

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF, LLC,
Petitioner,

v.

PPC BROADBAND, INC.,
Patent Owner.

Case IPR2013-00342
Patent 8,323,060 B2

Before JAMESON LEE, MICHAEL R. ZECHER, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Denying Requests for Further Briefing
37 C.F.R. § 42.5

On November 21, 2014, we issued a Final Written Decision (“2014 FWD”), holding that claims 10–25 of U.S. Patent 8,323,060 B2 (“the ’060 patent”) are unpatentable as obvious over Matthews¹ and Tatsuzuki.² Paper 49. On February 22, 2016, the U.S. Court of Appeals for the Federal Circuit vacated “the rejection of claims 10–25 of the ’060 patent” and remanded. *PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 747 (Fed. Cir. 2016). On May 20, 2016, we issued an Order directing the parties to confer with each other with regard to:

1. All matters, identified specifically, that must be reconsidered / reassessed before the Board on remand, e.g., claims, prior art references, grounds of unpatentability, particular secondary consideration factors, particular terms within claims, etc.;
2. Whether additional briefing and /or submission of new evidence is required for anything identified in Item (1) above, or if it is not required but should be permitted, and why; and
3. Whether the party would request additional briefing and/or submission of new evidence with respect to one or more subjects identified in response to Item (1), and if so, which particular subjects;

Paper 51.

On June 9, Petitioner provided its response (Paper 53) and Patent Owner provided its response (Paper 54). We have considered the responses

¹ US 2006/0110977 A1, published May 25, 2006. Ex. 1004.

² JP 2002-015823, published Jan. 18, 2002. Ex. 1032.

of both Petitioner and Patent Owner in reaching the following determinations regarding the course of this proceeding on remand:

A. We will determine anew Petitioner's assertion of unpatentability of claims 10–25 of the '060 patent, under 35 U.S.C. § 103(a), as unpatentable over Matthews and Tatsuzuki, on the basis of the arguments and evidence that were already in the record before us on November 21, 2014, the date of issuance of the 2014 FWD. We will apply the construction provided by the Federal Circuit for the claim term “reside around,” i.e., that it means *encircle or surround*. *PPC Broadband*, 815 F.3d at 756.

B. The determination in (A) above will be done without additional briefing by either party on the issue, and also without submission of additional evidence by either party.

C. Further proceeding in this case is closed to any issue that was not raised by any party for a decision in the 2014 FWD. Given that the 2014 FWD was vacated only because of an error in claim construction, we need, on remand, to correct the error as determined by our reviewing Court. Nothing more is required. To the extent that we may permit a new issue to be raised on remand, we decline to do so here on the issue of whether Petitioner has named in its Petition all real parties in interest as required by 37 C.F.R. § 312(a)(2). Patent Owner did not raise it before the Federal Circuit while the case was on appeal, and has not sufficiently explained in Paper 54 why we should consider the new issue now at this late stage.

ORDER

It is

ORDERED that Petitioner’s request and Patent Owner’s request to submit further briefing on the issue of patentability of claims 10–25 over Matthews and Tatsuzuki, in light of the Federal Circuit’s construction of “reside around,” is *denied*;³

FURTHER ORDERED that Patent Owner’s request to submit briefing for the first time, and also evidence for the first time, on whether Petitioner complied with the requirement in 35 U.S.C. § 312(a)(2) to name in the Petition all real parties in interest, is *denied*.

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³ The Federal Circuit’s claim construction was based on the construction urged by Patent Owner during the proceeding before the Board. Both parties already had reasonable opportunity to be heard in that regard.