

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ERICSSON INC. and  
TELEFONAKTIEBOLAGET LM ERICSSON,  
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,  
Patent Owner.

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Case IPR2014-00963  
Patent 6,952,408 B2

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Before JOSIAH C. COCKS, WILLIAM A. CAPP, and  
DAVID C. MCKONE, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

CORRECTED ORDER<sup>1</sup>  
Conduct of the Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> This Order corrects typographical errors in Paper 34. Specifically, references to “claims 1–12” and “claims 2–12” in Paper 34 have been corrected to “claims 1–16” and “claims 2–16,” respectively. This Order otherwise is identical to Paper 34.

We issued a Final Written Decision in this proceeding on October 22, 2015, ruling that Petitioner had not shown, by a preponderance of the evidence, that claims 1–16 are anticipated by the '480 patent (Ex. 1006) or obvious over the '480 patent and GSM 05.02 (Ex. 1012). Paper 29. We maintained that ruling upon request for rehearing. Paper 31. On May 29, 2018, the Federal Circuit reversed our decision as to claim 1 and remanded the case to us to determine the patentability of claims 2–16. *See Ericsson Inc. v. Intellectual Ventures I LLC*, 890 F.3d 1336, 1349 (Fed. Cir. 2018) (“We have considered all of the arguments presented by both sides, and conclude that claim 1 is not patentable. We reverse the decision as to claim 1. We vacate the decision as to claims 2–16, and remand for determination of patentability of claims 2–16.”).

The parties met and conferred to determine a recommended procedure post-remand. We convened a teleconference on August 1, 2018, with Judges McKone, Cocks, and Capp and representatives for Petitioner and Patent Owner. Both parties agreed that no further briefing or evidence is necessary and that we should decide the patentability of claims 2–16 on the papers and evidence already of record. We accept the parties’ agreement and will decide the patentability of claims 2–16, in due course, based on the papers and evidence already of record.

We also noted that the Petition raised additional claims and grounds on which we did not institute. *See* Paper 6 (Petition); Paper 10 (Institution Decision). During the teleconference, we asked the parties whether the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), affects this proceeding. Both parties represented that they currently do not seek, and will not seek in the future, to have us address the claims and

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grounds on which we did not institute. *Cf. Jazz Pharm., Inc. v. Amneal Pharm., LLC*, No. 2017-1671, 2018 WL 3400764, at \*5 (Fed. Cir. July 13, 2018) (“[A]ny error committed by the Board under the Administrative Procedure Act in partially instituting IPR was waivable.”) (citing *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1362–63 (Fed. Cir. 2018)). Accordingly, the remand proceeding will not address any claims or grounds not addressed in the Final Written Decision.

#### I. ORDER

No further briefing or evidence is authorized.

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