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Paper 26
Entered: March 26, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELEBRANDS CORP.,
Petitioner,

v.

TINNUS ENTERPRISES, LLC,
Patent Owner.

Case PGR2017-00015
Patent 9,527,612 B2

Before MICHAEL W. KIM, FRANCES L. IPPOLITO, and KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge.*

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

On March 23, 2018, we conducted a teleconference with counsel for the parties regarding Patent Owner's request for authorization to file a motion to terminate this proceeding in view of the Final Written Decision in PGR2016-00031 involving a related patent. Patent Owner submitted that the only issue in PGR2017-00015 is whether the "press-against" claim language is indefinite, and that the Board had concluded that this same language is not indefinite in the Final Written Decision in PGR2016-00031. Thus, Patent Owner contended that termination of this proceeding is warranted.

On the call, Patent Owner articulated two bases for its motion. First, Patent Owner contended that the statutory estoppel provision of 35 U.S.C. § 325(e)(1) barred this proceeding. Second, Patent Owner argued that we should exercise our discretion, terminate this proceeding, and vacate our Decision on Institution. Because we determined that neither of these bases were persuasive, we denied authorization to file the motion. A court reporter was present and recorded the call. We direct Patent Owner to file a copy of the transcript of the call in this case. We provide this additional detail to further explain the decision we made on the call.

As to the first basis, the plain language of § 325(e)(1) forecloses it. The relevant language of 35 U.S.C. § 325(e)(1) provides:

> (1) Proceedings before the office.—
>
> The petitioner in a post-grant review *of a claim in a patent* under this chapter *that results in a final written decision under section 328(a)* . . . may not request or maintain a proceeding before the Office with respect *to that claim* on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

35 U.S.C. § 325(e)(1) (emphasis added).

The plain language of this statute only applies to "a claim of a patent" that was subject to a post-grant review for which a final written decision issued. Although there may be similarities between the claim of the '612 patent at issue in this proceeding and the claims of the '282 patent that were at issue in PGR2016-00031, there can be no dispute that no final written decision has issued with respect to any claim of the '612 patent. While Patent Owner advances an assertion with respect to the similarities of just the dependent claims alone, we are unpersuaded by that assertion. Thus, we determine that under its plain language, § 325(e)(1) does not apply. *See Conn. Nat'l Bank v. Germain*, 503 U.S. 249, 254 (1992) ("[C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there . . . when the words of a statute are unambiguous, then . . . the judicial inquiry is complete.").

Second, Patent Owner argues that we should exercise our discretion, terminate the proceeding, and vacate our Decision on Institution. Patent Owner argues, among other things, that this would conserve resources and reduce the risk of inconsistent decisions. Without deciding whether such discretion exists, we note that this case is well along. Briefing is nearly complete—the Patent Owner Response has been filed, Petitioner's Reply is due April 11, and, as noted by Patent Owner, resources have also been expended concerning the similar claim limitation in the prior proceeding. In other words, significant resources have already been expended, and we are not persuaded that any potential savings would be as substantial as Patent Owner proposes. By contrast, termination would ignore the differences that exist between the record in this proceeding and the prior proceeding. In this proceeding, for example, Patent Owner has presented the Declaration of

Q. Todd Dickinson and a new Declaration of Josh Malone that were not submitted in the prior proceeding. As the due date for Petitioner to file a Reply to Patent Owner's Response has not yet arrived, Petitioner has not had the opportunity to be heard with respect to his new evidence. Thus, interests of fairness and due process weigh heavily against this relief.

For completeness of the record, we did, however, grant Patent Owner the opportunity to file a 5-page supplemental brief, if it wishes to further brief these issues. Patent Owner's supplemental brief, if it chooses to file one, will be due April 11, 2018. We also granted Petitioner the opportunity to respond, if Patent Owner files such a supplemental brief. Petitioner's brief, if Patent Owner files its supplemental brief, will be due April 25, 2018.

We understand Patent Owner's desire to bring this proceeding to quick resolution. Given the limited issues and lack of a motion to amend, we invite the parties, to work together on an expedited schedule that will, subject to the availability of the panel and a hearing room, allow us to move the oral hearing to an earlier date. We will also endeavor to issue our Final Written Decision with all due speed.

It is

ORDERED that Patent Owner's request for authorization to file a motion to terminate these proceedings is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file a 5-page supplemental brief, limited to the issues of estoppel and discretionary termination, by April 11, 2018;

FURTHER ORDERED that if Patent Owner files its supplemental brief, that Petitioner may file a 5-page responsive supplemental brief, no later than April 25, 2018;

FURTHER ORDERED that Patent Owner shall file a copy of the transcript of our teleconference; and

FURTHER ORDERED that the parties are directed to meet-and-confer and propose an expedited schedule with an earlier date for the oral hearing.

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