Trials@uspto.gov
571-272-7822

Paper No. 15
Entered: August 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

EVERYMD.COM LLC,
Patent Owner.

Case IPR2018-00050
Patent 8,804,631 B2

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and PATRICK M. BOUCHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A consolidated conference call in this proceeding and Case IPR2017-02027 (Patent 9,137,192 B2) was held on August 22, 2018, between the parties and the panels. As quick background, on March 9, 2018, the U.S. Court of Appeals for the Federal Circuit entered a "Rule 36 Judgment" in *EveryMD.com LLC v. Facebook, Inc.*, No. 2017-2105, thereby summarily affirming a determination by the U.S. District Court for the Central District of California that all the claims in U.S. Patent 9,137,192 B2 ("the '192 patent") and all the claims in U.S. Patent 8,504,631 B2 ("the '631 patent") are directed to non-statutory subject matter under 35 U.S.C. § 101. Ex. 3001. On May 4, 2018, the Federal Circuit denied Patent Owner's, EveryMD.com LLC ("EveryMD"), request for rehearing. In an email dated July 24, 2018, EveryMD informed the panel for Case IPR2018-00050 that it would not file a petition for writ of certiorari with the Supreme Court. Now that there appears to be a "final" judgment of invalidity with respect to all the claims of the '192 patent and the '631 patent, we initiated the consolidated conference call to discuss the impact of the "final" judgment on these proceedings.

II. DISCUSSION

We began the conference call by seeking clarification from the parties as to whether there was, indeed, a "final" judgment of invalidity with respect to all the claims of the '192 patent and the '631 patent, which are the patents at issue in these proceedings. The parties confirmed our understanding that all the claims in the '192 patent and all the claims in the '631 patent are now invalid because the time period for filing a petition for writ of certiorari with the Supreme Court has

expired. We then inquired as to whether either party disputes that we possess the authority to dismiss the petitions under 37 C.F.R. § 42.71(a), thereby terminating the trials without rendering any further decisions in accordance with 37 C.F.R. § 42.72.

EveryMD explained that it decided not file a petition for writ of certiorari with the Supreme Court for several reasons, including, among other things, because we already instituted a trial in each proceeding and, as a matter of right, it filed a Motion to Amend in each proceeding that proposes different claims than those determined to be invalid by the Federal Circuit. EveryMD referred us to the Federal Circuit's general discussion of a motion to amend in *Aqua Products, Inc. v. Matal*, 872 F.3d, 1290 (Fed. Cir. 2017), and then explained that it should be afforded a full and fair opportunity to have its newly proposed claims considered by the respective panel, regardless of the fact that all the claims in the '192 patent and all the claims in the '631 patent are now invalid. In response, Petitioner, Facebook, Inc. ("Facebook"), explained that the rules governing an *inter partes* review proceeding permit us to take up petitions or motions in any order and, if we so choose, we may dismiss a petition if the circumstances presented do not favor judicial economy. Facebook argued that the circumstances presented here warrant dismissing the Petition filed in each proceeding. Facebook also argued that EveryMD's position incorrectly presumes that the Motion to Amend filed in each proceeding has been granted, which, of course, is not the case. Facebook explained that we will have to expend additional resources in order to determine whether EveryMD's newly proposed claims should be entered in each proceeding. When given the opportunity to have the last word, EveryMD explained that the

Motion to Amend filed in Case IPR2017-02027 has been fully briefed. EveryMD represented that it was willing to waive oral argument in this case if the panel indicated their willingness to reach the merits of the Motion to Amend.

After the conclusion of the consolidated conference call, we briefly deliberated and determined that we would benefit from additional briefing on this issue. In particular, we agreed that briefing is warranted to determine, when, as here, there is "final" judgment of invalidity with respect to all the claims at issue, do we possess the authority to dismiss a petition (under 37 C.F.R. § 42.71(a) or otherwise), thereby terminating a trial without rendering any further decisions in accordance with 37 C.F.R. § 42.72?

III. ORDER

Accordingly, it is:

ORDERED that, pursuant to 37 C.F.R. § 42.20(d), each party is invited to file a brief in each proceeding that is tailored narrowly to address whether, based on the circumstances presented here, we possess the authority to dismiss the petition (under 37 C.F.R. § 42.71(a) or otherwise), thereby terminating the trial without rendering any further decisions in accordance with 37 C.F.R. § 42.72; and

FURTHER ORDERED that each brief is limited to five (5) pages and is due no later than Friday, August 31, 2018.

PETITIONER:

Heidi L. Keefe
Andrew C. Mace
Mark R. Weinstein (*pro hac vice*)
COOLEY LLP
zFBEveryMD@cooley.com
hkeefe@cooley.com
amace@cooley.com
mweinstein@cooley.com

PATENT OWNER:

Frank Michael Weyer
TECHCOASTLAW
fweyer@techcoastlaw.com