

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.

Case IPR2017-00276
Patent 6,633,945 B1

Before JEFFREY S. SMITH, JENNIFER S. BISK, and BEVERLY M.
BUNTING, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER

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

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '945 patent is unpatentable. Paper 14. We modify our institution decision to institute on all of the challenged claims and all of the grounds presented in the Petition, including the ground based on Ekanadham alone.

Our Final Written Decision will address all grounds presented in the Petition, including the ground based on Ekanadham alone. After the Final Written Decision, if either Patent Owner or Petitioner believes that the ground based on Ekanadham alone requires additional consideration in this proceeding, the parties may file a rehearing request pursuant to 37 C.F.R. § 42.71(d). As an alternative, the Board authorizes the parties to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the claims and grounds upon which we did not institute in our Decision on Institution.

In consideration of the foregoing, it is hereby:

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition; and

FURTHER ORDERED that the parties are authorized to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the claims and grounds upon which we did not institute upon in our Decision on Institution (*see* Paper 14, 6, 24).

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