

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 7,777,753 B2

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

ARPIN, *Administrative Patent Judge*.

DECISION
Partial Termination of *Inter Partes* Review
37 C.F.R. § 42.72

BACKGROUND

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 4, 7–10, and 12 (“the challenged claims”) of U.S. Patent No. 7,777,753 B2 (Ex. 1001, “the ’753 patent”). Paper 2. On December 7, 2016, we instituted trial for all of the challenged claims of the ’753 Patent. Paper 7. Subsequently, in a separate proceeding involving the ’753 patent, we issued a Final Written Decision pursuant to 35 U.S.C. § 318(a) determining claims 1–4 of the ’753 patent to be unpatentable. *HTC Corp. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01501, slip op. at 37 (PTAB January 4, 2017) (Paper 53). On February 22, 2017, we issued an Order to Show Cause why the instant proceeding should not be terminated with respect to claims 1, 2, and 4 in view of the determination that claims 1–4 of the ’753 patent are unpatentable. Paper 27, 2. After a conference call with the parties on February 27, 2017, we issued an Order authorizing the parties to file a Joint Motion to Terminate the instant proceeding with respect to claims 1, 2, and 4 in lieu of a response to the Order to Show Cause. Paper 28, 3. On March 10, 2017, the parties filed a Joint Motion to Partially Terminate the instant proceeding. Paper 31.

In their Joint Motion to Partially Terminate, the parties indicate that the time period has lapsed for appealing the Final Written Decision in *HTC Corporation v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01501, to the U.S. Court of Appeals for the Federal Circuit. *See*

Paper 31, 1. Therefore, three of the challenged claims in the instant *inter partes* review, i.e., claims 1, 2, and 4 of the '753 patent, are unpatentable.¹

The particular facts before us indicate that it is appropriate to terminate this *inter partes* review. *See* 37 C.F.R. § 42.72. We already have determined that claims 1–4 of the '753 patent are unpatentable, and, therefore, any decision we might reach in the instant proceeding regarding the patentability of these claims would be moot and purely advisory. *See* Paper 31, 2 (“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.”). Furthermore, rendering a Final Written Decision in the instant proceeding would not promote securing the just, speedy, and inexpensive resolution of every proceeding or the efficient utilization of the Board’s limited resources. *See* 37 C.F.R. § 42.1(b).

¹ In addition, Parthenon Unified Memory Architecture (“Patent Owner”) did not file a Patent Owner Response or a Motion to Amend in the instant proceeding with respect to claims 1, 2, or 4 of the '753 patent. *See* Paper 31, 1; *see also* Paper 29, 2 (“The Board held that claims 1–4 are unpatentable in IPR2015-01501. Therefore, this response is directed to an analysis of grounds 3–6 of the above Instituted Grounds.”). In the Scheduling Order for the instant proceeding, “[t]he patent owner [was] cautioned that any arguments for patentability not raised and fully briefed in the response will be deemed waived.” Paper 8, 3.

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ORDER

In consideration of the foregoing, it is hereby:

ORDERED that we grant the parties' Joint Motion to Partially Terminate and, as a result, we terminate this *inter partes* review as moot with respect to claims 1, 2, and 4 of the '753 patent.

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