

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES BENZ USA, LLC,
Petitioner,

v.

DIGITAL STREAM IP, LLC,
Patent Owner.

Case IPR2017-00834
Patent 8,265,545

**PATENT OWNER'S MOTION & CERTIFICATION
UNDER 37 C.F.R. § 42.100(b) REQUESTING EXPIRED
PATENT CLAIM CONSTRUCTION**

Notice of Request for Relief

Pursuant to 37 C.F.R. § 42.100(b), Patent Owner moves for a district court-type claim construction with respect to the challenged claims of U.S. Patent 8,265,545.

Material Facts

1. U.S. Patent 8,265,545, the patent challenged in this proceeding, will expire July 2, 2017, within 18 months of the NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE, Paper No. 4, mailed February 27, 2017, in this proceeding.

2. Petitioner, MERCEDES BENZ USA, LLC, filed its petition on February 1, 2017, acknowledging that U.S. Patent 8,265,545 may expire prior to the Board rendering a final written decision in this proceeding. Pet. at 7.

3. Petitioner alleges, “For this petition the outcome would be the same under either [a broadest reasonable interpretation (‘BRI’) or *Phillips*]

standard, as Mercedes' [] claim constructions are proper under either the BRI or a *Phillips*-type claim interpretation." Pet. at 7.

Certification

Patent Owner, by and through its undersigned attorney of record, certifies that U.S. Patent 8,265,545 will expire July 2, 2017.

Requested Relief

Patent Owner respectfully submits that the requirements of Rule 42.100(b) are met, and requests that in this proceeding the Board construe the claims of U.S. Patent 8,265,545 in accordance with the meaning they would have to a person of ordinary skill in the art at the time of the alleged invention considering the intrinsic evidence, and, if appropriate, extrinsic evidence. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-18 (Fed. Cir. 2005).

Discussion

Pursuant to 37 C.F.R. § 42.100(b), a Patent Owner "may request a district court-type claim construction approach to be applied if [the Patent Owner] certifies that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition. The request,

accompanied by [the Patent Owner's] certification, must be made in the form of a motion under § 42.20, within 30 days from the filing of the petition." The instant motion is being filed within 30 from the filing of the petition (February 1, 2017), and Patent Owner has certified that the involved patent, US Pat. 8,265,545, will expire July 2, 2017, within 18 months from the entry of the Notice of Filing Date Accorded to Petition on February 27, 2017. Accordingly, this request meets the requirements set forth in Rule 42.100(b).

The Board should grant Patent Owner's requested relief because the request is timely, Petitioner recognized that the involved patent may expire before a final written decision is rendered, Pet. at 7, and Petitioner alleges that the outcome of the proceeding will not be affected by the Board adopting a *Phillips*-type claim construction. *Id.*

Accordingly, Patent Owner requests that the Board grant this motion and apply a district court-type claim construction in this proceeding.

Respectfully submitted,

Dated: March 2, 2017

/Tarek N. Fahmi/

Tarek N. Fahmi

Reg. No. 41,402

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing

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was served on March 2, 2017, by filing this document through the PTAB E2E System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following address:

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The parties have agreed to electronic service in this proceeding.

Dated: March 2, 2017

Respectfully submitted,

/Tarek N. Fahmi/

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