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Paper 7
Date: June 6, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARM LIMITED,
Petitioner,

v.

ICPILLAR LLC,
Patent Owner.

IPR2024-00476 (Patent 8,924,899 B2)
IPR2024-00566 (Patent 9,367,657 B2)[1]

Before DONNA M. PRAISS and CHRISTOPHER M. KAISER,
Administrative Patent Judges.

PER CURIAM.

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

In separate email messages to the Board on May 28, 2024, and May 29, 2024, Petitioner requested additional briefing to address arguments in the Patent Owner Preliminary Responses filed in the captioned proceedings. Specifically, in each proceeding, Petitioner requested permission to present

[1] The parties are not authorized to use this style caption.

expert rebuttal to Patent Owner's expert statements regarding whether a particular claim limitation that is recited in each of the challenged patents is met by the same two asserted prior art references. In the email messages, Petitioner also stated that it will submit a *Sotera* stipulation in each proceeding to address Patent Owner's *Fintiv* arguments. The email messages informed the Board that Patent Owner opposed the additional briefing and would appreciate a conference with the Board to explain why it should be denied.

A conference with the parties was held on May 31, 2024, before Administrative Patent Judges Donna M. Praiss and Christopher M. Kaiser. Present at the conference on behalf of Petitioner were Kevin Anderson and Patrick D. McPherson. Kenneth Weatherwax appeared on behalf of Patent Owner. Patent Owner provided a court reporter for the conference.

At the conference, Petitioner requested permission to file a ten (10) page brief and an accompanying declaration from its expert of equal page length to address why the asserted prior art references disclose the claim limitation "outputting by the processor software programming commands to be executed by the hardware integrated circuit for controlling the electronic device." Petitioner stated that briefing was not being requested to explain why Petitioner's proposed stipulation resolves the *Fintiv* related issues.

Patent Owner opposed the need for further briefing on the basis that the Petition should have addressed every limitation in the challenged claims.

According to the parties, no claim construction for the limitation has been provided in the parties' co-pending litigation.

The Board agreed with Patent Owner that the Petition should have addressed the claim limitation at issue, but determined that it would be helpful for the parties to provide the Board with the proper claim

construction for the disputed limitation. The Board determined briefing directed to the proper claim construction for the limitation would be particularly helpful here where neither party provided an express claim construction for the limitation and a claim construction for the limitation has not been determined in the parties' co-pending litigation. The Board authorized each party to file a brief of no more than ten (10) pages in length limited to: (a) the proper claim construction of the term "outputting by the processor software programming commands to be executed by the hardware integrated circuit for controlling the electronic device," (2) the impact that the asserted claim construction has on understanding the asserted prior art references, and (3) the impact of Petitioner's proposed stipulation on the Fintiv related issues. The Board determined that no new evidence may be submitted with the permitted briefing, but directed Petitioner to file the proposed stipulation as an exhibit in each proceeding. The Board also provided a briefing schedule whereby Petitioner may file its brief within 10 calendar days from the conference date and Patent Owner may file its brief within ten (10) calendar days from receipt of Petitioner's brief.

The conference was adjourned after the parties confirmed that no other issues needed to be addressed.

ORDER

It is hereby ordered that:

Petitioner may file within ten (10) calendar days from May 31, 2024, a Preliminary Reply of no more than ten (10) pages in length limited to: (1) the proper claim construction of the term "outputting by the processor software programming commands to be executed by the hardware integrated circuit for controlling the electronic device," (2) the impact that the asserted

claim construction has on understanding the asserted prior art references, and (3) the impact of Petitioner's proposed stipulation on the Fintiv related issues.

Patent Owner may file a Preliminary Sur-Reply of no more than ten (10) pages in length within ten (10) calendar days from receipt of Petitioner's Preliminary Reply directed to (1) the proper claim construction of the term "outputting by the processor software programming commands to be executed by the hardware integrated circuit for controlling the electronic device," (2) the impact that the asserted claim construction has on understanding the asserted prior art references, and (3) the impact of Petitioner's proposed stipulation on the Fintiv related issues.

Patent Owner will file a copy of the transcript of the May 31, 2024, conference in each proceeding when the transcript becomes available.

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