

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXON ENTERPRISE, INC.,
Petitioner,

v.

DIGITAL ALLY, INC.,
Patent Owner.

IPR2017-00375
Patent 8,781,292 B1

Before PHILLIP J. KAUFFMAN, MINN CHUNG, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

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

The Supreme Court issued its decision on April 25, 2018, in *SAS Institute Inc. v. Iancu*, 584 U.S. ____ (2018), addressing the Board’s ability to issue a final written decision addressing a subset of the claims challenged in a petition. In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would prevail in showing that at least 1 of the challenged claims of the ’292 patent is unpatentable and we instituted *inter partes* review of all challenged claims. Paper 9. We instituted on obviousness over (1) Pierce, and (2) Pierce and 20/20-W. *Id.* at 27–28. We did not institute on Petitioner’s contention that if Pierce alone and Pierce combined with 20/20-W do not disclose a second communication signal, it would have been an obvious variant of Pierce. *Id.* at 27, fn.. 18. In light of the Supreme Court’s decision in *SAS*, we amend our institution decision to include review of all of the grounds presented in the Petition. Petitioner and Patent Owner shall meet and confer to discuss the need for additional briefing and any adjustments to the schedule. We are willing to consider an extension of the one-year statutory deadline if warranted.

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), we amend our institution decision to include review of all grounds presented in the Petition; and

FURTHER ORDERED that, Petitioner and Patent Owner shall meet and confer to discuss additional briefing and schedule changes, and shall provide the Board three mutually agreed upon dates and times for a conference call that can occur no later than five business days from entry of this order.

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