

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-00758
Patent 8,218,481 B2

Before CHRISTOPHER L. CRUMBLY, PETER P. CHEN, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*

McMILLIN, *Administrative Patent Judge*

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

On July 15, 2016, Petitioner filed Motion for Leave to file a Reply to Patent Owner's Preliminary Response to Petition for *Inter Partes* Review ("Motion") and, as Attachment A, Petitioner's Reply to Patent Owner's Preliminary Response to Petitioner's Petition for *Inter Partes* Review ("Reply") (Paper 10). Petitioner did not seek or obtain Board authorization to file the Motion or the Reply.

On July 29, 2016, at the Board's request, a conference call took place in order to discuss the propriety of the filing of the Motion and Reply. The parties were represented by their respective counsel.

37 C.F.R. § 42.20(b) provides: "[a] motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding." 37 C.F.R. § 42.108(c) provides: "[a] petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause."

During the teleconference, Petitioner's counsel contended that the April 1, 2016, amendment to 37 C.F.R. § 42.108(c), adding the sentence, "[a] petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c)" was an "order of general applicability" authorizing Petitioner to file the Motion and Reply under 37 C.F.R. § 42.20(b). Construing 37 C.F.R. § 42.20(b) and 37 C.F.R. § 42.108(c) together, however, we determined that Petitioner's understanding was in error. In particular, we clarified that Board authorization must be sought and obtained before a motion for leave to reply to the preliminary response is filed. The April 1, 2016, amendment to 37 C.F.R. § 42.108(c), did not alter this requirement for prior authorization, and

did not authorize Petitioner's filing of the Reply with the Motion. Thus, authorization is necessary from the Board for a motion seeking leave to file such a reply. Under Board procedure, the proposed reply is not to be attached to the motion; only if that motion is granted may Petitioner file the reply.

During the call, we also considered whether to retroactively authorize Petitioner's Motion. With regard to the showing of good cause to file the Motion and Reply, the Petitioner argues, "Good cause supports this request. Patent Owner has misstated both the teachings of the prior art and Petitioner's arguments, requiring a brief reply to correct the record on which the Board will render its institution decision." Motion 1. We determine Petitioner has not established the requisite good cause merely by contending Patent Owner has made misstatements, or, as Petitioner asserted during the telephone conference, "objectively false" statements about the references and Petitioner's arguments. The Board is capable of reviewing the record to determine whether any misstatements or mischaracterizations exist.

37 C.F.R. §42.7(a) provides: "[t]he Board may expunge any paper directed to a proceeding . . . that is not authorized under this part or in a Board order." Accordingly, we expunge the Motion and the attached Reply (Paper 10).

Therefore, it is

ORDERED that authorization to file a motion for leave to file a reply to the Patent Owner's Preliminary Response is DENIED; and

FURTHER ORDERED that Petitioner's Motion for Leave to file a Reply to Patent Owner's Preliminary Response to Petition for *Inter Partes* Review and Attachment A, Petitioner's Reply to Patent Owner's Preliminary

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Response to Petitioner's Petition for *Inter Partes* Review (Paper 10) are
expunged from the record.

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