

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. AND ZTE (USA) INC.,
Petitioners,

v.

INVT SPE LLC,
Patent Owner.

Case IPR2018-01474
Patent 7,206,587 B2

Before THU A. DANG, KEVIN F. TURNER, and BARBARA A. BENOIT,
Administrative Patent Judges.

BENOIT, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Apple Inc. and ZTE (USA) Inc. (collectively, “Petitioner”) filed a petition (Paper 3) seeking *inter partes* review of claims 3 and 4 of U.S. Patent No. 7,206,587 B2 (“the ’587 patent”). Patent Owner, INVT SPE LLC, filed a Preliminary Response (Paper 7) on December 13, 2018.

On January 4, 2019, Petitioner contacted the Board to request authorization to file a five-page reply to Patent Owner’s argument that institution should be denied for efficiency reasons because the challenged patents are at issue in a parallel investigation before the International Trade Commission (“ITC”). Petitioner represented that Patent Owner opposed Petitioner’s request unless Patent Owner would be permitted a sur-reply.

We authorize Petitioner to file a reply to Patent Owner’s Preliminary Response limited to addressing Patent Owner’s argument in Section IX that institution should be denied for efficiency reasons because the challenged patents are at issue in a parallel investigation before the ITC (Paper 7, 49–51). Petitioner’s reply is limited to five (5) pages and is to be filed no later than Wednesday, January 16, 2019. No new evidence is permitted to be filed with Petitioner’s reply. Patent Owner is authorized to file a sur-reply no later than Wednesday, January 23, 2019, and is also limited to five (5) pages.

The parties may wish to address differences in remedies available in each forum and differences in claim construction standards applied in the

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proceedings in each forum.¹ The parties also may wish to address with particularity the extent that issues—such as the prior art and statutory basis for unpatentability or invalidity asserted in each proceeding and claim constructions proposed by the parties in each case—overlap in the two proceedings.

It is so ORDERED.

¹ The Petition was filed on August 21, 2018. Paper 6 (Notice of Filing Date Accorded). *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018)(final rule) (“This rule is effective on November 13, 2018 and applies to all IPR, PGR and CBM petitions filed on or after the effective date.”).

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