

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RETAILMENOT, INC.,
Petitioner,

v.

HONEY SCIENCE CORP.,
Patent Owner.

Cases PGR2019-00060, PGR2019-00061, IPR2019-01565¹
Patent 10,140,625 B2

Before LINDA E. HORNER, PATRICK R. SCANLON, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in each of the identified cases. We exercise our discretion to issue one Order to be entered in each case. The parties are not authorized to use this style heading in subsequent papers.

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Petitioner RetailMeNot, Inc. filed the three captioned petitions challenging U.S. Patent No. 10,140,625 (“the ’625 patent”) in August, 2019. Patent Owner Honey Science Corp. filed Patent Owner Preliminary Responses in December, 2019. The petitions are pending decisions on institution by the Board.

Petitioner contacted the Board on January 6, 2020 to request permission to file certain exhibits in each case to make the Board aware of recent events in the co-pending district court litigation, *RetailMeNot, Inc. v. Honey Science Corp.*, Case No. 1:18-cv-00937-CFC-MPT (D. Del.). Specifically, Petitioner seeks to submit the fully-briefed motion to stay the district court proceeding with respect to the ’625 patent. Petitioner also seeks to submit Patent Owner’s pending objections to the magistrate judge’s Report & Recommendation regarding claim construction of the ’625 patent, and Petitioner’s reply to these objections. Petitioner does not request additional briefing to address these materials.

Petitioner represents that it met and conferred with Patent Owner about this request and that Patent Owner does not oppose Petitioner’s submission of these exhibits, so long as Patent Owner may submit two additional exhibits. Specifically, Patent Owner seeks to submit Applicant’s Interview Summary and Amendment, dated December 23, 2019, and the Examiner’s Interview Summary, dated December 31, 2019, from related U.S. Patent Appl. No. 16/172,685. Petitioner does not oppose Patent Owner’s request.

The Board agrees that the briefing on the motion for stay of the co-pending district court litigation and the materials showing positions taken by the parties on claim construction may prove relevant to the issues facing

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the Board in one or more of the pending petitions. Further, the Board notes that the parties do not oppose each other's requests.

Thus, it is

ORDERED that, the parties' requests to submit the above-referenced materials in each of the proceedings, without further briefing, is granted; and

FURTHER ORDERED that, the parties have three business days within which to file the requested materials along with updated exhibit lists.

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