

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLARIS WIRELESS, INC.
Petitioner,

v.

TRUEPOSITION, INC.
Patent Owner

Case IPR2013-00323
Patent 7,783,299

Before JAMESON LEE and JONI Y. CHANG, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

Introduction

A telephone conference was held on June 3, 2014. The participants of the call were respective counsel for the parties and Judges Lee and Chang. Counsel for Patent Owner requested the conference (1) to request filing of a motion for

observations on cross-examination of Petitioner's reply declarant by June 9, 2014, and (2) to request authorization to file a motion to strike Petitioner's Reply. We granted the first request but denied the second.

Discussion

Counsel for Petitioner did not oppose authorizing Patent Owner to file a motion for observations on cross-examination of petitioner's reply declarant by June 9, 2014. We authorized Patent Owner to file its motion for observations on cross-examination of Petitioner's reply declarant by June 9, 2014, and Petitioner to file a response to Patent Owner's motion by June 23, 2014.

With regard to its proposed motion to strike Petitioner's Reply, counsel for Patent Owner made three arguments contending that Petitioner's Reply exceeds the proper scope of a reply by presenting new arguments.

1.

The first argument relates to footnote 1 on page 5 of Petitioner's Reply, in which Petitioner states: "If § 120 is not satisfied, then the Patent Owner is admitting that the '829 Patent anticipates and invalidates the claims under 35 U.S.C. § 102(a), (b), and (e)." According to Patent Owner, by that language Petitioner has mounted a new attack against Patent owner's claims based on a ground of unpatentability that was not advanced in the Petition. Counsel for Petitioner represented that that simply is not the case, and that Petitioner has not requested any relief based on the statement and that Petitioner simply is noting a logical consequence for the Board to observe. Counsel for Petitioner further indicated that the Reply has not attempted to apply any challenged claim to the disclosure of the '829 Patent.

We are unpersuaded by Patent Owner that Petitioner, via footnote 1 on page 5 of Petitioner's Reply, has asserted a new ground of unpatentability against

the claims of Patent Owner. We also informed the parties that we will not be applying any new ground of unpatentability over prior art, that was not raised in the Petition. We did, however, authorize the parties to file a joint statement, limited to one paragraph no more than half a page, that summarizes their dispute over this issue, if Patent Owner remains unsatisfied, by July 3, 2014. The issue will be revisited at the time of writing of the final written decision. No additional briefing is authorized.

2.

The second argument relates to Patent Owner's claim to the earlier filing of an ancestral application. According to counsel for Patent Owner, in the Decision instituting trial, the Board already determined that Patent Owner is entitled to claim priority to a '264 ancestral patent and, therefore, Petitioner should not be able to argue in its Reply that Patent Owner is not entitled to the earlier filing date of the '713 patent which has the same disclosure as the '264 patent. That contention is misplaced. The Decision instituting trial is a preliminary determination, not a final determination, and petitioner is free to disagree with conclusions in that decision. Also, in its Patent Owner Response, Patent Owner is claiming priority to an ancestral application with a filing date even earlier than that of the '264 patent. That opens the door for Petitioner to make whatever arguments it can, in the Reply, with respect to why Patent Owner is not entitled to the filing date of any intermediate application in the chain that leads back to the earlier application the benefit of which is claimed in the Patent Owner Response. Once a new claim of priority is made by the Patent Owner in the Patent Owner Response to another application, Petitioner is free to advance additional arguments in that regard.

In any event, we authorized the parties to file a joint statement, limited to one paragraph no more than half a page, that summarizes their dispute over this

issue, if Patent Owner remains unsatisfied, by July 3, 2014. The issue will be revisited at the time of writing of the final written decision. No additional briefing is authorized.

3.

The third argument relates the issue of obviousness over prior art. According to counsel for Patent Owner, Petitioner in its Reply set forth a new motivation to combine references, referenced as motivation based on centralized databases. Counsel for Petitioner, however, explained that the Reply itself explains why the submission properly is responsive to the Patent Owner Response. Specifically, on page 14 of the Reply, it is stated:

The Patent Owner contends that there are no statements in Abbadessa or Havinis to suggest that the references be combined. P.O. resp. at 48:14-10. This is incorrect.

We agree with Petitioner that the above-quoted statement provides proper basis for Petitioner to offer motivations stemming from statements within the references, even if the statements were not initially discussed in the Petition.

Order

It is

ORDERED that Patent Owner is authorized to file a motion for observations on cross-examination of Petitioner's reply declarant by June 9, 2014, and Petitioner is authorized to file a response to the motion by June 23, 2014; and

FURTHER ORDERED that Patent Owner's request to file a motion to strike Petitioner's Reply is *denied*.

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