

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON CONNECT INC.,
Petitioner,

v.

OMEGA PATENTS LLC,
Patent Owner.

IPR2023-01162
Patent 8,032,278 B2

Before BARRY L. GROSSMAN, AMBER L. HAGY, and
KRISTIL R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

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

On December 18, 2023, counsel for Verizon Connect Inc. (“Petitioner”) contacted the Board via email stating that a disagreement between it and Omega Patents LLC (“Patent Owner”) has arisen regarding the filing deadline for Patent Owner’s Preliminary Response. Ex. 3001. In the email, Petitioner states that the Patent Owner’s Preliminary Response, which was filed on December 8, 2023 (Paper 7), was filed two weeks late and should be stricken from the record of the above-referenced proceeding. Ex. 3001. Patent Owner states that the Preliminary Response “should be accepted as filed.” *Id.* Both parties requested a conference call with the Board. *Id.*

The panel conferred and determined that a conference call is not necessary. In brief, the Board issued a Notice of Filing Date Accorded to Petition on August 24, 2023, stating that the Petition was defective and required correction within five business days. Paper 4. On September 8, 2023, the Board issued another Notice of Filing Date Accorded to Petition, stating that Patent Owner’s Preliminary Response was due three months “from the date of this notice.” Paper 5. Later that day, however, the Board issued an Errata stating that “[a]ll due dates continue to run from the date of the Notice of Filing Date Accorded was entered, August 24, 2023.” Paper 6, 2.

Although both the second Notice of Filing Date Accorded to Petition and the Errata were issued the same day, Patent Owner states in the email that “it has no record of this Errata in its electronic filing system.” Ex. 3001. Accordingly, Patent Owner states that it docketed December 8, 2023, as the due date for its Preliminary Response based on Paper 5. Ex. 3001. Patent Owner also refers to a separate email received from the Board in response to

Patent Owner's email seeking confirmation of the December 8, 2023, deadline. *Id.*; *see also* Ex. 3002 (email from Trials to Patent Owner's counsel). In response, Petitioner states that the "[t]he Board had issued clear guidance regarding when the Preliminary Response was due," and that notice of the Errata was emailed to the parties' counsel and the Errata itself was available on the P-TACTS website. Ex. 3001.

Due to the unique circumstances of this proceeding, we construe Patent Owner's statements as a *post-hoc* request for an extension of time to file its Preliminary Response from November 24, 2023, to December 8, 2023. Ex. 3001. We waive the due date of 37 C.F.R. § 42.107(b) and grant a retroactive extension of time for filing the Preliminary Response based on Patent Owner's demonstrated good-faith belief of the due date and because the Preliminary Response is helpful to the Board in deciding whether to institute an *inter partes* review. *See* 37 C.F.R. § 42.5(b) (stating that "[t]he Board may waive or suspend a requirement of parts 1, 41, and 42"). Nevertheless, to avoid any prejudice to Petitioner, the Board will issue a Decision on Institution under 35 U.S.C. § 314 on or before the original due date of February 24, 2024.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an extension of time for filing the Patent Owner Preliminary Response is *granted*;

FURTHER ORDERED that Petitioner's request to strike the Patent Owner Preliminary Response from the record is *denied*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314, the Board will issue a Decision on Institution on or before February 24, 2024.

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