

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK CORP. and DISH NETWORK L.L.C.,
Petitioner,

v.

CUSTOMEDIA TECHNOLOGIES, INC.,
Patent Owner.

CBM2017-00019
Patent 7,840,437

Before MEREDITH C. PETRAVICK, MICHAEL W. KIM, and
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

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

Pursuant to our Order of May 2, 2018, the parties conferred to determine any changes to the schedule or additional briefing in light of our modification to institute on all of the challenged claims and all of the grounds presented in the Petition. Paper 49. On May 15, 2018, counsel for the parties and Judge Petravick held a conference call to discuss any proposed changes. Patent Owner requested to

file a paper incorporating by reference its arguments in the Preliminary Response for the grounds newly instituted in the May 2, 2018 Order and our reasons in the Institution Decision for denying institution of those grounds. Petitioner did not oppose Patent Owner's request. Petitioner requested to file a reply limited to the newly instituted grounds, and to depose Patent Owner's declarant Dr. Kesan on only those grounds. *See Ex. 2001*. Patent Owner did not oppose Petitioner's request.

Given that the statutory deadline for issuing a final written decision is June 12, 2018, Patent Owner must file its paper no later than May 18, 2018 and Petitioner must depose Dr. Kesan and file its reply no later than June 4, 2018. The parties may contact the Board, if necessary, to request changes to the due dates, for example, due to difficulties in scheduling the deposition in a timely manner.

Patent Owner's request is granted and 37 C.F.R. § 42.6, prohibiting incorporation by reference from one document into another document, is waived for the purpose of this paper. Patent Owner's paper is limited to one page.

Petitioner's request also is granted. We remind Petitioner that a reply may only respond to arguments raised in the Patent Owner's paper. 37 C.F.R. § 42.23(b). Petitioner's reply is limited to ten pages.

During the call, Petitioner requested authorization to file a motion to withdraw from consideration the newly instituted grounds to avoid estoppel under 35 U.S.C. § 315. Patent Owner opposed the request. Petitioner's request for authorization to file a motion is denied because Petitioner has not shown good cause to withdraw grounds from consideration. Under these circumstances, we are unpersuaded that avoiding estoppel is good cause.

It is:

ORDERED that Patent Owner is authorized to file, no later than May 18, 2018, a one-page paper limited to incorporating by reference arguments in the Preliminary Response concerning the grounds newly instituted in the May 2, 2018 Order and our reasons in the Institution Decisions for denying institution of those grounds;

FURTHER ORDERED that Petitioner is authorized to depose Dr. Kesan and, no later than June 4, 2018, to file a ten-page reply to Patent Owner's paper; and

FURTHER ORDERED that Petitioner is not authorized to file a motion to withdraw grounds.

For Petitioner:

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