

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BITDEFENDER INC.,
Petitioner,

v.

UNILOC USA, INC.,
Patent Owner.

Case IPR2017-01315
Patent 6,510,466 B1

Before MIRIAM L. QUINN, ROBERT J. WEINSCHENK, and
JESSICA C. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

On November 1, 2017, the Board instituted an *inter partes* review in this proceeding as to some but not all of the challenged claims. Paper 7 (“Inst. Dec.”), 2. On November 13, 2017, Petitioner requested rehearing as to the claims for which review was not instituted (Paper 9), and we denied Petitioner’s rehearing request (Paper 10). Patent Owner then filed its Patent Owner Response on December 4, 2017 (Paper 11), and Petitioner filed its Reply on February 1, 2018 (Paper 13). An oral hearing (if requested) has been scheduled in this proceeding for August 7, 2018. Paper 8, 7.

On May 7, 2018, we issued an order to include the previously non-instituted claims in this proceeding consistent with *SAS Institute, Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). Paper 14, 2. In response to our order 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 a conference call with the panel to seek authorization for such changes or briefing” (*id.*), Petitioner requested a conference call with the Board.

On May 17, 2018, we held a conference call with counsel for both parties to discuss any requested briefing to address the newly-added claims (i.e., claims 15–17, 22–24, 30, and 35–37). Neither party requested any changes to the due dates in the Scheduling Order (Paper 8). During the call, Petitioner requested authorization to file a ten-page supplemental brief to address the newly-added claims, and Patent Owner unequivocally stated that it waived any further briefing on the newly-added claims.¹ Petitioner

¹ Patent Owner stated that it may wish to object to Petitioner’s supplemental brief or move to strike that brief or portions thereof. At this time, we do not

requested ten days in which to file its supplemental brief.

Upon consideration of Petitioner's request and Patent Owner's waiver of further briefing, out of an abundance of fairness and as detailed below, we authorize Petitioner to file an Institution Response Brief. We note that such a brief is not specifically authorized by our rules. *See* 37 C.F.R. § 42.23. We further note that Petitioner retains the burden to prove unpatentability of the previously non-instituted claims by a preponderance of the evidence, and that burden is unchanged by Patent Owner's waiver of supplemental briefing on the newly-added claims. *See* 35 U.S.C. § 316(e).

Petitioner is authorized, but not required, to file no later than June 4, 2018 an Institution Response Brief of no more than ten pages to address the Board's discussion in the institution decision of the newly-added claims. Petitioner's Institution Response Brief is for *identifying matters that Petitioner believes the Board misapprehended or overlooked, or otherwise erred* in its institution decision discussing the newly-added claims. Thus, the scope of Petitioner's Institution Response Brief is somewhat similar in scope to a request for rehearing of an institution decision, but broader in that the brief is not limited strictly to matters that Petitioner believes the Board misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

Petitioner is not permitted to introduce new arguments or evidence in its Institution Response Brief. Petitioner must identify with particularity the place where each matter (i.e., argument or evidence) raised in its Institution Response Brief was previously addressed in its Petition (Paper 1). This Institution Response Brief is not an opportunity for Petitioner to add

grant prospective authorization for such a filing.

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additional arguments, evidence, or otherwise try to improve its Petition. Petitioner should be mindful that Board rules prohibit incorporating by reference arguments from one document into another document. 37 C.F.R. § 42.6(a)(3); *see Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 7–10 (PTAB August 29, 2014) (Paper 12) (Informative) (not considering arguments in declaration that were not made in the Petition but only incorporated by reference).

Petitioner’s Institution Response Brief is not a request for rehearing of our institution decision; therefore, we will not decide the issues raised in the brief before the conclusion of the trial. We will take the Petitioner’s Institution Response Brief into consideration as part of the totality of the record we consider in our Final Written Decision.

IT IS SO ORDERED.

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PETITIONER:

Andrei Popovici
andrei@apatent.com

Mihai Murgulescu
mihaihm2000@gmail.com

PATENT OWNER:

Brett Mangrum
brett@etheridgelaw.com

Sean Burdick
sean.burdick@unilocusa.com

Ryan Loveless
ryan@etheridgelaw.com