

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INFOBIONIC, INC.,  
Petitioner,

v.

BRAEMAR MANUFACTURING, LLC,  
Patent Owner.

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IPR2017-00796  
Patent RE43,767 E

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Before PHILLIP J. KAUFFMAN, KEVIN W. CHERRY, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

## I. BACKGROUND

On May 11, 2018, a conference call was held between counsel for Petitioner, counsel for Patent Owner, and Judges Woods, Cherry, and Kauffman to discuss the impact of an order entered on May 3, 2018, which modified our Decision to Institute (Paper 11, “DI”) to include *all grounds* presented in the Petition, including Grounds 4 and 5. Paper 34, 2 (“Order”).

In our original DI, we instituted review of *all challenged claims* under Grounds 1–3. Paper 11, 2. We did not find persuasive, however, Petitioner’s challenges under Grounds 4 and 5. *See id.* at 35 (“Petitioner has not demonstrated a reasonable likelihood that it will prevail with regards to its challenge . . . under Ground 4 or . . . under Ground 5.”). As explained in our DI, we found persuasive Patent Owner’s arguments in response to those grounds. *See id.* at 32 (citing Prelim. Resp. 35–36 (“Patent Owner’s argument is persuasive”)); *see also id.* at 27–34.

During the conference call, Petitioner acknowledged that in the DI, we determined that Petitioner’s Grounds 4 and 5 were not persuasive. Nevertheless, in the interests of efficiency, Petitioner represented that it does not request to submit additional briefing or supplemental evidence in connection with these grounds.

Also during the conference call, however, Patent Owner expressed concern that the proceeding now includes Grounds 4 and 5. In particular, Patent Owner expressed concern that its Patent Owner Response (Paper 14) did not address these newly-added grounds, even though those grounds were addressed persuasively by Patent Owner in its Preliminary Response.

This proceeding is in its late stages, as oral hearing was held on May 1, 2018, and the Final Written Decision is due on or before July 31, 2018.

## II. ANALYSIS

Although we found Patent Owner's arguments presented in its Preliminary Response persuasive as to Grounds 4 and 5 (*see* Paper 11, 32), Patent Owner's concern that these arguments were not similarly presented in its Patent Owner Response has merit. Indeed, our Scheduling Order provides that "[t]he patent owner is cautioned that any arguments for patentability not raised and fully briefed in the [Patent Owner Response] will be *deemed waived*." Paper 12, 3 (emphasis added).

To address Patent Owner's concerns, while keeping the current proceeding on-schedule and while avoiding the need for additional briefing, we now consider those particular arguments presented in Patent Owner's Preliminary Response as *not waived*. In other words, we will consider Patent Owner's arguments presented on pages 33–37 of its Preliminary Response (responding to Grounds 4 and 5, only) in our Final Written Decision. Based on representations made by Petitioner during the conference call, we understand that Petitioner does not request to file supplemental briefing or evidence to reply to Patent Owner's arguments or respond to our analysis from the DI. Accordingly, we determine that no further briefing from either party is warranted at this time.

## III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's arguments responding to Grounds 4 and 5 of the Petition, as presented in Patent Owner's Preliminary Response, are not waived and shall be considered by the Board in its Final Written Decision analysis.

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