

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORPORATION,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

Case IPR2017-00381
Patent 7,886,122 B2

Before SALLY C. MEDLEY, BARBARA A. PARVIS, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

Background

Petitioner filed a Petition requesting an *inter partes* review of claims 1–28 (“the challenged claims”) of U.S. Patent No. 7,886,122 B2 (Ex. 1001, “the ’122 patent”). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 7.

In its Petition, Petitioner asserts the following grounds of unpatentability (Pet. 1–2):

Reference(s)	Basis	Challenged Claim(s)
Lee ¹	§ 102(b)	1, 5, 6, 8, 9, 13, 14, 16, 20, and 24
Lee	§ 103(a)	2–4, 10–12, 17–19, 21–23, and 25–28
Lee and Yoo ²	§ 103(a)	2–4, 10–12, 17–19, 21–23, and 25–28
Lee and Kyung ³	§ 103(a)	2, 3, 10, 11, 17, 18, 21, 22, 25, 26, and 28
Lee and Gould ⁴	§ 103(a)	7 and 15

On June 22, 2017, we entered an Institution Decision, instituting an *inter partes* review as to all of the challenged claims, but only for the first, third, fourth, and fifth grounds, and not the second ground asserted by Petitioner. Paper 9, 26–27. After institution of trial, Patent Owner filed a Patent Owner Response (Paper 18), to which Petitioner filed a Reply (Paper 21). Additionally, a hearing was held on March 8, 2018 and a transcript of the hearing has been entered into the record as Paper 32.

¹ U.S. Patent No. 6,496,445 B2, issued Dec. 17, 2002 (Ex. 1004) (“Lee”).

² U.S. Patent No. 6,477,110 B2, issued Nov. 5, 2002 (Ex. 1006) (“Yoo”).

³ U.S. Patent Application Publication No. 2005/0047246 A1, published Mar. 3, 2005 (Ex. 1005) (“Kyung”).

⁴ U.S. Patent No. 7,571,297 B2, issued Aug. 4, 2009, filed Dec. 30, 2005 (Ex. 1007) (“Gould”).

On April 24, 2018, the Supreme Court of the United States held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). The Office issued guidance on the implications of SAS on trial proceedings on April 26, 2018 and the Chief Judge held a Webinar on April 30, 2018. See “Guidance on the Impact of SAS on AIA Trial Proceedings” (April 26, 2018) (<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>) (herein “Guidance on SAS”).

May 2, 2018 Conference Call

On May 2, 2018, a conference call was held with Judges Medley, Parvis, and Ullagaddi and counsel for the parties in attendance. The call was held to give the parties an opportunity to discuss the impact of SAS with respect to the instant proceeding. During the call, the parties indicated that they had conferred, and arrived at an agreement such that we need not address the second ground in the Final Written Decision. The parties indicated that they had not prepared a joint submission in writing for filing, but would be willing to further confer to prepare a joint submission to waive or withdraw the second ground.

Discussion

In light of the parties’ indication that they have arrived at an agreement to waive or withdraw the second ground, the parties are given until Tuesday May 8, 2018 to further confer and prepare a joint written request. As we explained during the call, any such joint request by the

parties must be set forth in writing. The parties are authorized to file their joint written request no later than Tuesday May 8, 2018.

If, after further conferring, the parties decide not to file a joint written request, the parties shall further confer to discuss the impact of *SAS* on the instant proceeding, including, for example, whether the parties wish to submit further briefing or otherwise change the schedule. The parties must request a conference call with the panel to seek authorization for any briefing or other changes. The parties are cautioned that as the Oral Hearing has been held, an Order instituting on all challenges in this proceeding may be entered any time after Tuesday May 8, 2018, and the Final Written Decision in this proceeding will be entered thereafter.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner and Patent Owner are authorized to file no later than Tuesday May 8, 2018 a joint written request that waives or withdraws the second ground—namely, the following ground: claims 2–4, 10–12, 17–19, 21–23, and 25–28 are unpatentable under § 103(a) as obvious over Lee; and

FURTHER ORDERED if the parties elect not to submit the aforementioned joint written request that Petitioner and Patent Owner shall confer to determine whether they desire further briefing or changes to the schedule, and, if so, shall request a conference call with the panel to seek authorization for such briefing or schedule changes.

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