

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,
Petitioner,

v.

FRACTUS, S.A.,
Patent Owner.

Case IPR2018-01451 Patent 7,397,431 B2
Case IPR2018-01455 Patent 7,394,432 B2
Case IPR2018-01456 Patent 8,941,541 B2
Case IPR2018-01457 Patent 8,976,069 B2
Case IPR2018-01461 Patent 9,054,421 B2
Case IPR2018-01462 Patent 9,240,632 B2
Case IPR2018-01463 Patent 9,362,617 B2¹

Before PATRICK M. BOUCHER, KEVIN C. TROCK,
JOHN A. HUDALLA and AVELYN M. ROSS,
Administrative Patent Judges.

TROCK, *Administrative Patent Judge.*

DECISION

Granting Motion for District Court-Type Claim Construction
37 C.F.R. § 42.100(b)(2016)

¹ This Decision applies to each of the listed cases. We exercise our discretion

DISCUSSION

On November 19, 2018, Patent Owner contacted the Board by email with a “request to file Motions under 37 CFR 42.20 to Request a District Court-Type Claim Construction in *inter partes* reviews IPR2018-01456, -01451, -01455, -01457, and -01462.”² Ex. 3001. In its email, Patent Owner also stated, “Patent Owner believes there is good cause for such motions because, among other things, the patents in IPR2018-01451, -01455, -01457, and -01462 will all expire within 18 months of the entry of the Notice of Filing Date Accorded to Petition, the patent in IPR2018-01456 will expire a few days later and before any appeal is concluded.” *Id.* On November 29, 2018, the Board responded by email authorizing the request, and indicated that Patent Owner could also file such a motion in IPR2016-01461. *Id.*

On December 7, 2018, Patent Owner filed a Motion for District Court-Type Claim Construction under 37 C.F.R. § 42.100(b)(2016) in all the cases identified in the Appendix (“these proceedings”), except for IPR2018-01463, in which the motion was filed on December 20, 2018, and IPR2018-01456, in which no motion was filed. Paper 8 (“Mot.”).³ In each Motion, Patent Owner certifies that the challenged patent will expire within 18 months of the entry of the Notice of Filing Date Accorded to Petition (Paper 8, 3), except for case IPR2018-01456, which Patent Owner indicates in its email request will expire a few days later, and requested that we apply a district court-type claim construction approach in each case (Paper 8, 2).

² Patent Owner made a similar request by email in IPR2018-01463 on December 14, 2018, which was granted.

³ Substantially identical papers were filed in each of the cases. Paper numbers and pages referenced are for IPR2018-01451.

On January 4, 2019, Petitioner filed a Response to each of the motions. Paper 10 (“Resp.”). In each of its Responses, 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” (Paper 10, 1), and “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).” *Id.*

37 C.F.R. § 42.100(b)(2016) provides that

A party may 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. The request, accompanied by a party’s certification, must be made in the form of a motion under § 42.20, within 30 days from the filing of the petition.

The Petitions in these cases have filing dates of August 3, 2018, with the exception of IPR2018-01455, which has a filing date of August 2, 2018. What is not addressed by the parties in their papers, however, is the requirement in 37 C.F.R. § 42.100(b) that “[t]he request, accompanied by a party’s certification, must be made in the form of a motion under § 42.20, *within 30 days from the filing of the petition.*” 37 C.F.R. § 42.100(b)(2016) (emphasis added). Here, Patent Owner’s email sent to the Board requesting leave to file such a motion is dated November 16, 2018, well beyond the 30 day time period.

Petitioner explains that it “is contemporaneously filing additional *inter partes* review (“IPR”) petitions on 6 patents that are based on the same specification as the ’431 patent, namely U.S. Patent Nos. 7,394,432 (IPR2018-01455); 8,941,541 (IPR2018-01456); 8,976,069 (IPR2018-01457); 9,054,421 (IPR2018-01461); 9,240,632 (IPR2018- 01462); and 9,362,617 (IPR2018-01463).” This suggests that any claim construction issues in these

proceedings may have substantial overlap, and that it would be appropriate to use the same claim construction standard in all of the cases, including IPR2018-01456.

Moreover, the Board's prior policy of using the Broadest Reasonable Interpretation (BRI) standard for construing unexpired and proposed amended patent claims in proceedings under the America Invents Act (AIA) has changed. For AIA petitions filed on or after November 13, 2018, the new standard is the same as that applied in Article III courts and the International Trade Commission (ITC) under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). 37 C.F.R. § 42.100(b) (2018); *see also* 83 Fed. Reg. 51340 (Oct. 11, 2018) (revising the claim construction standard for interpreting claims in AIA proceedings before the Board). The new rule helps ensure, among other things, consistency in claim construction between the Board and proceedings in district court or at the ITC, and increases judicial efficiency. 83 Fed. Reg. at 51342.

Pursuant to 37 C.F.R. § 42.5, we have discretion to waive or suspend a requirement under Part 42. Given the identity of the parties in these proceedings, the apparent agreement by the parties to use the *Phillips* claim construction standard, the relationship among the patents being contested, the likelihood of significant overlap in claim construction issues, the recent change to use the *Phillips* claim construction standard by the Board, and the expected consistency and judicial efficiency of using a single claim construction standard in these cases, we waive the 30 day requirement of 37 C.F.R. § 42.100(b) (2016) for these cases and *grant* each of Patent Owner's Motions to use the *Phillips* claim construction standard in these proceedings, including IPR2018-01456.

ORDER⁴

It is, therefore,

ORDERED that Patent Owner's Motions for District Court-Type Claim Construction are *granted*; and

FURTHER ORDERED that the *Phillips* claim construction standard shall be used in each of the above-captioned cases.

⁴ This is not an order from an expanded panel of the Board. Judges Boucher, Trock, and Hudalla are paneled on IPR2018-01451, IPR2018-01455, IPR2018-01456, IPR2018-01457, and IPR2018-01461. Judges Boucher, Hudalla, and Ross are paneled on IPR2018-01462 and IPR2018-01463.

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