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Paper No. 61
Entered: August 25, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner,

v.

AT&T INTELLECTUAL PROPERTY I, L.P.,
Patent Owner.

Case IPR2015-01227
Patent 7,907,714 B2

Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and SHEILA F. McSHANE,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge*.

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

I. DISCUSSION

As background, the An reference serves as the basis of three of the seven grounds of unpatentability instituted in this proceeding. Paper 13, 41. Based on our review of the Revised Amended Petition ("Revised Petition") and supporting evidence, it was clear that Petitioner, Cox Communications, Incorporated ("Cox"), was relying on the filing date of the An provisional application to qualify the An reference as prior art to U.S. Patent 7,907,714 B2 ("the '714 patent") under 35 U.S.C. § 102(e). Paper 9, 17, 42–52; Ex. 1014 ¶ 101. Patent Owner, AT&T Intellectual Property I, L.P. ("AT&T"), presented arguments in its Patent Owner Response addressing whether Cox had demonstrated sufficiently in its Revised Petition that Cox was entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e). Paper 40, 44–53.

Of particular importance in this case is a decision issued by the U.S. Court of Appeals for the Federal Circuit in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Circ. 2015). *Dynamic Drinkware* issued on September 4, 2015, which was after Cox filed its Revised Petition on June 22, 2015. In *Dynamic Drinkware*, the Federal Circuit held that "[a] reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with [35 U.S.C.] § 112, ¶ 1." 800 F.3d at 1381.

During the oral argument held on August 23, 2016, counsel for AT&T raised a due process argument by asserting that we improperly refused AT&T's request

for authorization to file a sur-reply to address Cox's Reply argument that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e). *See* Paper 48, 3–23. As we explained during the oral argument, we understood AT&T's request for authorization to file a sur-reply to be limited in scope to the issue of whether the challenged claims of the '714 patent actually were reduced to practice prior to the filing date of the An provisional application, which is an issue that AT&T raised in its Patent Owner Response and for which it carries the burden of persuasion. Paper 50, 2. In other words, we did not understand AT&T to request authorization to file a sur-reply to address Cox's Reply argument that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art. Given the uncertainty surrounding AT&T's initial request for authorization to file a sur-reply, as well as the fact that the Federal Circuit's decision in *Dynamic Drinkware* issued after Cox filed its Revised Petition, we exercise our discretion under 37 C.F.R. § 42.20(d) to afford AT&T a full and fair opportunity to file a sur-reply limited in scope to addressing the issue articulated above.

II. ORDER

Accordingly, it is:

ORDERED that AT&T is authorized to file a sur-reply limited in scope to addressing Cox's Reply argument (Paper 48, 3–23) that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e); and

FURTHER ORDERED that AT&T's sur-reply is limited to seven (7) pages and due no later than September 2, 2016; and

FURTHER ORDERED that Cox is not authorized to file a responsive submission.

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