

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

PATRICK ZUILI,
Patent Owner.

Case CBM2016-00008
Patent 8,671,057 B1

Before KARL D. EASTHOM, SCOTT A. DANIELS, and
STACEY G. WHITE, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

Conduct of Proceedings
37 C.F.R. § 42.5

Section 18 of the AIA created a transitional program, limited to persons or their privies that have been sued or charged with infringement of a “covered business method patent,” which does not include patents for “technological inventions.” AIA §§ 18(a)(1)(B), 18(d)(1), Pub. L. No. 112-29, 125 Stat. 284, 329–331 (2011); *see* 37 C.F.R. § 42.302. A covered business method is “a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” AIA § 18(d)(1); *see* 37 C.F.R. § 42.301(a). On November 21, 2016, the Court of Appeals for the Federal Circuit issued a decision in *Unwired Planet, LLC v. Google Inc.*, No. 2014–00006, 2016 WL 6832978 (Fed. Cir. Nov. 21, 2016). There, the Federal Circuit ruled that the Board’s reliance on whether the patent claims activities “incidental to” or “complementary to” a financial activity as the legal standard to determine whether a patent is a CBM patent was not in accordance with law. *Id.* at *5. Therefore, based on developments in the law and arguments in this case, we discern a need for additional briefing as to whether the ’057 patent is a covered business method patent.

ORDER

It is

ORDERED that Patent Owner is authorized to file a paper, no more than four pages in length,¹ by no later than December 12, 2016, to discuss the issue of whether the subject matter of at least one claim of the ’057

¹ We remind the parties of their duty to follow our Rules and urge the parties to take particular note of Rules 42.6, 42.11, and 42.13. We are in the late stages of this proceeding and we warn the parties that an improper filing may be expunged *without* an opportunity for refileing to correct errors.

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patent is directed to a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, in light of the Federal Circuit's decision in *Unwired Planet, supra*;² and

FURTHER ORDERED that Petitioner is authorized to file a paper, no more than four pages in length, by no later than December 21, 2016, to respond to Patent Owner's submission.³

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² The Patent Owner submission shall not discuss the technological invention exception of § 18(d)(1) of the AIA and/or 37 C.F.R. § 42.301(a).

³ The Petitioner submission also shall not discuss the technological invention exception of § 18(d)(1) of AIA and/or 37 C.F.R. § 42.301(a).