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Paper 23
Entered: May 17, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Case IPR2017-01137
Patent 6,998,977 B2

Before JONI Y. CHANG, JUSTIN T. ARBES, and
JON M. JURGOVAN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Limit Petition

On October 16, 2017, we entered an Institution Decision in the instant proceeding, instituting an *inter partes* review as to all of the challenged claims, but not all of the grounds presented in the Petition. Paper 7, 28–29. In particular, the Institution Decision originally instituted the instant review based on the following grounds of unpatentability (the "originally instituted grounds") (*id*.):

Claim(s)	Basis	Reference(s)
1–4, 6–11, and 22–25	§§ 102(a), 102(e)(1)	Menard (Ex. 1003)
11 and 25	§ 103(a)	Menard and Lee (Ex. 1007)
5	§ 103(a)	Menard and Held (Ex. 1005)
3	§ 103(a)	Menard and the HomeRF Specifications (Exs. 1004 and 1012)

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). In light of the Guidance on the Impact of *SAS* on AIA Trial Proceedings posted on April 26, 2018 (at https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial), we modified our Institution Decision to institute on *all of the grounds* presented in the Petition, namely adding one additional ground with respect to claim 3 based on Menard and Jacobs. Paper 17.

Pursuant to our Order (Paper 20, 7), the parties filed a Joint Motion to Limit the Petition to remove the newly instituted ground from consideration, limiting the Petition to the aforementioned originally instituted grounds (Paper 7, 28−29). Paper 22. Upon consideration, we agree with the parties that the Petition should be limited to the originally instituted grounds.

As stated above, our Institution Decision (Paper 7) originally instituted this *inter partes* review as to all of the challenged claims. Limiting the Petition to remove the newly instituted ground would not impact other instituted grounds. Neither party has submitted briefing as to the newly instituted ground. More importantly, at this late stage, as all of the substantive briefing has been filed by the parties and the oral hearing is scheduled for June 14, 2018, removing the newly instituted ground from consideration would promote efficient use of the Board's resources and minimize unnecessary cost and delay to the parties, as well as facilitate just, speedy, and inexpensive resolution of the patentability dispute between the parties. *See* 37 C.F.R. § 42.1(b).

In view of the foregoing, it is hereby

ORDERED that the parties' Joint Motion to Limit the Petition to remove the newly instituted ground from consideration is *granted*; and

FURTHER ORDERED that the instant review is limited to the aforementioned originally instituted grounds (Paper 7, 28−29).

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