

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 IPR2018-01478  
Patent 6,760,590 B2

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Before THU A. DANG, BARBARA A. BENOIT, and J. JOHN LEE,  
*Administrative Patent Judges.*

BENOIT, *Administrative Patent Judge.*

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

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Apple Inc. and ZTE (USA) Inc. (collectively, “Petitioner”) filed a petition (Paper 1) seeking *inter partes* review of claims 1–8 of U.S. Patent No. 6,760,590 B2. Patent Owner, INVT SPE LLC, filed a Preliminary Response (Paper 7) on November 29, 2018.

On Saturday, January 26, 2019, Petitioner contacted the Board by e-mail (Ex. 3001) to request authorization to file a reply to Patent Owner’s argument that institution should be denied for efficiency reasons because the challenged patent is at issue in a parallel investigation before the International Trade Commission (“ITC”). Petitioner correctly noted that the Board had granted Petitioner’s similar request in IPR2018-01474 and IPR2018-01477, authorizing Petitioner to file a five page reply and Patent Owner to file a five page sur-reply in each proceeding. Petitioner requests the same here. Petitioner also represented that Patent Owner had not responded to Petitioner’s January 21 and January 24 inquiries regarding Patent Owner’s position on this request.

The timing of Petitioner’s request is problematic. Petitioner made its request two months after Patent Owner filed its Preliminary Response (November 29, 2018) and only one month before the non-extendable statutory deadline for issuing a decision whether to institute an *inter partes* review (February 28, 2019). In many situations, such timing alone may dictate denial of a petitioner’s request for additional briefing.

Here, we recognize that the requested briefing has been completed by both parties in other concurrent proceedings—IPR2018-01474 (as of January 23, 2019) and IPR2018-01477 (as of January 23, 2019). Allowing the parties to brief the identical issue here may facilitate the Board’s ability to maintain consistency in addressing this identical issue across these

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proceedings, each of which is to be decided separately on its own record. This factor is not dispositive, however.

Critically important here is the ability of the panel to consider the authorized briefing requested by Petitioner at such a late point during this preliminary proceeding to decide whether to institute *inter partes* review. Despite the problematic timing of Petitioner's request, in view of the particular facts and circumstances of this case, we have determined that we would be able to consider the requested reply and sur-reply, but only if briefing is completed and filed on an expedited basis.

Accordingly, we authorize Petitioner to file a reply to Patent Owner's Preliminary Response limited to addressing Patent Owner's argument in Section VII that institution should be denied for efficiency reasons because the challenged patent is at issue in a parallel investigation before the ITC (Paper 7, 52–54). Petitioner's reply is limited to five (5) pages and to be filed no later than Friday, February 1, 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, February 6, 2019. Patent Owner's sur-reply is limited to five (5) pages.

It is so ORDERED.

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FOR PETITIONERS:

Adam P. Seitz  
Paul R. Hart  
ERISE IP, P.A.  
Adam.Seitz@eriseip.com  
Paul.Hart@eriseip.com

Bing Ai  
Vinay P. Sathe  
Babak Tehranchi  
Kevin J. Patariu  
John P. Schnurer  
PERKINS COIE LLP  
Ai-ptab@perkinscoie.com  
VSathe@perkinscoie.com  
BTehranchi@perkinscoie.com  
KPatariu@perkinscoie.com  
JSchnurer@perkinscoie.com

FOR PATENT OWNER:

Cyrus A. Morton  
Bryan J. Vogel  
Derrick J. Carman  
Stephanie A. Diehl  
Li Zhu  
ROBINS KAPLAN LLP  
CMorton@RobinsKaplan.com  
BVogel@RobinsKaplan.com  
DCarman@RobinsKaplan.com  
SDiehl@RobinsKaplan.com  
LZhu@RobinsKaplan.com