

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE USA, INC. and ZTE, INC.,
Petitioner,

v.

SPHA AMERICA, LLC,
Patent Owner.

Cases IPR2015-00203 (Patent 8,532,231 B2)
IPR2015-00221 (Patent 8,565,346 B2)¹

Before SALLY C. MEDLEY, BARBARA A. BENOIT, and BETH Z.
SHAW, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER

Patent Owner's Amended Mandatory Notices
37 C.F.R. §§ 42.5

¹ This Order addresses issues that are the same in the identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading.

IPR2015-00203 (Patent 8,532,231)

IPR2015-00221 (Patent 8,565,346)

Petitioner Huawei Device USA, Inc. and ZTE (USA), Inc. filed a Petition requesting an *inter partes* review in each of the above-identified proceedings. Paper 4.² SPH America, LLC (“SPH”) filed a Patent Owner Preliminary Response in each of the above-identified proceedings. Paper 9. SPH also filed an Amended Mandatory Notice (“Notice”) in each proceeding. Paper 10.

According to the face of the two involved patents, the assignee, or patent owner is Electronics and Telecommunications Research Institute (“ETRI”). The Notice, however, indicates that SPH is the exclusive licensee of the involved patents and that SPH will conduct the proceedings “on behalf of Patent Owner.” *Id.* at 1; IPR2015-00221, Paper 10. According to the Notice, Exhibit 2008 is evidence confirming SPH’s authority to conduct the above-identified proceedings on behalf of Patent Owner ETRI. *Id.*

Exhibit 2008 is a document describing that an exclusive license was granted from ETRI to SPH, including the exclusive right to appoint attorneys and to defend each of the involved patents in the above-identified proceedings. The document is signed by SPH’s President and ETRI’s Director.

Based on the record before us, we accept SPH’s showing that it has authority to conduct the proceedings on behalf of ETRI. For purposes of these proceedings SPH is the sole entity authorized to submit papers, evidence, and to otherwise represent or act as Patent Owner. To the extent that ETRI would want to participate in any manner in the proceedings,

² Unless otherwise indicated, citations are to IPR2015-00203.

IPR2015-00203 (Patent 8,532,231)

IPR2015-00221 (Patent 8,565,346)

Patent Owner must initiate a conference call with opposing counsel and the Board. Lastly, although ETRI will not participate in any manner in these proceedings, ETRI nonetheless would be bound by any judgment adverse to SPH. *See, e.g.*, 37 C.F.R. § 42.73(d)(3).

In consideration of the foregoing, it is hereby:

ORDERED that SPH is authorized to conduct the above-identified proceedings on behalf of Patent Owner;

FURTHER ORDERED that if ETRI wants to participate in the proceedings in any manner, Patent Owner must arrange a conference call with opposing counsel and the Board; and

FURTHER ORDERED that although ETRI will not participate in any manner in these proceedings, SPH as well as ETRI, would be bound by any judgment adverse to SPH. *See, e.g.*, 37 C.F.R. § 42.73(d)(3).

IPR2015-00203 (Patent 8,532,231)

IPR2015-00221 (Patent 8,565,346)

For PETITIONER:

Paul Hunter
Christopher C. Bolten
Troy D. Smith
Foley & Lardner LLP
phunter@foley.com
cbolten@foley.com
tdsmith@foley.com

Steven A. Moore
Richard W. Thill
Pillsbury Winthrop Shaw Pittman LLP
steve.moore@pillsburylaw.com
richard.thill@pillsburylaw.com

For PATENT OWNER:

SPH

Wayne Helge
Donald Jackson
Davidson Berquist Jackson & Gowdey L.L.P.
whelge@dbjg.com
djackson@dbjg.com

ETRI

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
sloftis@hunton.com