

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA), INC.

Petitioner,

v.

FRACTUS, S.A.

Patent Owner.

Case No.: IPR2018-01461

Patent No. 9,054,421

Issue Date: June 9, 2015

**PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION
FOR DISTRICT COURT-TYPE CLAIM CONSTRUCTION
UNDER 37 C.F.R. §42.20**

Pursuant to the Board's email dated December 10, 2018, Petitioner submits this response to Patent Owner's Motion for District Court-Type Claim Construction Under 37 C.F.R. §42.20.

Petitioner agrees with Patent Owner that the underlying patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to the instant Petition. Accordingly, the Petitioner agrees that the Board should construe the claims under the framework laid out in the *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

While Petitioner recognizes the recent revisions to Rule 37 C.F.R. §42.100(b) (effective date November 13, 2018), 83 Fed. Reg. 51340, 51340 (Oct. 11, 2018), are not applicable to the instant petition¹, in promulgating the revisions to Rule 37 C.F.R. §42.100(b), the Patent Office provided commentary shedding light on the manner in which prior claim construction determinations would be applied by the Board. 83 Fed. 51340, 51355. Specifically, the Patent Office explained, "The suggestion that the PTAB must necessarily defer to prior claim constructions are not adopted." *Id.* (Response to Cmt. 30.) The Patent Office further explained, in its October 11, 2018 commentary, that "[n]on exclusive factors to be considered [when determining the appropriate weight to give prior claim construction determinations] may include for

¹ Petitioner filed its Petition on August 3, 2018.

example, how thoroughly reasoned the prior decision is and the similarities between the record in the district court . . . and the record before the PTAB. It also be may be relevant whether the prior claim construction is final or interlocutory.” *Id.*

The current IPR record does not include the parties’ district court claim construction briefs,² the Eastern District of Texas’ claim constructions are interlocutory and have not been affirmed by the Federal Circuit Court of Appeals, and the underlying case has been transferred from the Eastern District of Texas to the Northern District of Texas³. As of the filing of this Response, no scheduling order has issued from the Northern District of Texas, and the new court has not indicated whether it will adopt the previously issued claim construction order or perform any additional claim construction analysis.

In view of the above, Petitioner respectfully requests that the Board conduct its own independent claim construction analysis under the *Phillips* standard to delineate the meaning of the claim terms and the scope of the claimed invention in view of “the words of the claims themselves, the remainder of the specification, the

² Upon approval from the Board, the Petitioner can file the parties’ claim construction briefs so that the Board has a complete record of information that was submitted to the district court.

³ *See, e.g.*, Patent Owner’s Updated Mandatory Notices (Paper 7) in IPR2018-01451.

prosecution history, and extrinsic evidence concerning relevant scientific principles
the meaning of technical terms, and the state of the art.” *Phillips*, 415 F.3d at 1314.

Dated: January 4, 2019

Respectfully submitted,
BRINKS GILSON & LIONE

/James R. Sobieraj/
James R. Sobieraj
Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION FOR DISTRICT COURT-TYPE CLAIM CONSTRUCTION UNDER 37 C.F.R. §42.20 was served on January 4, 2019, upon the following counsel of record for Patent Owner by electronic mail.

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