

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAS INSTITUTE, INC.  
Petitioner

v.

COMPLEMENTSOFT, LLC  
Patent Owner

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Case IPR2013-00226  
Patent 7,110,936 B2

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Before KEVIN F. TURNER, JUSTIN T. ARBES, and JENNIFER S. BISK,  
*Administrative Patent Judges.*

BISK, *Administrative Patent Judge.*

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

*Background*

This proceeding is on remand from the United States Court of Appeals for the Federal Circuit. The Federal Circuit issued its decision affirming-in-part, vacating-in-part, and remanding the case to the Board on June 10, 2016. *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341 (Fed. Cir. 2016) (Ex. 3001). Petitioner requested rehearing en banc regarding the issue of whether 35 U.S.C. § 318(a) permits the Board to issue a final written decision with respect to the patentability of only some of the patent claims challenged in the Petition (“the partial institution issue”). This request was denied on November 7, 2016. *SAS Inst., Inc. v. ComplementSoft, LLC*, No. 2015-1346, 2016 WL 6575090 (Fed. Cir. Nov. 7, 2016) (Ex. 3002). Petitioner did not move to stay the mandate pursuant to Fed. R. App. P. 41(d)(2)(A), and the mandate issued on November 14, 2016. Ex. 3003.

*Stay Pending Petitioner’s Petition for Writ of Certiorari*

On December 14, 2016, we held a call with counsel for both parties to discuss the next steps in this proceeding. Petitioner’s counsel represented that it will be filing a petition for writ of certiorari with the Supreme Court of the United States in early 2017 regarding the partial institution issue. Petitioner requested, for efficiency purposes, that we stay any further proceedings on remand pending the Supreme Court’s decision.

Patent Owner objected to such a stay, explaining that the only issue involved in the remand is whether Petitioner has shown that dependent claim 4 is unpatentable given our claim construction of “graphical representations of data flows” adopted in our Final Written Decision. *SAS*, 825 F.3d at 1350–53. According to Patent Owner, because Petitioner’s petition will be limited to the partial institution issue, the remanded issue will not be addressed in any Supreme

Court ruling and, therefore, we should proceed with the remand notwithstanding Petitioner's plan to file a petition for writ of certiorari.

Petitioner agrees that the substance of the issue on remand—claim 4's alleged obviousness over Antis, Coad, and Burkwald—will not be at issue in any potential Supreme Court decision; however, Petitioner notes that if the Supreme Court agrees with Petitioner's position that partial institution is improper, we may ultimately have to decide the issue of alleged unpatentability for claims 2 and 11–15, which were not included in the trial. According to Petitioner, given this possibility, it would be more efficient to stay the proceeding as to claim 4 and address all of the remaining claims at once.

Upon consideration of the issue, and given the particular factual circumstances of this case, the panel has determined that we will not stay remand proceedings at this time pending Petitioner's petition for writ of certiorari, which has not yet been filed. There are several issues, as detailed below, that need to be addressed, which will not be directly impacted by any Supreme Court deliberation or decision on the partial institution issue. At this time, we will proceed with briefing, as ordered below.

#### *New Declaratory Evidence*

Both parties agree that if no stay is issued, briefing of the issue on remand should be granted. Petitioner proposes that along with its briefing, Petitioner should be allowed to introduce new declaratory evidence. Because, to this date, no remand proceedings in *inter partes* or post-grant reviews have included the introduction of new declaratory evidence, we find that briefing from the parties on this issue would be beneficial. Specifically, we would like the parties to propose a process that will (1) efficiently allow a decision on the merits of whether Petitioner has shown claim 4 unpatentable over Antis, Coad, and Burkwald, and (2) ensure due process is accorded both parties.

*Motion to Withdraw Counsel*

On December 5, 2016, Patent Owner filed an unopposed motion to withdraw counsel and appoint Andrew W. Williams and Gavin J. O’Keefe as new counsel. Paper 44. As discussed during the call, this motion is granted.

Accordingly, it is

ORDERED that Petitioner’s request to stay this proceeding pending a Supreme Court decision is *denied*;

FURTHER ORDERED that both parties shall file briefs of 5 pages or less outlining a proposed process for briefing the merits of the issue on remand, including a discussion of Petitioner’s request for new declaratory evidence, no later than January 9, 2017; and

FURTHER ORDERED that Patent Owner’s motion to withdraw counsel is *granted*;

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