

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

MONKEYMEDIA, INC.,
Patent Owner.

Case IPR2018-00059
Patent 9,247,226 B2

Before MARC S. HOFF, LYNNE E. PETTIGREW, and
KAMRAN JIVANI, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

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

The Institution Decision in IPR2018-00059 instituted a trial on claims 1 and 7 of U.S. Patent No. 9,247,226 B2 (Ex. 1001, “the ’226 patent”), but not on claims 2-6 and 8-12. Paper 15, 36. Subsequently, on April 24, 2018,

IPR2018-00059
Patent 9,247,226 B2

the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1352-53 (2018).

On May 18, 2018, we convened a teleconference at the parties' request. Counsel for Petitioner, counsel for Patent Owner, and Judges Hoff and Pettigrew attended. During the call, the parties requested authorization to file a joint motion to withdraw the non-instituted grounds and claims. Patent Owner requested authorization to file a motion for adverse judgment as to claims 1 and 7, which presently stand disclaimed by Patent Owner. We authorize the parties to file, by [date], 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). We further authorize Patent Owner to file, by [date], a Motion for Adverse Judgment as to claims 1 and 7.

ORDER

In consideration of the foregoing, it is, therefore,

ORDERED that the parties are authorized to file, by [date], a Joint Motion to Limit the Petition by removing all claims and grounds that were not instituted in our Decision on Institution.

ORDERED that Patent Owner is authorized to file, by [date] a Motion for Adverse Judgment as to claims 1 and 7 of the '226 Patent.

IPR2018-00059
Patent 9,247,226 B2

PETITIONER:

Stuart A. Nelson
W. Karl Renner
Ryan Chowdhury
FISH & RICHARDSON P.C.
snelson@fr.com
axf-ptab@fr.com
rchowdhury@fr.com

Ashraf Fawzy
Jonathan Stroud
UNIFIED PATENTS, INC.
afawzy@unifiedpatents.com
jonathan@unifiedpatents.com

PATENT OWNER:

Jonathan D. Baker
FARNEY DANIELS PC
jbaker@farneydaniels.com