

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., LG ELECTRONICS INC.,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00222 (Patent 7,167,487 B2)¹
Case IPR2019-00252 (Patent 7,167,487 B2)

Before ROBERT J. WEINSCHENK, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

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

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers absent prior authorization from the Board.

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On April 17, 2019, a conference call was conducted among counsel for Petitioner (Roberto Devoto and Karl Renner), counsel for Patent Owner (Brett Mangrum) and Judges Weinschenk, Horvath, and O’Hanlon. The purpose of the call was to address Petitioner’s request to file a Reply to the Preliminary Response to the Petition filed in each of these proceedings.

Our rules permit a petitioner to request a reply to a preliminary response, however, the request must make a showing of good cause. 37 C.F.R. § 42.108(c). During the conference call, Petitioner argued good cause exists to file a Reply to the Preliminary Response in each proceeding for two reasons.

First, Petitioner argued the cases cited in each Preliminary Response in support of Patent Owner’s argument that Petitioner has failed to establish the public availability of the 3GPP R2-010182 document are non-precedential, distinguishable, and less relevant than the case cited in each Petition in support of Petitioner’s argument that the R2-010182 document was publically available at the time of the claimed invention. Thus, Petitioner seeks leave to file a Reply setting forth a legal analysis that distinguishes the cases cited in the Preliminary Response regarding the sufficiency of Petitioner’s showing of public availability.

Patent Owner countered that mere disagreement with the legal analysis set forth in each Preliminary Response does not amount to good cause to file a Reply because it is a core function of the Board to assess the evidence of record, and to apply the law to the facts in evidence. *See Forty Seven, Inc. v. Stichting Sanquin Bloedvoorziening*, Case IPR2016-01529, Paper 8, *slip op.* at 2 (PTAB, Dec. 9, 2016) (“Assessment of the evidence of record, and application of the law to the facts of the case are core functions

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of the Board, and not unique to this dispute.”); *see also Unified Patents, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-02148, Paper 8, slip op. at 3 (PTAB, Mar. 14, 2018) (same).

We agree with Patent Owner. Mere disagreement with Patent Owner’s interpretation of certain cases on the sufficiency of the evidence needed to show the public availability of a reference does not demonstrate good cause to file a Reply to the Preliminary Response in each of these proceedings. *See Forty Seven Inc*, Paper 8 at 2; *Unified Patents*, Paper 8 at 3.

Second, Petitioner argued that each Preliminary Response construed the term “a minimum bit rate criteria applicable for the respective logic channel” to require a “*differential* minimum bit rate criteria applicable to the respective logic channel,” and this construction was not reasonably foreseeable because it is incompatible with the patent’s intrinsic record.

Patent Owner countered that mere disagreement with the claim constructions set forth in each Preliminary Response does not amount to good cause to file a Reply because it was reasonably foreseeable that each Preliminary Response would construe the challenged claims in a manner that distinguished them over the prior art relied upon in each Petition.

We agree with Patent Owner. Petitioner had an opportunity, when it filed each Petition, to propose how the challenged claims should be construed and how the prior art reads on the challenged claims when they are so construed. *See* 37 CFR § 42.104(3). It was reasonably foreseeable at the time each Petition was filed that Patent Owner would file a Preliminary Response that offered alternative claim constructions in support of

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arguments that the prior art does not read on the challenged claims when they are construed under those alternative constructions.

Accordingly, for the reasons discussed above, Petitioner has failed to show good cause exists for filing a Reply to the Preliminary Response to the Petition in each of these proceedings.

ORDER

It is: ORDERED that Petitioner's request to file a Reply to Patent Owner's Preliminary Response is *denied*.

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PETITIONER:

W. Karl Renner
Roberto J. Devoto
Jeremy J. Monaldo
Ayan RoyChowdhury
Fish & Richardson P.C
axf-ptab@fr.com
devoto@fr.com
monaldo@fr.com
IPR39521-0061IP1@fr.com

PATENT OWNER:

Ryan Loveless
Brett Mangrum
James Etheridge
Jeffrey Huang
Etheridge Law Group
ryan@etheridgelaw.com
brett@etheridgelaw.com
jim@etheridgelaw.com
jeff@etheridgelaw.com