

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASABI LTD.,
Petitioner,

v.

BYTEMARK, INC.,
Patent Owner.

Case IPR2017-01449
Patent 8,494,967 B2

Before JOSIAH C. COCKS, NEIL T. POWELL, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

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

A telephone conference was held on May 17, 2018 with counsel for the parties¹. A court reporter retained by Patent Owner transcribed the telephone conference. The purpose of the conference was to discuss any need for supplemental briefing, supplemental depositions, and changes to the Scheduling Order (Paper 11) because of our Order (Paper 20) adding additional patent claims and additional grounds to the instituted trial.

The Petition challenged the patentability of each of claims 1–6, 17–23, and 34 as anticipated by each of Terrell, Cruz, or Dutta based on 35 U.S.C. § 102. We instituted an *inter partes* review based solely on whether claims 1, 3–6, 17, 18, 20–23, and 34 are anticipated by Terrell. *See* Paper 11 (“Dec. Inst.”), 34. We did not institute a review on whether claims 2 and 19 are anticipated by Terrell. *Id.* at 31. We also did not institute a review on whether claims 1–6, 17–23, and 34 are anticipated by each of Cruz or Dutta. *Id.* at 33.

Following the Supreme Court decision in *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018), we modified our institution decision to institute on all of the challenged claims and all of the grounds presented in the Petition. Paper 20.

The current status of the case, based on schedule revisions previously agreed to by the Parties (*see* Paper 16), is:

Patent Owner took the deposition of Petitioner’s expert on March 7;
Patent Owner’s Response and a Motion to Amend were filed
March 15;

Petitioner’s Reply is due June 14;

¹ Messrs. LaLone and Donohue appeared for Petitioner. Ms. Meredith appeared for Patent Owner.

A hearing, if requested, will be held on August 22.

During the conference, Patent Owner requested a supplemental response to address the newly-added challenges in this proceeding, which are whether claims 2 and 19 are anticipated by Terrell and whether claims 1–6, 17–23, and 34 are anticipated by each of Cruz or Dutta.

Supplemental Filings and Other Activity

We determine good cause exists to permit the requested Supplemental Response. *See* 37 C.F.R. § 42.5. Patent Owner is authorized to file a Supplemental Response directed to the newly-added challenges in this proceeding. The Supplemental Response is limited to 10,500 words. Any arguments for patentability regarding the newly-added challenges that are not raised in the Supplemental Patent Owner Response are deemed waived.

Patent Owner also is authorized to file a supplemental expert report in support of its Supplemental Response. The supplemental expert report also is limited to addressing the newly-added challenges in this proceeding.

Patent Owner also may take a supplemental deposition of Petitioner's expert witness. The supplemental deposition is limited to addressing the newly-added challenges in this proceeding. The supplemental deposition direct examination is limited to four (4) hours.

Patent Owner also is authorized to file a motion to expunge its Motion to Amend (Paper 18) and to substitute in its place a Substitute Motion to Amend.

In consideration for Patent Owner's combined Response and Supplemental Response having a combined authorized word count of 24,500 words, Petitioner is authorized to file a single Reply to the Response and Supplemental Response, the single Reply having a corresponding

proportional increase in words from 5,600 to 9,800 words. Petitioner's Reply may respond to preliminary findings made by the Board in the Decision on Institution with respect to the newly-added challenges, but otherwise is subject to 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments raised in the corresponding . . . response."). Evidence relied on by Petitioner in its Supplemental Reply is limited to rebuttal evidence only.

Revised Due Dates

Following our May 17 conference call with the parties, based on their input and requests, and in accordance with the supplemental activities authorized above, we revise the following dates in our Scheduling Order (Paper 11), as previously modified by the parties (Paper 16).

Action	Old Due Date	Revised Due Date
Patent Owner's Supplemental Deposition of Petitioner's Expert	N.A.	May 31, 2018
Patent Owner's Supplemental Response	N.A.	June 8, 2018
Patent Owner's Substitute Motion to Amend	N.A.	June 15, 2018
(1) Petitioner's Reply to Patent Owner's Response <i>and</i> Patent Owner's Supplemental Response; <i>and</i> (2) Petitioner's opposition to Motion to Amend	June 14, 2018 (see Paper 16)	June 29, 2018
Patent Owner's Reply to Petitioner's	July 5, 2018	July 15, 2018

Opposition to Motion to Amend		
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All other due dates established in the Scheduling Order (Paper 11), beginning with due date 4, remain unchanged. We note for emphasis and clarity that the oral argument, if requested, remains as scheduled on August 22, 2018.

As set out in our original Scheduling Order (Paper 11, 6), the parties may stipulate to different dates for DUE DATES 1 through 5 in the original Scheduling Order, as revised herein (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be filed with the Board. The parties may not stipulate to an extension of DUE DATES 6 and 7.

As an alternative, the Board authorizes the parties to file, within three (3) business days of this Order, a Joint Motion to Limit the Petition by removing the claims and grounds upon which we did not institute in our Decision on Institution. *See, e.g., 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). Such a Joint Motion would moot the schedule detailed above.

In consideration of the foregoing, it is so ORDERED.

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