

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

PATRICK ZUILI,
Patent Owner.

Case CBM2016-00021
Patent 7,953,667

Before JAMESON LEE and GLENN J. PERRY, MIRIAM L. QUINN,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

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.

ORDER

It is

ORDERED that Patent Owner is authorized to file a paper, no more than 4 pages in length, within 10 days of the date of entry of this Order, to discuss the issue of whether the subject matter of at least one claim of the ’763 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*;¹ and

FURTHER ORDERED that Petitioner is authorized to file a paper, no more than 4 pages in length, within 10 days of the date of filing of Patent Owner’s submission as authorized herein, to respond to Patent Owner’s submission.²

¹ The Patent Owner’s submission shall not discuss the technological invention exception of Section 18(d)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) (“AIA”) and/or 37 C.F.R. § 42.301(a).

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

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