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Paper 9
Date: March 26, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

ADAPTIVE SPECTRUM AND SIGNAL ALIGNMENT, INC.,
Patent Owner.

IPR2025-00012 (Patent 10,848,398 B2)
IPR2025-00013 (Patent 11,770,313 B2)
IPR2025-00087 (Patent 11,477,108 B2)
IPR2025-00088 (Patent 11,050,654 B2)[1]

Before KEVIN F. TURNER, KEVIN C. TROCK, and SCOTT RAEVSKY, *Administrative Patent Judges.*

RAEVSKY, *Administrative Patent Judge*.

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

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[1] The Board uses this consolidated caption for convenience. The parties may not use this caption.

In each of the captioned cases, Petitioner, Charter Communications, Inc., filed a Petition requesting *Inter Partes* review, and Patent Owner, Adaptive Spectrum and Signal Alignment, Inc., filed a Preliminary Response.

In each Petition, Petitioner requested that the Board not exercise its discretion to deny institution under 35 U.S.C. § 314(a), arguing that the factors considered by the Board in its precedential decision in *Apple Inc. v. Fintiv, Inc.,* IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) ("*Fintiv*"), weigh against exercising discretion to deny institution. Pet. 5.[2] As part of its argument against exercising discretionary denial, Petitioner invoked "Director Vidal's Interim Guidance, dated June 21, 2022" ("*Fintiv* Memo"). *Id.* at 8. In each Preliminary Response, Patent Owner requested that the Board exercise its discretion to deny institution under 35 U.S.C. § 314(a) and also invoked the *Fintiv* Memo. Prelim. Resp. 37.

On February 28, 2025, the USPTO rescinded the *Fintiv* Memo in a document entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation."[3] On March 24, 2025, the Board issued Guidance on the recission of the *Fintiv* memo.[4]

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[2] We cite solely to IPR2025-00012 for convenience, but the other cases raise similar issues.
[3] Available at https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures.
[4] Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

Because both parties cited to, and relied upon, the now rescinded *Fintiv* Memo, the Panel requests supplemental briefing from the parties on what effect the recission of the *Fintiv* Memo has on the parties' positions argued under 35 U.S.C. § 314(a) in the Petitions and Preliminary Responses.

Accordingly, it is ORDERED that in each captioned case, each of the parties may file by April 2, 2025, a supplemental brief not to exceed 4 pages, limited to addressing what effect, if any, the recission of the *Fintiv* Memo has on the parties' respective *Fintiv* analysis and arguments set forth in the Petitions and the Preliminary Responses. No new evidence may be introduced by either party.

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