

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO., KG,
Patent Owner.

Case IPR2016-01860
Patent 8,966,144 B2

Before JONI Y. CHANG, JAMES B. ARPIN, and MIRIAM L. QUINN,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

ORDER TO SHOW CAUSE
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

On October 11, 2016, Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3, 5–7, 9, 15–17, 19, 21, 26, 27, 29, 34, 37–39, 41, 49, 52, 54, 56, 57, 59–64, 66, 67, 78–83, and 86 (“the challenged claims”) of U.S. Patent No. 8,966,144 B2 (Ex. 1001, “the ’144 patent”). Paper 2 (“Pet.”). After considering the Preliminary Response filed by Papst Licensing GmbH & Co., KG, (“Patent Owner”) (Paper 9), we instituted *inter partes* review on April 17, 2017 (Paper 10).

On January 15, 2017, Petitioner filed two Petitions for *inter partes* review and corresponding Motions for Joinder concerning the ’144 patent. *See* IPR2017-00679, Paper 1 and IPR2017-00670, Paper 1. Those Petitions and Motions for Joinders were granted, and, consequently, Petitioner was joined as a party to the following proceedings: IPR2016-01212 and IPR2016-01216. *See* IPR2016-01212 (Paper 21), IPR2016-01216 (Paper 22). The Board issued Final Written Decisions in those proceedings on December 11, 2017, concluding that the challenged claims of the ’144 patent are unpatentable. *See* IPR2016-01212 (Paper 32), IPR2016-1216 (Paper 33).

As a result, all the challenged claims in the instant proceeding have been the subject of a final written decision under 35 U.S.C. § 318. According to 35 U.S.C. § 315(e)(1),

[t]he petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim

on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.

Further, the Board has discretion to not institute or to terminate a review for reasons for administrative expediency. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *see also Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1385 (Fed. Cir. 2016) (“But [35 U.S.C.] § 318(a) contemplates that a proceeding can be ‘dismissed’ after it is instituted, and, as our prior cases have held, ‘administrative agencies possess inherent authority to reconsider their decisions, subject to certain limitations, regardless of whether they possess explicit statutory authority to do so.’” (citations omitted)). Indeed, our rules expressly provide the Board with the authority to terminate a trial without rendering a final written decision where appropriate. 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate . . .”).

Due to the posture of the instant proceeding in light of the already issued Final Written Decisions in IPR2016-01212 and IPR2016-01216, in which the Board determined the patentability of the challenged claims in the instant proceeding and where Petitioner was a party, we issue this Order for the parties to show cause why IPR2016-01860 should or should not be terminated.¹

¹ Petitioner and Patent Owner have requested oral argument in IPR2016-

I. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that each party shall file, no later than one week from this Order, a paper not to exceed five pages in length showing cause why IPR2016-01860 should or should not be terminated; and

FURTHER ORDERED that all remaining deadlines and the requested oral argument for IPR2016-01860 are held in abeyance until the Board determines whether and, if so, how to continue this proceeding.

01860. The hearing and all further deadlines in the case are held in abeyance until we determine whether and, if so, how to continue the instant proceeding.

IPR2016-01860
Patent 8,966,144 B2

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