

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD.,
Petitioner,

v.

OPTIS WIRELESS TECHNOLOGY, LLC,
Patent Owner.

IPR2018-00653
IPR2018-00655
Patent 8,208,569 B2¹

Before KEVIN F. TURNER, MIRIAM L. QUINN, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.70

¹ The parties are not authorized to use this style of caption.

I. BACKGROUND

On September 9, 2019, the Final Written Decision was entered in each of the captioned proceedings. Paper 40 (“Decision” or “Dec.”). On October 9, 2019, Patent Owner filed Patent Owner’s Request for Rehearing of Final Written Decision. Paper 41 (“Request for Rehearing”).

On May 7, 2020, the General Order in Cases Involving Requests for Rehearing Under *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d1320 (Fed. Cir. 2019) was entered, ordering that these proceedings “are held in abeyance.” Paper 42, 2 (“Gen. Order in Reh’g Cases”). On October 26, 2021, the General Order Lifting General Order in Cases Involving Requests for Rehearing Under *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) was entered, ordering that these proceedings “are no longer in administrative abeyance.” Paper 43, 2.

In an email to the Board dated November 1, 2021, Petitioner’s counsel stated that on October 26, 2021, the Board removed these proceedings from abeyance, and now that the cases are active, the parties renew their request to file a joint motion to vacate the final written decisions and terminate the proceedings in light of the parties’ settlement. *See* Ex. 3002.

II. ANALYSIS

In response to the parties’ request, we provide the parties the following guidance.

A. *Motion to Vacate*

No motions to vacate are authorized. The Final Written Decision, issued under 35 U.S.C. § 318, in each of these proceedings stands as the final agency action. *See Kingston Tech. Co. v. Polaris Innovations Ltd.*, IPR2016-01621, Paper 38 at 2 (PTAB Oct. 29, 2021) (Order) (Chief Judge

Scott R. Boalick) (“The Board already has proceeded to a final written decision in this case and, therefore, under the plain language of the statute, a motion to terminate without a final written decision is not available under § 317(a).”).

B. Motion to Terminate

The parties are authorized to file a motion to terminate due to settlement post-institution in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. In that event, Patent Owner’s pending Request for Rehearing would be rendered moot.

Alternatively, in lieu of the parties filing a motion to terminate due to settlement, Patent Owner is authorized to file a motion to withdraw the pending Request for Rehearing, after which each case will close as there would be no other issues pending.

Regardless of which option the parties or Patent Owner selects from this section, the Board’s final written decision in these proceedings will remain the final agency action.

C. Request Director Review

Patent Owner’s request for rehearing was pending before the Office issued guidance on an interim Director review process.² Thus, although not specifically requested, as a further alternative to the parties filing a motion to terminate due to settlement, Patent Owner is authorized to request Director review of the Final Written Decisions in these cases consistent with the

² See *USPTO implementation of an interim Director review process following Arthrex*, <https://www.uspto.gov/patents/patent-trial-and-appealboard/procedures/uspto-implementation-interim-director-review>.

IPR2018-00653
IPR2018-00655
Patent 8,208,569 B2

Office's interim guidance.³ If Patent Owner does not file a request for Director review within the time allotted for action in this Order, then the Board's Final Written Decision will remain the final agency decision.

³ *See supra*; see also *Arthrex* Q&As, <https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/arthrex-qas> (updated July 20, 2021) (setting forth more details about the interim Director review process).

IPR2018-00653
IPR2018-00655
Patent 8,208,569 B2

ORDER

It is, therefore,

ORDERED that the parties are authorized to take the actions set forth in sections II.B and II.C above within fourteen (14) days hereof; and

FURTHER ORDERED that no other filings are authorized.

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