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Paper 42
Entered: May 11, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2017-00859
Patent 9,047,586 B2

Before TREVOR M. JEFFERSON, DAVID C. MCKONE, and JOHN A. HUDALLA, *Administrative Patent Judges*.

JEFFERSON, *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 less 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 U.S. Patent No 9,047,586 B2 is unpatentable. IPR2017-00859, Paper 7. We modify our Decision on Institution to institute on all of the challenged claims and all of the grounds presented in the IPR2017-00859 Petition (Paper 2). *See Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018), available at https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial.

On May 7, 2018, a conference call was held between respective counsel for the parties and Judges Jefferson, McKone, Parvis, and Hudalla for the instant proceeding and two related proceedings, i.e., IPR2017-00729 and IPR2017-00787.[1] A court reporter transcribed the teleconference, and a transcript of the teleconference will be filed as an exhibit in this proceeding in due course. During the call, we discussed whether the parties would request additional briefing and/or schedule adjustments based on *SAS*. Both parties affirmatively waived additional briefing and schedule adjustments. As to the claims and grounds previously denied, the parties agreed that no further briefing is necessary and that we should base our final written

[1] As explained during the call, the call was not with an expanded panel of the Board. Judges McKone, Parvis, and Hudalla are paneled on IPR2017-00729 and IPR2017-00787. Judges Jefferson, McKone, and Hudalla are paneled on IPR2017-00859.

decision on the evidence and arguments presented in the Petition and the Preliminary Response. We agree to the parties' approach as to the claims and grounds previously denied.[2]

Accordingly, it is hereby:

ORDERED that our Decision on Institution is modified to include review of all challenged claims and all grounds presented in the IPR2017-00859 Petition (Paper 2).

[2] Our Scheduling Order of August 10, 2017, cautioned that "any arguments for patentability not raised in the [Patent Owner] response will be deemed waived." Paper 8, 3. Because we now agree to consider certain of Patent Owner's arguments from the Preliminary Response when rendering our final written decision, we abrogate the caution from the Scheduling Order as to the claims and grounds previously denied.

IPR2017-00859
Patent 9,047,586 B2

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