

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIONPOINT CORPORATION,
Petitioner,

v.

TRANSPERFECT GLOBAL, INC.,
Patent Owner.

Case CBM2015-00168 (Patent 6,526,426 B1)
Case CBM2015-00178 (Patent 7,207,005 B2)¹

Before JEREMY M. PLENZLER, MIRIAM L. QUINN, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

¹ This order addresses issues relevant to the captioned cases. The parties are not authorized to use this caption, unless previously authorized by the Board.

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On December 4, 2015, we held a conference call between respective counsel for Petitioner and Patent Owner, and Judges Quinn, Chagnon, and Plenzler. Petitioner requested the call to discuss additional briefing on certain issues and a procedural question regarding re-filing the Petition to address claim construction for claims 9–16 in CBM2015-00168. A court reporter was present. Each of the issues addressed in the call are summarized below. This order sets a special briefing schedule for the authorized papers, as described below.

A. ADDITIONAL BRIEFING REGARDING STANDING

Petitioner requests additional briefing to address an issue of standing that Patent Owner raised in the Preliminary Response. The requested briefing is limited to the interpretation of the statutory provision that allows filing of a petition for covered business method review of a patent by a person who has been sued for infringement of the patent. Patent Owner objects to Petitioner's request because Patent Owner contends that Petitioner should have established standing in the Petition. In the event the objection is overruled, Patent Owner requests an opportunity to respond to Petitioner's filing in a proportional number of pages.

After hearing both sides on the issues raised and the potential impact of this issue on our decision whether to institute, we authorized Petitioner to file additional briefing limited to Petitioner's contention that it has standing to file the instant proceedings based on its interpretation of the applicable statutory and regulatory provisions. No facts beyond those already established in the record are alleged to be relevant to the issue. Therefore, no new facts are to be addressed in the authorized briefs. Petitioner's brief will be limited to three pages, and shall be styled as a Reply to Patent Owner's Preliminary Response. Patent Owner is authorized to file a Sur-Reply limited to no more than three pages. These

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instructions and the briefing schedule hereby ordered shall apply to both proceedings.

B. CLAIM CONSTRUCTION STANDARD CLARIFICATION

Petitioner requests additional briefing regarding whether the reinstatement of the patent, after the filing of the Petition, impacts in any way its position on claim construction. Patent Owner objects to the additional brief because it alleges that Petitioner has taken a position on claim construction that is unaffected by the reinstatement of the patent. In the alternative, if the Board authorized Petitioner's filing, Patent Owner requests an opportunity to respond.

After hearing both sides of the issues raised and considering the change of status of the patent *after the filing of the Petition*, we authorized Petitioner to file a one page Reply addressing the impact, if any, that the reinstatement of the patent, post-Petition, would have on Petitioner's claim construction position advocated in the filed Petition. Because this issue is relevant to both proceedings, we authorized the filing in both proceedings. Patent Owner is not authorized to file any responsive papers. These instructions and the briefing schedule hereby ordered shall apply to both proceedings.

C. RE-FILING OF PETITION WITH REGARD TO CLAIMS 9–16 IN CBM2015-00168

Petitioner alleges that the Preliminary Response raised the issue of whether claims 9–16 in CBM2015-00168 recite means-plus-function terms. Although Petitioner contends they do not, Petitioner, nevertheless, seeks an opportunity to address, post-Petition, what would be the means-plus-function construction of claims 9–16. Petitioner sought to withdraw from consideration claims 9–16 in favor of filing a new Petition that addresses these claim construction issues. Patent Owner objects to the proposed withdrawal because filing a new Petition would

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give an unfair advantage to Petitioner to pre-empt Patent Owner's arguments made in the Preliminary Response. Patent Owner argues that the Petition should be considered as filed, without consideration of additional substantive material.

After hearing both sides of the issues raised and consideration of the Board's resources, we did not authorize the withdrawal of claims from CBM2015-00168. The Petition will be considered as filed.

D. CONSIDERATION OF RELATED CASE CBM2015-00178

Petitioner requests that the Board consider in CBM2015-00178 the same issues addressed above. Patent Owner's Preliminary Response in Case CBM2015-00178 is due on December 8, 2015. Given the overlap of issues in the two proceedings, we authorized Petitioner to file the authorized briefs in both proceedings. In light of the authorized briefing by Petitioner, Patent Owner requested additional time to prepare its Preliminary Response in CBM2015-00178. We are not inclined to change the current deadline for Patent Owner's Preliminary Response in light of the authorized sur-reply for Patent Owner to respond.

Order

It is

ORDERED that Petitioner is authorized to file, by December 11, 2015, a First Reply to Patent Owner's Preliminary Response of no more than 3 pages, limited to addressing Petitioner's interpretation of the applicable statutory and regulatory provisions to the established facts concerning standing. No new facts are to be introduced into the record;

FURTHER ORDERED that Patent Owner is authorized to file, by December 18, 2015, a Sur-reply, of no more than 3 pages, responding to the standing interpretation issue addressed in Petitioner's Reply;

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FURTHER ORDERED that Petitioner is authorized to file, by December 11, 2015, a Second Reply of no more than 1 page, limited to addressing the impact, if any, that the reinstatement of the patent, post-Petition, would have on Petitioner's claim construction position advocated in the filed Petition;

FURTHER ORDERED that the schedule for filing the additional briefing ordered above is set for both of the captioned proceedings;

FURTHER ORDERED that Petitioner is not authorized to either alter or withdraw any of the grounds or claims asserted in the filed Petitions; and

FURTHER ORDERED that the time for filing Patent Owner's Preliminary Response in CBM2015-00178 remains unchanged, with the deadline remaining December 8, 2015.

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