

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP,
Petitioner,

v.

III HOLDINGS 4, LLC
Patent Owner.

Case IPR2017-00782
Patent 8,654,999 B2

Before SALLY C. MEDLEY, DAVID C. McKONE, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

ORDER

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

The Institution Decision in IPR2017-00782 instituted a trial on claims 10, 11, 13–15, and 20 of U.S. Patent No. 8,654,999 B2 (Ex. 1101, “the ’999 patent”) but not claim 12. Paper 8, 33. Subsequently, on April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018).

We convened a teleconference on April 26, 2018, to discuss the impact of the Supreme Court’s decision on the oral argument, scheduled for May 1, 2018. The parties and the panel agreed to hold the oral argument as scheduled. Nevertheless, we directed the parties to consult with their respective clients and meet and confer with each other to discuss the treatment of claim 12 going forward.

We held the oral argument on May 1, 2018, as scheduled.¹ At the oral argument, both parties requested on the record that claim 12 be withdrawn from the proceeding. In light of these representations, the Board authorizes the parties to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the claim and ground upon which we did not institute in our Decision on Institution. *See, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision).

¹ The oral hearing jointly considered IPR2017-00782 and IPR2017-00781. IPR2017-00781 involves the same parties and challenges the same patent. That proceeding, however, challenges different claims of the ’999 patent. We instituted a trial on all challenged claims and all petitioned grounds in that proceeding.

IPR2017-00782
Patent 8,654,999 B2

In consideration of the foregoing, it is hereby:

ORDERED that the parties are authorized to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing claim 12.

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