

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HTC CORPORATION, HTC AMERICA, INC., and
ZTE (USA) INC.,
Petitioners,

v.

INVT SPE LLC,
Patent Owner.

IPR2019-01574
Patent 7,339,949 B2

Before KEVIN F. TURNER, J. JOHN LEE, and SCOTT RAEVSKY,
Administrative Patent Judges.

RAEVSKY, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
Due to Disclaimer of All Challenged Claims
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. INTRODUCTION

A. Background

Apple, Inc., HTC Corp., HTC America, Inc., and ZTE (USA) Inc. (collectively, “Petitioners”) requested an *inter partes* review of claims 16 and 19 (the “challenged claims”) of U.S. Patent No. 7,339,949 B2 (Ex. 1001, “the ’949 patent”). Paper 4 (“Petition” or “Pet.”). INVT SPE LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review, under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. For the reasons provided below, we do not institute an *inter partes* review.

B. Related Proceedings

Petitioner and Patent Owner identify related litigations involving the ’949 patent: *INVT SPE LLC v. Apple, Inc.*, Case No. 2:17-cv-03738 (D.N.J. 2017), *INVT SPE LLC v. HTC Corp. & HTC Am., Inc.*, Case No. 2:17-cv-03740 (D.N.J. 2017), *INVT SPE LLC v. ZTE Corp. & ZTE (USA) Inc.*, Case No. 2:17-cv-06522 (D.N.J. 2017), and *Certain LTE- and 3G-Compliant Cellular Commc’ns Devices*, Inv. No 337-TA-1138 (ITC). Pet. 64; Paper 6, 2.

II. ANALYSIS

Patent Owner has filed a statutory disclaimer of claims 16 and 19 of the ’949 patent. Ex. 2001. Under 37 C.F.R. § 42.107(e), “patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent,” and “[n]o *inter partes* review will be instituted based on disclaimed claims.” A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original

patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a) (2012). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee’s ownership interest in the patent; and

(4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a) (2019); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that § 253 disclaimer is “recorded” on date the Office receives disclaimer meeting requirements of 37 C.F.R. § 1.321(a) and that no further action is required in the Office).

Based on our review of Exhibit 2001 and Office public records, we conclude that a disclaimer of claims 16 and 19 of the ’949 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of November 20, 2019. Ex. 2001. Because all claims challenged by Petitioners have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), we do not institute *inter partes* review. 37 C.F.R. § 42.107(e); *Gen. Elec. Co. v. United Tech. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential).

III. ORDER

For the reasons given, it is ORDERED that no *inter partes* review is instituted for any challenged claim.

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For PETITIONER:

Adam P. Seitz
Adam.Seitz@eriseip.com
Paul R. Hart
Paul.Hart@eriseip.com

Stephen S. Korniczky
skorniczky@sheppardmullin.com
Martin R. Bader
mbader@sheppardmullin.com
Nam H. Kim
nkim@sheppardmullin.com
Ericka Jacobs Schulz
eschulz@sheppardmullin.com
Eric K. Gill
egill@sheppardmullin.com

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

For PATENT OWNER:

Cyrus Morton
Bryan Vogel
Derrick Carman

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Shui Li
Francois Ecclesiaste
ROBINS KAPLAN LLP
cmorton@robinskaplan.com
bvogel@robinskaplan.com
dcarman@robinskaplan.com
sli@robinskaplan.com
fecclesiaste@robinskaplan.com