

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZSCALER, INC.,  
Petitioner

v.

SEMANTEC CORPORATION,  
Patent Owner

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Case IPR2017-01342  
Patent 8,661,498 B2

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Before RAMA G. ELLURU, DANIEL N. FISHMAN, and  
STACEY G. WHITE, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

On June 7, 2018, a conference call was conducted with counsel for the parties and Judges Elluru, Fishman, and White.

Based on the record comprising the Petition (Paper 3), the Patent Owner Response (Paper 9), and each party's supporting evidence, we issued a Decision on Institution granting review of claims 1, 2, 13, 28, and 39 and denying review of the remaining challenged claims. Paper 10. Following our Decision on Institution, Patent Owner filed a Response (Paper 14) with a statutory disclaimer (Ex. 2007) directed to all originally instituted claims. Petitioner then filed a Reply arguing that Patent Owner's statutory disclaimer be construed as a request for adverse judgment by Patent Owner and requested the Board enter adverse judgment against Patent Owner finding the disclaimed claims (1, 2, 13, 28, and 39) unpatentable. Paper 15, 2.

After the above-identified filings, in view of *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1352–53 (2018), we issued an order instituting all claims and all grounds (instituting the originally denied claims as “newly instituted claims”) and instructing the parties to confer regarding any scheduling changes and additional briefing they may require. Paper 17 (filed May 7, 2018). Responsive to our instructions, the parties filed a Joint Motion to Amend Schedule proposing a revised schedule and, impliedly, requesting additional briefing. Paper 19 (“Motion”). Responsive to the Motion, we granted the requested schedule changes (with some adjustments), authorized Patent Owner to file a Supplemental Response addressing the newly instituted claims (claimed previously denied review for lack of a reasonable likelihood of prevailing), and authorized Petitioner to file a Supplemental Reply addressing issues raised by Patent Owner's Supplemental Response.

Paper. 20 (“Order”). Our Order authorized fifteen (15) pages for each of the Supplemental Response and the Supplemental Reply. Order 4.

During the June 7 conference call, Patent Owner requested the fifteen (15) page limit for its Supplemental Response be increased to fifty (50) pages. Petitioner suggested the page limit for both the Supplemental Response and the Supplemental Reply be increased to no more than thirty (30) pages. When asked what general issues Patent Owner intended to address in its Supplemental Response that would require fifty pages, Patent Owner’s counsel indicated it intended to address arguments raised in the Petition directed to the newly instituted claims, but indicated it had no intention of addressing Petitioner’s argument that Patent Owner’s statutory disclaimer of the originally instituted claims be deemed a request for adverse judgement.

Having heard argument from both parties, we grant Patent Owner’s request and modify our prior Order to authorize Patent Owner to file a Supplemental Response of no more than fifty (50) pages and to authorize Petitioner to file a Supplemental Reply of no more than fifty (50) pages. Our earlier order remains unchanged regarding the revised schedule and unchanged in that Patent Owner’s Supplemental Response remains limited to addressing the newly instituted claims and Petitioner’s Supplemental Reply remains limited to addressing issues raised in Patent Owner’s Supplemental Response. Furthermore, no Motion to Amend has been requested or authorized.

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In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a Supplemental Response addressing the newly instituted claims, the Supplemental Response limited to fifty (50) pages filed no later than June 18, 2018 (REVISED DUE DATE 1); and

FURTHER ORDERED that Petitioner is authorized to file a Supplemental Reply addressing issued raised by Patent Owner's Supplemental Response, the Supplemental Reply limited to fifty (50) pages filed no later than July 31, 2018 (REVISED DUE DATE 2).

**PETITIONER:**

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