

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION and ZTE (USA) INC.,
Petitioner,

v.

IPR LICENSING, INC.,
Patent Owner.

Case IPR2014-00525
Patent 8,380,244 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

ORDER

Conduct of the Proceedings

37 C.F.R. § 42.5

I. INTRODUCTION

A final decision was entered in this proceeding on September 14, 2014, in which we determined that Petitioner had proven, by a preponderance of the evidence, that claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the '244 patent were unpatentable. Paper 48. The final decision was appealed by Patent Owner to the United States Court of Appeals for the Federal Circuit. On April 20, 2017, the Federal Circuit affirmed with respect to all claims, but vacated our finding of obviousness of claim 8, which depends from claim 1, and remanded for further consideration. *IPR Licensing, Inc. v. ZTE Corp., ZTE (USA) Inc., Microsoft Corp.*, Nos. 2016-1374, 2016-1443 (Fed. Cir. Apr. 20, 2017).¹ In particular, the Federal Circuit agreed with our claim construction for the claim 1 phrase “maintain[ing] a communication session,” but held that “substantial evidence does not support the Board’s articulated motivation to combine the asserted references to arrive at the invention defined in claim 8.” *Id.* at 3.

The Board held a conference call on July 18, 2017, among representatives for Petitioner, Patent Owner, and Judges Medley, Quinn, and Bunting to discuss potential actions to be taken in view of the remand by the Federal Circuit. A court reporter was present on the call, and a transcript of the call is to be filed in due course by Patent Owner as an exhibit.

Both Petitioner and Patent Owner agree that the narrow issue to be addressed regarding claim 8 is the motivation to combine the PDP Context feature of the GPRS standards that enables the subscriber unit to “maintain a communication session” with a CDMA network. *Id.* at 11–13. In addition,

¹ The motion of joined Petitioner Microsoft Corporation, requesting termination of its participation in this proceeding, was granted May 23, 2017. Paper 53.

both parties agree that additional briefing beyond the arguments and evidence presently in the current record is unnecessary.

We authorized Petitioner to file a three (3) page paper, which is due no later than August 1, 2017. This paper is limited to a numeric listing of citations to the previously existing record, indicating where the evidence was originally introduced or argued in the Petition, concerning the motivation to combine the PDP Context feature of the GPRS standard that enables the subscriber unit to “maintain a communication session” with a CDMA network as recited in claim 8. While the paper may include a short introductory paragraph, it is not to include any discussion or argument. Quotes from the brief are permitted, for example:

1. “There is a strong motivation to combine Jawanda with the IEEE 802.11 Standard and the GPRS Standards.” Paper 1, 25.

Patent Owner is not authorized to file a response at this time, but should request authorization via a brief and non-argumentative email to trials@uspto.gov after reviewing Petitioner’s filing, should it feel observations are necessary.

II. ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner is authorized to file a three (3) page paper no later than August 1, 2017, limited to a listing indicating citations to the Petition indicating evidence directed to the motivation to combine the PDP Context feature of the GPRS standard that enables the subscriber unit to “maintain a communication session” with a CDMA network; and

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FURTHER ORDERED that Patent Owner is not authorized to file observations at this time, and may contact the Board should it feel observations are necessary.

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