

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

Granting Joint Motion to Limit the Petition
37 C.F.R. § 42.20

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*, 138 S. Ct. 1348, 1369–60 (2018).

At the May 1, 2018, oral argument, both parties requested on the record that claim 12 be withdrawn from the proceeding. In light of these representations, we authorized the parties to file a Joint Motion to Limit the Petition by removing the claim and ground upon which we did not institute in our Decision on Institution. Paper 25; *see also 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). On May 14, 2018, pursuant to that authorization, the parties filed a Joint Motion to Limit the Petition. Paper 26. Specifically, “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.” *Id.* at 2.

Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. *See* 37 C.F.R. § 42.1(b); *Apotex*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19); *SAS*, 138 S. Ct. at 1357. Accordingly, we grant the Joint Motion to Limit the Petition. As such, the challenge to claim 12 is removed from dispute in this proceeding. The

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grounds remaining in dispute are the challenge to claims 10, 13, 14, and 20, based on obviousness under 35 U.S.C. § 103, over Fichtl and Mangold, and the challenge to claims 11 and 15, based on obviousness under 35 U.S.C. § 103, over Fichtl, Mangold, and Sacha.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Limit the Petition is *granted*;

FURTHER ORDERED that the Petition is limited to the ground of unpatentability asserted against claims 10, 13, 14, and 20, based on obviousness under 35 U.S.C. § 103, over Fichtl and Mangold, and the ground of unpatentability asserted against claims 11 and 15, based on obviousness under 35 U.S.C. § 103, over Fichtl, Mangold, and Sacha.

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