

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ITRON, INC.,  
Petitioner,

v.

SMART METER TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2017-01199  
Patent 7,058,524 B2

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Before BRYAN F. MOORE, BARBARA A. BENOIT, and  
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *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 fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at \*10 (U.S. Apr. 24, 2018). In our institution decision, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '524 patent is unpatentable for one of the three grounds asserted in the Petition. Paper 8, 20. We instituted trial for all of the challenged claims on this one ground (i.e., claims 17–22 under 35 U.S.C. § 103 over Suh). *Id.*

We modify our institution decision to institute also on the two additional grounds presented in the Petition. Each of these grounds challenged claims 17–22. *Id.* at 4. Accordingly, we modify our institution decision to add the grounds of (i) claims 17–22 under 35 U.S.C. § 103 over Suh and Bartone and (ii) claims 17–22 under 35 U.S.C. § 103 over Bartone and Villicana. *Id.* (citing Pet. 3) (identifying the grounds asserted in the Petition).

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to change the schedule or submit further briefing, the parties must, on or before May 9, 2018, request a conference call with the panel to seek authorization for such changes or briefing. This conference call, if requested, will be held at 10:00 a.m. EDT on May 11, 2018.

As an alternative, we authorize the parties to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the grounds upon which we did not institute in our institution decision. *See*

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*id.*; see also *Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision).

In consideration of the foregoing, it is hereby:

ORDERED that our institution decision is modified to add the grounds of (i) claims 17–22 under 35 U.S.C. § 103 over Suh and Bartone and (ii) claims 17–22 under 35 U.S.C. § 103 over Bartone and Villicana; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further briefing, and, if so, shall request on or before May 9, 2018 a conference call with the panel to seek authorization for such changes or briefing.

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