

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
MICRON TECHNOLOGY, INC., and SK HYNIX, INC.,
Petitioner,

v.

ELM 3DS INNOVATIONS, LLC,
Patent Owner.

Cases¹

IPR2016-00386 (Patent 8,653,672) IPR2016-00387 (Patent 8,841,778)
IPR2016-00388 (Patent 7,193,239) IPR2016-00389 (Patent 8,035,233)
IPR2016-00390 (Patent 8,629,542) IPR2016-00391 (Patent 8,796,862)
IPR2016-00393 (Patent 7,193,239) IPR2016-00394 (Patent 8,410,617)
IPR2016-00395 (Patent 7,504,732)

Before GLENN J. PERRY, BARBARA A. BENOIT, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are substantially similar in the proceedings. We exercise our discretion to issue one order to be filed in each proceeding.

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Samsung Electronics Co., Ltd.; Micron Technology, Inc.; and SK Hynix Inc. (collectively “Petitioner”) filed Petitions requesting *inter partes* review of claims in various patents owned by Elm 3DS Innovations, LLC (“Patent Owner”). *See, e.g.*, IPR2016-00386, Paper 1 (“Pet.”).² In its Petitions, Petitioner raised the possibility that the challenged patents may expire during the *inter partes* review. Pet. 9, n.6 (“The ’672 patent may expire during this proceeding.”). Petitioner contends that expired claims should be construed according to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) as used in district court proceedings. *Id.* (“After expiration, Petitioner believes the claims should be construed according to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).”). Patent Owner filed a Preliminary Response to each Petition but did not address this issue. *See generally* Paper 10.

The claim construction standard to be applied during these *inter partes* reviews depends upon whether the patent is or will be expired during *inter partes* review. The Board gives a claim in an unexpired patent its broadest reasonable construction, in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b) (Aug. 14, 2012); *see Cuozzo Speed Techs., LLC v. Lee*, No. 15-446, 2016 WL 3369425, at *12 (U.S. June 20, 2016) (concluding the broadest reasonable construction “regulation represents a reasonable exercise of the rulemaking authority that Congress delegated to the Patent Office”).

² Unless otherwise indicated, paper numbers refer to IPR2016-00386.

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For claims of an expired patent, the Board’s claim construction analysis is similar to that of a district court. *See In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012). In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips*, at 1312–13 (Fed. Cir. 2005) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

In addition, a recent rule change, which does not apply to these proceedings, specifies:

A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. A party may request a district court-type claim construction approach to be applied if a party certifies that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition. The request, accompanied by a party's certification, must be made in the form of a motion under §42.20, within 30 days from the filing of the petition.

37 C.F.R. § 42.100(b) (Apr. 1, 2016).

Thus, to give both parties an opportunity to be heard under the proper claim construction standard on construction of relevant claim terms, Patent Owner is to file in each proceeding, within ten business days from the entry

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of this Order, a Notice of Patent Expiration certifying whether each of the challenged patents will or will not expire before the deadline for issuing final written decisions in each case—no more than one year from the date of institution of each respective *inter partes* review. 37 C.F.R. § 42.100(c). Patent Owner should include in its Notice a short explanation along with citations to evidence supporting its certification. Patent Owner’s Notice for each proceeding should be no more than two pages.

If Patent Owner certifies that the challenged patents will expire before the deadline for issuing final written decisions in each proceeding, Patent Owner’s Notice should be accompanied by a motion of no more than five pages under 37 C.F.R. §42.20 indicating whether a broadest reasonable construction or a district court-type claim construction approach under *Phillips* should be applied. Petitioner is authorized to file an opposition of no more than five pages to any motion filed by Patent Owner within seven business days. Patent Owner may file a reply of no more than three pages to any opposition filed by Petitioner within three business days.

Patent Owner’s Motion or Reply filed related to the Notice (but not the Notice itself) may address all of the above listed cases in one common document that identifies any relevant substantive or procedural differences between the proceedings, as long as the common document is filed in each proceeding and uses a caption identifying each proceeding in which the common document is filed.

Similarly, Petitioner’s opposition, if any, may address all of the above listed cases in one common document that identifies any relevant substantive

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or procedural differences between the proceedings, as long as the common document is filed in each proceeding and uses a caption identifying each proceeding in which the common document is filed.

PETITIONER:

Jason Engel
K&L Gates LLP
jason.engel.PTAB@klgates.com

Naveen Modi
Paul Hastings LLP
PH-Samsung-ELM-IPR@paulhastings.com

John Kappos
O'Melveny & Myers LLP,
jkappos@omm.com

PATENT OWNER:

Cyrus A. Morton
Kelsey Thorkelson
ROBINS KAPLAN LLP
camorton@rkmc.com
kthorkelson@robinskaplan.com

James Carmichael
CARMICHAEL IP, PLLC
jim@carmichaelip.com