

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

adidas AG,
Petitioner,

v.

NIKE, Inc.,
Patent Owner.

Case IPR2013-00067
Patent 7,347,011 B2

Before JOSIAH C. COCKS, MICHAEL J. FITZPATRICK, and
JAMES B. ARPIN, *Administrative Patent Judges*.
ARPIN, *Administrative Patent Judge*.

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

On April 28, 2014, we issued a Final Written Decision in the above-captioned case. Paper 60 (“Final Dec.”). We granted Patent Owner’s request for the cancellation of original claims 1–46, but denied Patent Owner’s request for entry of substitute claims 47–50. Final Dec. 42. In

particular, we concluded that Patent Owner failed to establish the patentability of substitute claims 47–50. Patent Owner appealed the Final Written Decision to the United States Court of Appeals for the Federal Circuit (“the Federal Circuit”). Paper 61. On February 11, 2016, the Federal Circuit issued a decision, affirming-in-part, vacating-in-part, and remanding the case to the Board. *Nike, Inc. v. adidas AG*, 812 F.3d 1326, 1329 (Fed. Cir. 2016). The Federal Circuit’s mandate issued on April 4, 2016. Paper 1.

Since the issuance of the mandate over four months ago, neither party has sought authorization to submit additional argument or evidence relevant to any matters that must be reconsidered or reassessed before the Board on remand, e.g., the propriety of Patent Owner’s proposal of multiple substitute claims for original claim 19 or the panel’s failure to expressly consider Patent Owner’s arguments and evidence of secondary considerations, or our guidance on the conduct of the remand proceeding. *See Nike*, 812 F.3d at 1339–42. Our determination of the issues on remand will be based solely on the arguments and evidence that were already in the record before us on April 28, 2014, the date of issuance of the Final Written Decision, without additional briefing by either party, and also without submission of additional evidence by either party. *See id.* at 1345 n.6 (citing *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (“We do not direct the Board to take new evidence or, even, to accept new briefing. The Board may control its own proceedings, consistent with its governing statutes, regulations, and practice.”))).

Given that the Final Written Decision was vacated and remanded only for specific errors, we need only address and correct on remand those errors as determined by our reviewing Court. Nothing more is required. Further proceeding in this case is closed to any issue that was not raised by any party for decision in the Final Written Decision.

ORDER

Accordingly, it is

ORDERED that the Parties may not submit further argument or evidence, regarding the issues to be considered on remand.

Case IPR2013-00067
Patent 7,347,011 B2

PETITIONER:

Mitchell G. Stockwell
Theodore G. Brown III
Vaibhav P. Kadaba
Tiffany L. Williams
KILPATRICK TOWNSEND & STOCKTON LLP
tbrown@kilpatricktownsend.com
mstockwell@kilpatricktownsend.com
wkabada@kilpatricktownsend.com
twilliams@kilpatricktownsend.com

PATENT OWNER:

Jonathan van Es
Thomas Pratt
Joseph M. Skerpon
H. Wayne Porter
BANNER & WITCOFF, LTD.
pvanes@bannerwitcoff.com
tpratt@bannerwitcoff.com
jskerpon@bannerwitcoff.com
wporter@bannerwitcoff.com