

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INAUTH, INC.,  
Petitioner,

v.

MSIGNIA, INC.,  
Patent Owner.

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Case IPR2018-00150  
Patent 9,559,852 B2

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Before TREVOR M. JEFFERSON, JAMES B. ARPIN, and  
GREGG I. ANDERSON, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

ORDER  
Denying Request for Additional Briefing  
*37 C.F.R. § 42.5(a)*

## I. DISCUSSION

On April 10, 2018, mSIGNA, Inc. (“Patent Owner”) sought a conference call with us to request authorization to file (1) a copy of proposed, claim constructions prepared by InAuth, Inc. (“Petitioner”) for use in a related U.S. district court proceeding also directed to the above-captioned patent and (2) additional briefing based on the proposed claim constructions. We and the parties participated in a conference call on April 13, 2018, to discuss Patent Owner’s requests.

During the conference call, Patent Owner confirmed that the above-captioned patent has not expired, and the parties acknowledged that we shall apply the broadest reasonable interpretation standard in construing any disputed claim term in this Preliminary Proceeding. Petitioner further explained that its claim constructions were proposed under the *Phillips* standard used by the U.S. district court and for the purpose of conferring with Patent Owner in an effort to reduce claim construction issues before the U.S. district court.

Further, the parties informed us that claim construction briefing is not due in the U.S. district court proceeding until May 14, 2018, and a *Markman* hearing in the U.S. district court proceeding is scheduled for June 5, 2018. Petitioner’s proposed claim constructions have not been filed with the U.S. district court. Thus, neither the parties’ claim construction briefs nor any claim construction order from the U.S. district court will be filed with us prior to the statutory deadline, i.e., May 11, 2018, for our institution decision.

Because Petitioner’s proposed, claim constructions may or may not reflect the claim constructions ultimately argued in its briefing and

considered by the U.S. district court and because Petitioner's proposed, claim constructions were not prepared under the standard which we will apply in reaching our institution decision, Patent Owner failed to persuade us that receiving the proposed, claim constructions and briefing discussing these proposed claim constructions is appropriate or desirable at this time. We informed the parties of our decision to deny Patent Owner's request during the conference call.

We have not yet determined whether to institute review. Consistent with guidance from our reviewing court, *if* we institute review in this proceeding and *if* claim construction briefing is filed in the U.S. district court and/or *if* the U.S. district court provides constructions for claim terms that either party believes are relevant to issues in this proceeding,<sup>1</sup> either or both parties may seek to bring such briefing and/or any claim construction order to our attention. *See Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326 (Fed. Cir. 2015) (“The fact that the board is not generally bound by a previous judicial interpretation of a disputed claim term does not mean, however, that it has no obligation to acknowledge that interpretation or to assess whether it is consistent with the broadest reasonable construction of the term.”); *see also* 37 C.F.R. § 42.51(b)(1)(iii) (“Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.”).

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<sup>1</sup> During the conference call, Petitioner informed us that, if we institute review, Petitioner intends to seek a stay of the U.S. district court proceeding.

## II. ORDER

It is:

ORDERED that Patent Owner's request for authorization to file (1) a copy of proposed, claim constructions prepared by Petitioner for use in a related U.S. district court proceeding relating to the above-captioned patent and (2) additional briefing relating to those proposed, claim constructions is *denied*.

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