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Paper 17
Entered: June 26, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

AIP ACQUISITION, LLC,
Patent Owner.

Case IPR2014-00247
Patent 7,724,879

Before JAMESON LEE, HOWARD B. BLANKENSHIP, and JUSTIN BUSCH, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

Order
Conduct of Proceedings
37 C.F.R. § 42.5

Introduction

On June 25, 2014, an initial conference call was held. The participants were respective counsel for the parties and Judges Lee, Blankenship, and Busch. Petitioner filed a proposed motions list (Paper 16). Patent Owner did not file a proposed motions list. Petitioner's list, however, states only that Petitioner does not presently intend to file any motion.

Discussion

During the conference call, counsel for Patent Owner directed our attention to Due Dates 1 and 2 in the Scheduling Order dated May 27, 2014 (Paper 15). Due Date 1 was set as July 7, 2014, and Due Date 2 was set as November 14, 2014. Those dates would give the Patent Owner six weeks to prepare a Patent Owner Response, and the Petitioner eighteen weeks to prepare a Reply. We recognized that those dates are incorrect, and proposed to divide the time from institution of trial to November 14, 2014, evenly between Petitioner and Patent Owner. Based on that proposal, the parties agreed that Due Date 1 would be reset to August 18, 2014.

We took the opportunity to advise counsel for each party of several common mistakes for practitioners in an *inter partes* review proceeding. First, we noted that a proper Motion to Exclude Evidence should not include arguments alleging that a reply exceeds the scope of a proper reply. If such an issue arises, the parties should initiate a telephone conference call with the Board. Second, we noted that each observation in a Motion for Observations on Cross-Examination of a reply witness should be no longer than a short paragraph and should not be argumentative. An elaborate or argumentative observation may be denied entry or not considered. Third, we reminded the parties that a Motion for Observations on Cross-Examination

is not a paper which "must be" filed regardless of the outcome of the cross-examination. It should be filed only if there is reason to contrast certain cross-examination testimony with other evidence in the record and relied on by the opposing party.

We asked counsel for Patent Owner when the patent involved in this proceeding will expire. Counsel for Patent Owner indicated October 11, 2014. Counsel for Petitioner indicated that he does not have enough information to agree or disagree with that representation. The oral argument for this proceeding is set for January 7, 2015. Paper 15. In all likelihood, Patent 7,724,879 will expire prior to rendering of the final written decision in this proceeding.

The claims of an *unexpired* patent are given their broadest reasonable interpretation in an *inter partes* review. 37 C.F.R. § 42.100(b). We instituted this trial applying the broadest reasonable interpretation for claim construction. If Patent 7,724,879 expires prior to our rendering of a final written decision, however, the broadest reasonable interpretation should not apply for purposes of the final written decision. In that circumstance, the Board's review of the claims is similar to that of a district court's review. *In re Rambus, Inc*., 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, claim terms are given their ordinary and customary meanings, as would be understood by a person of ordinary skill in the art, at the time of the invention, having taken into consideration the language of the claims, the specification, and the prosecution history of record. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). It should be noted, however, that there still would be no presumption of validity in this proceeding and Petitioner's burden of proof is still by a preponderance of the evidence. Also, we will not be

applying a rule of construction with an aim to preserve the validity of claims.

To ensure that the parties will not be caught by surprise late in this trial, and to provide an opportunity for briefing by the parties within the Patent Owner Response and the Petitioner's Reply, we asked the parties to indicate whether they agree with our view that if Patent 7,724,879 expires prior to rendering of the final written decision, the rule of broadest reasonable interpretation does not apply. Counsel for Patent Owner replied that in that circumstance, the rule of broadest reasonable interpretation should not apply, because Patent Owner would have had no opportunity to amend its claims. Counsel for Patent Owner then committed to not filing a Motion to Amend Claims.

Counsel for Petitioner, however, indicated that the rule of broadest reasonable interpretation for construing claims should still apply at the time of rendering of the final written decision even if the involved patent will have expired prior to that time, because at the time of institution of trial, the involved patent has not expired. We gave counsel for both parties one week to consider the issue and to provide an answer in writing, together with the date each party believes the involved patent will expire.

Subsequent to the filing of the parties' responses, we will issue an Order expressing our claim construction not applying the rule of broadest reasonable interpretation. It is possible that on the record before us, there is no difference between applying and not applying the rule of broadest reasonable interpretation.

Order

It is

ORDERED that Due date 1 is reset to August 18, 2014;

FURTHER ORDERED that by July 7, 2014, each party shall file a paper, limited to a single page, to indicate the date it believes Patent 7,724,879 expires, and whether it agrees that the rule of broadest reasonable interpretation for claim construction should not apply at the time of rendering of the final written decision, if Patent 7,724,879, will have expired by that time.

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