

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD CO.,
Petitioner,

v.

U.S. PHILIPS CORPORATION, ORANGE, S.A.,
TDF SAS, and INSTITUT FÜR RUNDFUNKTECHNIK GMBH,
Patent Owner.

Case IPR2015-01505 (Patent 5,777,992)
Case IPR2015-01506 (Patent 5,539,829)
Case IPR2015-01507 (Patent 5,323,396)¹

Before BRIAN J. McNAMARA, SCOTT A. DANIELS, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are identical in related cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

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Counsel for Petitioner contacted the Board via e-mail on December 14, 2015, requesting a conference call to seek authorization to file a Reply to Patent Owner's Preliminary Response, in each of IPR2015-01505 and IPR2015-01507. In particular, Petitioner indicated that it seeks authorization to address an evidentiary issue raised in the Preliminary Responses of whether certain references relied upon in the Petitions have been shown to be prior art printed publications. *See* IPR2015-01505, Paper 14, 8–18; IPR2015-01507, Paper 14, 8–18.

Counsel for Patent Owner subsequently contacted the Board via e-mail on December 15, 2015, providing substantive arguments regarding Petitioner's request. The parties are reminded that 37 C.F.R. § 42.20(b) expressly prohibits the filing of a motion without prior authorization. Substantive e-mails to the Board merely act as an attempt to circumvent this rule. As such, we have not considered Patent Owner's e-mail of December 15, 2015. The parties are instructed to limit future e-mail communications to the Board to requests for a conference call, including only a short explanation as to why the party requests the call, and to avoid including substantive discussions in e-mail communications.

An *inter partes* review may not be authorized unless the information presented *in the Petition* shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(c). Allowing Petitioner to file a Reply at this stage would be tantamount to providing additional pages for the Petition. *See* 37 C.F.R. § 42.24(a)(1)(i) (setting page limit for petitions in *inter partes* review).

We are not persuaded that additional briefing on the issue of whether certain references have been shown to be prior art printed publications is warranted at this

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time. Petitioner has the burden to establish *in its Petition* a reasonable likelihood of success, including, among other things, making a threshold showing that the relied upon references are “printed publications” within the meaning of 35 U.S.C. §§ 102 and 311(b). *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(c); *see also* 37 C.F.R. § 42.20(c) (moving party has the burden).

Further, Petitioner waited six weeks after the filing of the Preliminary Responses to contact the Board with this request. By statute, the Board has only three months from the date of filing of a Preliminary Response to make a determination whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b)(1). Allowing additional briefing at this time could hinder the Board’s ability to timely reach an institution decision.

For the reasons discussed, additional briefing is not authorized. The panel will determine whether to institute trial in each proceeding based on the Petition as-filed, and the Preliminary Response. No conference call is scheduled at this time.

It is

ORDERED that no Reply is authorized in any of the captioned proceedings;
and

FURTHER ORDERED that, except as otherwise authorized in the Rules of Practice in Patent Cases, 37 C.F.R. § 42 *et. seq.*, no motions or other substantive correspondence may be filed in these proceedings without prior, express authorization.

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