

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,  
Patent Owner.

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Case IPR2016-01839  
Patent 6,470,399 B1

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Before JONI Y. CHANG, JAMES B. ARPIN, and  
MIRIAM L. QUINN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

Petitioner filed a Petition requesting an *inter partes* review of claims 1, 3, 5, 11, and 14 of U.S. Patent No. 6,470,399 B1 (Ex. 1001, “the ’399 patent”). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 12 (“Prelim. Resp.”).

Claims of an *expired* patent are given their ordinary and customary meaning in accordance with *Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *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 Cir. 2012); *see also Black & Decker, Inc. v. Positec USA, Inc.*, 646 F. App’x. 1019, 1024 (non-precedential) (applying the *Phillips* standard to construe the claims of an expired patent in an *inter partes* review). In contrast, claim terms in an *unexpired* patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 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).

Although Petitioner indicates that the U.S. Court of Appeals for the Federal Circuit has construed certain terms under the *Phillips* standard in connection with a related district court proceeding involving the ’399 patent, neither party indicates whether the ’399 patent will expire within 18 months of the entry of the Notice of Filing Date Accorded to Petition, pursuant to 37 C.F.R. § 42.100(b). Pet. 9–11 (citing *In re Papst Licensing GmbH & Co. KG Litig. v. Fujifilm corp.*, 778 F.3d 1255 (Fed. Cir. 2015); Ex. 1016); Prelim. Resp. 7–9. Nevertheless, the ’399 patent, on its face, appears to expire on March 3, 2018—20 years from its March 3, 1998, filing date

(Ex. 1001 at [22])—within 1 year from the date of this Order. At this juncture, the instant proceeding is in its preliminary phase, and we have not yet decide whether to institute a trial. In order to determine the applicable claim construction standard for this proceeding, it is necessary for us to ascertain the expiration date of the '399 patent. We hereby seek additional information from Patent Owner regarding the expiration date of the '399 patent, pursuant to 37 C.F.R. § 42.5.

In light of the foregoing, it is:

ORDERED that, within three business days of the entry date of this Order, Patent Owner shall file a notice that sets forth the expiration date of the '399 patent; the notice may include a brief explanation of Patent Owner's determination of the expiration date, not exceeding two pages, but no argument is permitted.

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Patent 6,470,399 B1

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