

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Cases

IPR2016-01114 (Patent 7,777,753)
IPR2016-01118 (Patent 7,321,368)
IPR2016-01134 (Patent 7,542,045)¹

Before MICHAEL R. ZECHER, JAMES B. ARPIN,
SUSAN L. C. MITCHELL, and MATTHEW R. CLEMENTS,
Administrative Patent Judges.

CLEMENTS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

¹ This Order addresses an issue that is identical in all three cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers without prior authorization.

IPR2016-01114 (Patent 7,777,753)

IPR2016-01118 (Patent 7,321,368)

IPR2016-01134 (Patent 7,542,045)

On February 22, 2017, we issued an Order to Show Cause why IPR2016-01114 should not be terminated as to claims 1–4, why IPR2016-01118 should not be terminated, and why IPR2016-01134 should not be terminated, in light of issuance of Final Written Decisions mailed in three earlier-filed proceedings, respectively.² Paper 27 (“Order to Show Cause”).³

On February 23, 2017, the parties jointly requested a conference call with the Board to discuss an appropriate disposition of these proceedings in light of Patent Owner’s reported representation to Petitioner that Patent Owner does not intend to appeal the Final Written Decisions to the U.S. Court of Appeals for the Federal Circuit.

On February 27, 2017, a conference call in the above proceedings among respective counsel for the parties and Judges Zecher, Arpin, Mitchell, and Clements. During the call, Petitioner explained that, by its calculation, Patent Owner has until March 8, 2017, to file Notices of Appeal of the Final Written Decisions with the Federal Circuit. According to Petitioner, Patent Owner represented that it does not intend to appeal the Final Written Decisions to the Federal Circuit. Petitioner inquired whether, in light of Patent Owner’s representation, it would be appropriate to file Joint Motions to Dismiss in lieu of responses to the Order to Show Cause.

² *HTC Corp. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01500 (PTAB Jan. 4, 2017) (Paper 54) (“1500 FWD”); *HTC Corp. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01501 (PTAB Jan. 4, 2017) (Paper 53) (“1501 FWD”); *HTC Corp. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01502 (PTAB Jan. 4, 2017) (Paper 52) (“1502 FWD”) (collectively, “Final Written Decisions”).

³ Citations are to IPR2016-01114. An identical Order was entered in IPR2016-01118 and in IPR2016-01134.

IPR2016-01114 (Patent 7,777,753)

IPR2016-01118 (Patent 7,321,368)

IPR2016-01134 (Patent 7,542,045)

During the call, Patent Owner confirmed that it does not intend to appeal the Final Written Decisions to the Federal Circuit, and that it does not oppose filing either Joint Motions to Dismiss or Joint Motions to Terminate.

Petitioner expressed that our Decisions on Institution in these proceedings need not be vacated, distinguishing these proceedings from cases in which Decisions on Institution have been vacated, e.g., for failure to name a real party-in-interest. Patent Owner did not express an opinion on whether our Decisions on Institution should be vacated

Based on Patent Owner's representation that it does not intend to appeal the Final Written Decisions to the Federal Circuit, and in lieu of responses to our Order to Show Cause, we authorized the parties to file, in each proceeding, a Joint Motion to Terminate Under 37 C.F.R. § 42.72, limited to no more than three pages in length, on or before March 10, 2017.

ORDER

Accordingly, it is

ORDERED that both parties are excused from filing a response to the Order to Show Cause entered into each proceeding;

FURTHER ORDERED that, in IPR2016-01114, the parties are authorized to file a Joint Motion to Terminate only as to Claims 1–4, not to exceed three pages in length, on or before March 10, 2017;

FURTHER ORDERED that, in IPR2016-01118, the parties are authorized to file a Joint Motion to Terminate, not to exceed three pages in length, on or before March 10, 2017; and

IPR2016-01114 (Patent 7,777,753)

IPR2016-01118 (Patent 7,321,368)

IPR2016-01134 (Patent 7,542,045)

FURTHER ORDERED that, in IPR2016-01134, the parties are authorized to file a Joint Motion to Terminate, not to exceed three pages in length, on or before March 10, 2017.

IPR2016-01114 (Patent 7,777,753)

IPR2016-01118 (Patent 7,321,368)

IPR2016-01134 (Patent 7,542,045)

For PETITIONER:

Andrew S. Ehmke

David W. O'Brien

HAYNES AND BOONE, LLP

andy.ehmke.ipr@haynesboone.com

david.obrien.ipr@haynesboone.com

For PATENT OWNER:

Massod Anjom

Scott Clark

AHMAD, ZAVITSANOS, ANAIPAKOS, ALAVI & MENSING P.C.

manjom@azalaw.com

sclark@azalaw.com