

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE (USA), INC.  
Petitioner,

v.

FRACTUS, S.A.  
Patent Owner.

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Case IPR2018-01461  
Patent 9,054,421

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

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## I. AUTHORIZATION

The Board authorized Patent Owner to file the present motion in an email to counsel of record for both parties dated November 29, 2018.

## II. RELIEF REQUESTED

Patent Owner Fractus, S.A. (“Patent Owner”) requests a district court-type claim construction approach to be applied in this proceeding, in accordance with 37 C.F.R. § 42.20 and 37 C.F.R. § 42.100(b).

In 2016, the USPTO amended 37 C.F.R § 42.100(b) to give the Board discretion to apply a district court-style claim construction approach “for claims of patents that will expire before entry of a final written decision.” Amendments to the Rules of Practice for Trials before the Patent Trial and Appeal Board, 81 Fed. Reg. 18750, 18750 (Apr. 1, 2016). The amended rule allows a party to request a district court-type claim construction approach to be applied “if a party certifies that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition.” *Id.*, at 18766.

Here, the parties are in agreement that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition, and Patent Owner certifies same below. *See* Certification, Section II, *infra*; *see also* Petition, Paper 2, at 19. The parties are also in agreement that a district court-type claim construction should be applied in this proceeding. *See* Petition, Paper 2, at

19 (“ . . . the claims should be reviewed under the standard in Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)(en banc)”), and Patent Owner Preliminary Response, Paper 6, at 17. Accordingly, application of a district court-type claim construction is appropriate.

## II. CERTIFICATION

Patent Owner certifies that U.S. Patent No. 9,054,421 (“the ‘421 Patent’”) will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition.

The ‘421 Patent is based on an application filed on January 2, 2013 and claims priority through a series of continuing applications to an international application filed on September 20, 1999. Ex. 1001, at pp. 1-2. The ‘421 Patent includes 131 days of patent term adjustment. *Id.*, at p. 1. The ‘421 Patent is subject to a terminal disclaimer with respect to U.S. Patent No. 8,941,541, Ex. 2037, but the terminal disclaimer does not affect the term of the ‘421 Patent because U.S. Patent No. 8,941,541 expires after the ‘421 Patent. Therefore, the term of the ‘421 Patent expires on January 29, 2020. *See* 35 U.S.C. § 154(a)(2); *see also* Petition, Paper 2, at 19 (“ . . . the ‘421 patent expires on January 29, 2020 . . .”); and Patent Owner Preliminary Response, Paper 6, at 17.

The Notice of Filing Date Accorded to Petition was entered on September 7, 2018. The date that is 18 months from the Notice of Filing Date Accorded to

Petition (i.e., March 7, 2020) is after the date of expiration of the '421 Patent (i.e., January 29, 2020). Thus, the '421 Patent will expire within 18 months of the Notice of Filing Date Accorded to Petition.

Accordingly, Applicant requests that this motion for a district court-type claim construction approach be granted.

Dated: December 7, 2018

Respectfully submitted,  
/Jason Shapiro/  
Jason Shapiro (Reg. No. 35,354)  
Attorney for Patent Owner  
Fractus, S.A.

**CERTIFICATE OF SERVICE**

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing PATENT OWNER'S MOTION FOR DISTRICT COURT-TYPE CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.20 was served via email (as previously consented to by counsel) on December 7, 2018 to lead and backup counsel of record for Petitioners as follows:

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Dated: December 7, 2018

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