

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FINTIV, INC.,
Patent Owner.

IPR2020-00019
Patent 8,843,125 B2

Before WILLIAM M. FINK, *Vice Chief Administrative Patent Judge*, and
LINDA E. HORNER and LYNNE E. PETTIGREW, *Administrative Patent
Judges*.

PETTIGREW, *Administrative Patent Judge*.

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

A conference call was held on December 5, 2019, among Judges Horner and Pettigrew and respective counsel for Petitioner, Apple Inc., and Patent Owner, Fintiv, Inc. Petitioner requested the call to seek leave to file the *Markman* order recently issued by the district court in *Fintiv, Inc. v. Apple Inc.*, Case No. 6:18-CV-372-ADA (W.D. Tex.), and a paper addressing how Petitioner contends the prior art satisfies one claim construction provided by the district court that was not proposed by either party. Patent Owner informed us before the call that it opposes Petitioner's request.

DISCUSSION

The Petition in this case was filed on October 28, 2019. *See* Paper 1. The Board entered the Notice of Filing Date Accorded to the Petition on November 15, 2019. *See* Paper 3. According to Petitioner, the district court issued its *Markman* order on November 27, 2019.

Petitioner stated on the call that, in the district court proceeding, the parties had proposed constructions for seven disputed claim terms. Petitioner further explained that the district court adopted either Apple's or Fintiv's proposed construction for six of the disputed claim terms, but for the seventh term—"over-the air (OTA) proxy" or "OTA proxy"—the district court did not adopt either party's proposal and provided its own construction. During the call, Patent Owner agreed with Petitioner's characterization of the district court's *Markman* order.

Petitioner seeks to file the district court's *Markman* order and a short paper with accompanying exhibits to address how Petitioner contends the prior art satisfies the term "OTA proxy" as construed by the district court. According to Petitioner, the Petition analyzes the claims and the prior art

IPR2020-00019
Patent 8,843,125 B2

under both parties' constructions of the term but not under the district court's later-issued construction.

Patent Owner opposes Petitioner's request. Among other reasons provided on the call, Patent Owner argues it would suffer prejudice if we authorize Petitioner's request because the filing deadline for its preliminary response is February 15, 2019.

In *inter partes* review proceedings, pursuant to a 2018 amendment to our rules, the Board now uses the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b) (2019); *see* Patent Trial and Appeal Board Consolidated Trial Practice Guide 45–46 (Nov. 19), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“Trial Practice Guide”). The revised rule also provides that any prior claim construction determination concerning a claim term in a civil action that is timely made of record in an *inter partes* review will be considered. 37 C.F.R. § 42.100(b). The Trial Practice Guide provides that “[p]arties should submit a prior claim construction determination by a federal court . . . in an AIA proceeding as soon as that determination becomes available.” Trial Practice Guide 47.

As we ruled during the conference call, we *grant* Petitioner's request under the particular circumstances in this case. A district court claim construction determination preferably should be submitted with a paper such as a petition or preliminary response, along with explanations. *See* Trial Practice Guide 47. Nevertheless, in our view the timing here warrants submission of the *Markman* order along with a supplemental brief by Petitioner so that the district court's claim construction and Petitioner's arguments are on record as soon as possible in this proceeding. The district

IPR2020-00019
Patent 8,843,125 B2

court issued its *Markman* order only one month after the Petition in this case was filed, and Petitioner promptly requested authorization to file the *Markman* order and a short brief. Moreover, Patent Owner still has more than ten weeks to file a preliminary response, providing ample time for Patent Owner to incorporate into that paper any response to arguments in Petitioner's supplemental brief. As stated on the call, we will increase the word limit for any preliminary response filed by Patent Owner in an amount equal to the word limit of Petitioner's supplemental brief.

ORDER

Accordingly, it is:

ORDERED that Petitioner is authorized to file the district court's *Markman* order as an exhibit;

FURTHER ORDERED that Petitioner is authorized to file a supplemental brief addressing how Petitioner contends the prior art satisfies the claim term "OTA proxy" under the district court's construction of that term, along with accompanying exhibits;

FURTHER ORDERED that Petitioner's supplemental brief shall be no longer than 1,000 words and shall be filed no later than December 9, 2019;

FURTHER ORDERED that the word limit for any preliminary response filed by Patent Owner is increased to 15,000 words; and

FURTHER ORDERED that the due date for a preliminary response remains unchanged.

IPR2020-00019
Patent 8,843,125 B2

PETITIONER:

Travis Jensen
K. Patrick Herman
ORRICK, HERRINGTON & SUTCLIFFE LLP
T61ptabdocket@orrick.com
P52ptabdocket@orrick.com

PATENT OWNER:

Jonathan Waldrop
Rodney Miller
John Downing
KASOWITZ BENSON TORRES LLP
jwaldrop@kasowitz.com
rmiller@kasowitz.com
jdowning@kasowitz.com