw Ground 2 from the Petition, based on Petitioner's agreement that the prior art publication supporting this Ground is art that was "raised or reasonably could have been raised" during the instant proceeding for purposes of 35 U.S.C. §315(e); and (ii) that Patent Owner's pending Motion for Rehearing (Paper 65) should proceed in the ordinary course as to Ground 1 for claims 16 and 28. Paper 67, 2–3.

In light of the Supreme Court's *SAS* decision and in an effort to promote the Board's mandate of providing a "just, speedy, and inexpensive" resolution to the proceeding, good cause having been shown, the parties Joint Motion to withdraw Ground 2 of the Petition is *granted*.

Accordingly, for the reasons given, it is

ORDERED that Ground 2 of the Petition is withdrawn; and,

FURTHER ORDERED that Patent Owner's pending Motion for Rehearing (Paper 65) shall proceed in the ordinary course as to Ground 1 for claims 16 and 28.

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