

Filed: May 14, 2018

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 No. 8,654,999

JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. § 42.71

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71 and the Order issued May 7, 2018 authorizing this motion, Petitioner K/S HIMPP and Patent Owner III Holdings 4 LLC jointly request limiting the petition in *inter partes* review IPR2017-00782 of U.S. Patent No. 8,654,999 (“the ’999 patent”) to claims 10, 11, 13–15, and 20. The parties respectfully request that the Board remove claim 12 of the ’999 patent from this proceeding.

II. STATEMENT OF FACTS

K/S HIMPP filed this petition for *inter partes* review on January 27, 2017 requesting review of claims 10-15 and 20 of the ’999 patent. The review was instituted for claims 10, 11, 13-15, and 20, but not claim 12, on July 27, 2017. 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 (U.S. Apr. 24, 2018). At the oral argument on May 1, 2018, both parties requested on the record that the non-instituted claim—claim 12—be withdrawn from the proceeding. The Order, issued May 7, 2018, authorized the parties to file a Joint Motion to Limit the Petition by removing the claim and ground not instituted in the Decision on Institution.

III. ARGUMENT

A. Limiting the Petition in IPR2017-00782 is Appropriate

The Board should limit the petition in IPR2017-00782 for at least the

following reasons.

First, both parties have agreed to limit this proceeding by removing claim 12, as stated at oral argument on May 1, 2018.

Second, removing claim 12 promotes efficient use of the resources of the Board and saves expense for the parties. The oral argument in the proceeding has already been held and, without claim 12, there would be no need for supplemental briefing and/or a supplemental hearing.

B. Summary

For the foregoing reasons, both parties respectfully request that the Board remove claim 12 of the '999 patent from this *inter partes* review proceeding, and limit the petition in this *inter partes review* proceeding to claims 10, 11, 13-15, and 20 of the '999 patent.

Respectfully submitted,

/Haixia Lin/

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Counsel for Petitioner

Respectfully submitted,

/Henry A. Petri, Jr./

Henry A. Petri, Jr.
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Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on May 14, 2018, I caused a true and correct copy of the foregoing materials:

- Joint Motion to Limit Petition Under 37 C.F.R. § 42.71

to be served electronically via e-mail to the following:

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