

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. AND ZTE (USA) INC.,  
Petitioners,

v.

INVT SPE LLC,  
Patent Owner.

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Case IPR2018-01477  
Patent 7,848,439 B2

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Before THU A. DANG, KEVIN F. TURNER, and BARBARA A. BENOIT,  
*Administrative Patent Judges.*

BENOIT, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

Apple Inc. and ZTE (USA) Inc. (collectively, “Petitioner”) filed a Petition (Paper 1) seeking *inter partes* review of claims 1–11 of U.S. Patent No. 7,848,439 B2. Patent Owner, INVT SPE LLC, filed a Preliminary Response (Paper 7) on December 13, 2018.

On January 4, 2019, Petitioner contacted the Board to request authorization to file a five-page reply to Patent Owner’s argument that institution should be denied for efficiency reasons because the challenged patents are at issue in a parallel investigation before the International Trade Commission (“ITC”). Petitioner represented that Patent Owner opposed Petitioner’s request unless Patent Owner would be permitted a sur-reply.

We authorize Petitioner to file a reply to Patent Owner’s Preliminary Response limited to addressing Patent Owner’s argument in Section IX that institution should be denied for efficiency reasons because the challenged patents are at issue in a parallel investigation before the ITC (Paper 7, 60–62). Petitioner’s reply is limited to five pages and is to be filed no later than Wednesday, January 16, 2019. No new evidence is permitted to be filed with Petitioner’s reply. Patent Owner is authorized to file a sur-reply no later than Wednesday, January 23, 2019, and is also limited to five pages.

The parties may wish to address differences in remedies available in each forum and differences in claim construction standards applied in the proceedings in each forum.<sup>1</sup> The parties also may wish to address with

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<sup>1</sup> The Petition was filed on August 21, 2018. Paper 6 (Notice of Filing Date Accorded). *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018)(final rule) (“This rule is effective on November 13, 2018 and applies to all IPR, PGR and CBM petitions filed on or after the effective date.”).

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particularity the extent that issues—such as the prior art and statutory basis for unpatentability or invalidity asserted in each proceeding and claim constructions proposed by the parties in each case—overlap in the two proceedings.

It is so ORDERED.

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