

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01115
IPR2024-01116
IPR2024-01119
Patent 10,656,754 B1¹

Before NATHAN A. ENGELS, SHARON FENICK, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

IPR2024-01115
IPR2024-01116
IPR2024-01119
Patent 10,656,754 B1

On February 19, 2025, we held a call with counsel for both parties to discuss the following issues: (A) the consolidation of these three proceedings and (B) a potential stay of the co-pending *ex parte* reexamination of challenged patent 10,656,754 B1 (Reexamination Control No. 90/019,646).

A. Consolidation

During the conference call, the parties agreed to consolidation of these proceedings. The Board will issue an order consolidating these proceedings in due course. The parties are hereby instructed to meet and confer and attempt to reach an agreement as to a proposal for word limits for the following papers in the consolidated proceeding: (1) Patent Owner Response; (2) Petitioner's Reply; and (3) Patent Owner's Sur-Reply. The parties are also directed to meet and confer regarding any changes they deem necessary to the Scheduling Order in IPR2024-01115 (Paper 10) to accommodate the additional claims in the consolidated proceeding. The parties are ordered to send a joint email to the board with the agreed-upon proposed word limits and proposed modifications to the scheduling order (if any) within 10 business days of this order.

We note that, during the call, a question was raised regarding whether consolidation might require a longer oral argument; as discussed during the conference call, the decision regarding time provided for oral argument will be made after any requests for oral argument are filed.

IPR2024-01115
IPR2024-01116
IPR2024-01119
Patent 10,656,754 B1

B. Reexamination

During the conference call, Petitioner indicated that it was not opposed to a stay of the *ex parte* reexamination proceeding. Patent Owner, however, indicated that it opposes a stay.

We determine that the Board would benefit from briefing from the parties regarding whether to stay the *ex parte* reexamination proceeding. Both parties are hereby authorized to submit simultaneous briefs detailing their respective positions, within 10 business days of this order. Each brief is to be limited to 5 pages.

In the briefing, the parties may address the factors identified in the subsection “Considerations for When a Parallel Office Proceeding Will Be Stayed or Suspended” in the Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,656–57 (Apr. 22, 2019). Notably, one of those factors is “[w]hether amending the claim scope in one proceeding would affect the claim scope in another proceeding.” *Id.* at 16,657. To that end, the parties shall specifically identify the claims that are at issue in both the instituted *inter partes* review proceedings and in the *ex parte* reexamination proceeding. Also, in its brief, Patent Owner may, optionally, include a stipulation that it will not amend one or more of the claims in the consolidated *inter partes* review proceeding and/or in the *ex parte* reexamination proceeding.

IPR2024-01115
IPR2024-01116
IPR2024-01119
Patent 10,656,754 B1

Accordingly, it is:

ORDERED that the parties shall meet and confer on the issues affecting consolidation as set forth above and, within ten (10) business days of the entry of this Order, the parties shall jointly email the Board (Trials@uspto.gov) with their proposed agreements or, if no agreement is reached, with proposed dates and times the parties are available for a conference call with the Board; and

FURTHER ORDERED that, within ten (10) business days of the entry of this Order, the parties are authorized to submit their respective briefs, limited to 5 pages, addressing the issue of whether to stay the *ex parte* reexamination proceeding as set forth above.

IPR2024-01115
IPR2024-01116
IPR2024-01119
Patent 10,656,754 B1

FOR PETITIONER:

W. Karl Renner
David Holt
FISH & RICHARDSON P.C.
axf-ptab@fr.com
dth@fr.com

FOR PATENT OWNER:

Eagle H. Robinson
Daniel S. Leventhal
Chad Wallis
NORTON ROSE FULBRIGHT US LLP
eagle.robinson@nortonrosefulbright.com
daniel.leventhal@nortonrosefulbright.com
chad.wallis@nortonrosefulbright.com