

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner

Case IPR2016-01114
Patent No. 7,777,753

JOINT MOTION TO PARTIALLY TERMINATE UNDER 37 C.F.R. § 42.72

Petitioner Apple Inc., (“Apple”) and Patent Owner Parthenon Unified Memory Architecture LLC (“PUMA”) (collectively, the “Parties”), pursuant to the authorization provided by the Board’s Order – Conduct of the Proceedings entered March 1, 2017 (Paper 28), 35 U.S.C. § 315(d) and 37 C.F.R. § 42.72, jointly request termination of this *inter partes* review only as to claims 1, 2, and 4. The instant motion is filed in lieu of a response to the Board’s Order to Show Cause issued February 22, 2017. Ex. 1026, 14:8-13.

1. Statement of Facts

On May 31, 2016, Petitioner filed a Petition requesting *inter partes* review of claims 1, 2, 4, 7-10, and 12 of U.S. Patent No. 7,777,753 (“the ’753 Patent”) (IPR2016-01114). On December 7, 2016, the Board instituted *inter partes* review as to all challenged claims (Paper 7). DUE DATE 1 (March 9, 2017) has passed and Patent Owner certifies that it has not filed (and will not file) a Response contesting the instituted grounds as to claim 1, 2, or 4 of the ’753 Patent.

Claims 1-4 of the ’753 Patent were held unpatentable in the Final Written Decision in *HTC Corp. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01501 (PTAB Jan. 4, 2017) (Paper 53) (“1501 FWD”). Patent Owner confirmed that it did not intend to appeal the 1501 FWD (Ex. 1026, 8:23-25), the time for such appeal expired March 8, 2017, and Patent Owner hereby certifies that no Notice of Appeal has been or will be filed relative to the 1501 FWD.

2. Relief Requested

Relative to the 1501 FWD, Patent Owner's time for noticing an appeal to the Court of Appeals for the Federal Circuit expired March 8, 2017, and Patent Owner certifies that it has not filed (and will not file) a notice of appeal of the 1501 FWD. 35 USC §§ 141-142, 319; 37 CFR § 90.3. Thus, because a final written decision determining challenged claims 1, 2, and 4 to be unpatentable has issued, and because the time for appeal has expired, pursuant to 35 USC § 318, "the Director shall issue and publish a certificate canceling" claims 1, 2, and 4 of the '753 Patent. 35 USC § 318(a, b). When that certificate issues in due course based on the now-final determination of the 1501 FWD, claims 1, 2, and 4 will no longer be *patent claims* of the '753 Patent and, relative to this proceeding, the Board will no longer be able to issue a "final written decision with respect to the patentability of [] *patent claim*[s 1, 2 or 4] challenged by the petitioner." 35 USC § 318(a) (emphasis added). Because the Director must issue the certificate, this proceeding as to claims 1, 2, and 4 is now moot and should be terminated as to claims 1, 2, and 4, but only as to such claims. Claims (7-10 and 12) continue to be challenged in the present *inter partes* review, and that challenge is not rendered moot.

The Board has previously followed this very course of action, terminating-in-part an *inter partes* review as moot where that review challenged claims that were finally determined to be unpatentable in a previously-issued final written

decision. *See International Business Machines Corp. v. Intellectual Ventures II LLC*, Case IPR2015-01323 (PTAB Apr. 7, 2016) (Paper 22). The Board based its decision (in part) on the additional fact that the time for appeal of the earlier final written decision had lapsed. The same course of action is appropriate here, as Patent Owner's time for appeal of the 1501 FWD has expired and claims 1, 2, and 4 challenged in the instant proceeding have been finally determined to be unpatentable. The Board's authority to terminate can be found in 35 USC § 315(d).

For avoidance of doubt, Petitioner respectfully submits that vacating the Decision to Institute is not appropriate. *See Ex. 1026, 10:3-12:4*. The Board has previously vacated an institution decision in very limited circumstances (*e.g.*, no jurisdiction to review patent, defective petition, or misapprehension of claim dependency). None of those circumstances exist here, and accordingly, Petitioner respectfully submits that, while termination-in-part of this proceeding as moot is appropriate for the reasons set forth above, vacating the present Decision to Institute (even in-part) is not warranted.

Because challenged claims 1, 2, and 4 have already been finally determined to be unpatentable, any decision the Board might reach in this proceeding regarding those claims would be moot and purely advisory. The Parties therefore respectfully request that the Board partially terminate the present proceeding, but only as to claims 1, 2, and 4, for which the present proceeding is now moot.

Respectfully submitted,



/David W. O'Brien/

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