

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMKOR TECHNOLOGY, INC.  
Petitioner

v.

TESSERA, INC.  
Patent Owner

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Case IPR2013-00242  
Patent 6,046,076

Before KEVIN F. TURNER, JUSTIN T. ARBES, and  
CARL M. DeFRANCO, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on April 4, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Turner, Arbes, and DeFranco.<sup>1</sup> The call was requested by Patent Owner to discuss its intent to file a terminal disclaimer of the remaining term of the challenged patent, U.S. Patent No. 6,046,076 (“the ’076 patent”).

Patent Owner argued that the claims of an unexpired patent are given their broadest reasonable interpretation in post-grant proceedings before the Office, but for claims of an expired patent, the claim interpretation analysis is similar to that of a district court, citing *Ex Parte Ronald A. Katz Tech. Licensing L.P.*, Appeal 2008-005127, 2010 WL 1003878 (BPAI Mar. 15, 2010). Patent Owner explained that there was a dispute between the parties previously as to whether the ’076 patent expires in 2014 or 2017 (due to a continuation-in-part application in the application chain leading to the ’076 patent). However, Patent Owner now agrees that the ’076 patent will expire in December 2014. Patent Owner stated that it intends to file a terminal disclaimer of the remaining term of the ’076 patent, such that the patent will be expired and the Board should not apply the broadest reasonable interpretation standard to the challenged claims. Patent Owner requested authorization, if the terminal disclaimer is filed, to file a motion to terminate the proceeding on the basis that the Board applied the broadest reasonable interpretation standard in the decision to institute this *inter partes* review. Alternatively, Patent Owner requested that the hearing in this proceeding be delayed.

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<sup>1</sup> A court reporter, retained by Patent Owner, was present on the call. Patent Owner shall file the transcript of the call as an exhibit in this proceeding.

Petitioner opposed Patent Owner's requests, arguing that Patent Owner improperly delayed until all substantive briefing in this proceeding was completed to raise the terminal disclaimer issue. Petitioner asserted that Patent Owner should have raised the issue in its response when Patent Owner had the opportunity to state how it believes the challenged claims should be interpreted. Petitioner further disputed that there was ever any disagreement regarding the expiration date of the '076 patent, and argued that the Board should continue to apply the broadest reasonable interpretation standard in this proceeding.

During the call, we stated that we would not order Patent Owner to file or not to file the terminal disclaimer at this time, but authorized Patent Owner to notify the Board if it files a terminal disclaimer. Patent Owner subsequently filed its terminal disclaimer on April 11, 2014, and notified the Board accordingly. *See* Paper 115; Ex. 2131.

The present situation appears to be an issue of first impression in *inter partes* reviews. As such, we are persuaded that briefing from the parties is warranted. Pursuant to 37 C.F.R. § 42.3(a), “[t]he Board may exercise exclusive jurisdiction within the Office over every involved . . . patent during the proceeding, as the Board may order.” In their papers, the parties should state what action(s), if any, they believe the Board should take with respect to the terminal disclaimer and with respect to this proceeding in general. The parties should take into account the late stage of this proceeding and the fact that all substantive briefing has been completed. Also, each party should explain its position as to the appropriate standard for interpreting the challenged claims when the Board issues its final written decision, provide a proposed interpretation for any limitation the party

believes differs depending on whether it is given its broadest reasonable interpretation or interpreted as a district court would, and explain why, if the interpretation differs, the prior art at issue in this proceeding teaches or does not teach the limitation, with appropriate citations to the record.

The trial schedule set forth in the Revised Scheduling Order (Paper 91) in this proceeding is unchanged, and no motion to terminate the proceeding is authorized at this time.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file, by April 21, 2014, a brief, limited to twelve pages, addressing the issues identified above; and

FURTHER ORDERED that Petitioner is authorized to file, by April 28, 2014, a responsive brief, limited to twelve pages.

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Patent 6,046,076

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