Trials@uspto.gov
571-272-7822

Paper 7
Entered: July 14, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP, INC.,
Petitioner,

v.

PROVEN NETWORKS, LLC,
Patent Owner.

IPR2022-00644
Patent 8,687,573 B2

Before PATRICK M. BOUCHER, JOHN A. HUDALLA, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

The Petition in this proceeding was filed on March 1, 2022. *See* Paper 1. In addressing the factors the Board applies when considering certain types of discretionary denials of institution in accordance with *Apple*

Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Petition includes a statement that "Petitioner stipulates that, if review is instituted, Petitioner will not pursue in [related] ITC Litigation the grounds in this petition, thereby mitigating concerns of duplicative efforts." *Id.* at 66. Subsequent to the Petition's filing, on June 21, 2022, the Director promulgated an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation ("Interim Procedure").[1] The Interim Procedure states that "the PTAB no longer discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding." Interim Procedure at 7. In light of the Director's memorialization of this practice, Petitioner notified Patent Owner that Petitioner was withdrawing the stipulation made in its Petition.

On July 13, 2022, we held a conference call with the parties to address Petitioner's request for authorization to file a copy of email correspondence that includes notification to Patent Owner that Petitioner's stipulation had been withdrawn. Patent Owner opposes the request, primarily on the basis that the Interim Procedure may not apply "retroactively." During the call, we notified the parties that the Interim Procedure had immediate effect on the date of its promulgation. *See* Interim Procedure 9 ("This interim guidance applies to all proceedings pending before the Office. This interim

[1] Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

guidance will remain in place until further notice.”). We accordingly granted Petitioner authorization to file its email correspondence withdrawing its stipulation, and Petitioner subsequently filed that correspondence as Exhibit 1027.

It is

ORDERED that Petitioner’s filing of Exhibit 1027 is authorized.

PETITIONER

Erika Arner
Erika.arner@finnegan.com

Joshua Goldberg
Joshua.goldberg@finnegan.com

Gracie Mills
Gracie.mills@finnegan.com

PATENT OWNER

Reza Mirzaie
rmirzaie@raklaw.com

Neil Rubin
nrubin@raklaw.com