

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 this proceeding 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, 2, 36. Subsequently, on April 24,

IPR2018-00059
Patent 9,247,226 B2

2018, 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. *See* Paper 18; Ex. 2010. We authorize the parties to file, by June 7, 2018, 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 June 7, 2018, 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 June 7, 2018, 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 June 7, 2018, a Motion for Adverse Judgment as to claims 1 and 7 of the '226 Patent.

IPR2018-00059
Patent 9,247,226 B2

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