

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Cases IPR2016-01733
Patent 9,189,437 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

We instituted *inter partes* review in this proceeding on February 8, 2017. Paper 7. Patent Owner's Response is due May 10, 2017. *See* Paper 8, 6.

In the meantime, it has come to our attention that the '437 patent may expire near the time of the statutory deadline for our final written decision—February 8, 2018. *See, e.g.*, Case No. IPR2016-01839 (challenging a related patent), Paper 13, 14. The expiration date may affect the standard of claim construction the Board applies in post-grant proceedings—for unexpired patents, we usually apply the broadest reasonable interpretation standard, but, for expired patents, we apply a standard that is similar to the construction standard applied by U.S. district courts. *See Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed. Cir. 2015) (en banc). 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (upholding the Office regulation requiring the use of the broadest reasonable interpretation standard in the context of *inter partes* review); *In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012); *see also Black & Decker, Inc. v. Positec USA, Inc.*, 646 F. App'x. 1019, 1024 (non-precedential) (applying the Phillips standard to construe the claims of an expired patent in an *inter partes* review).

Accordingly, we require the parties in their briefing (i.e., the Patent Owner Response and the Petitioner's Reply) to address (1) the claim construction standard that properly should be applied in this proceeding, and (2) construction under both standards (i.e., broadest reasonable interpretation and the standard that is similar to the U.S. district court standard) for each term that needs to be construed explicitly in the final written decision.

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Patent 9,189,437 B2

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