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Paper 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL CORPORATION, TCL COMMUNICATION TECHNOLOGY HOLDINGS, LTD., TCT MOBILE LIMITED, TCT MOBILE INC., and TCT MOBILE (US), INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

Cases IPR2015-01602, IPR2015-01637, IPR2015-01641, IPR2015-01646
IPR2015-01674, IPR2015-01676, IPR2015-01761, IPR2015-01806
Patent RE43,931 E

Before BENJAMIN D. M. WOOD, PATRICK R. SCANLON, and BARBARA A. BENOIT, *Administrative Patent Judges.*

BENOIT, *Administrative Patent Judge*.

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

We instituted *inter partes* review of U.S. Patent No. RE43,931 E ("the '931 patent") in eight cases: IPR2015-01602, IPR2015-01637, IPR2015-01641, IPR2015-01646, IPR2015-01674, IPR2015-01676, IPR2015-01761, and IPR2015-01806. *See, e.g.*, IPR2015-01602, Paper 9 (Decision to Institute); IPR2015-01674, Paper 7 (Decision to Institute).

On April 6, 2016, a conference call took place between Judges Benoit, Wood, and Scanlon and respective counsel for Patent Owner (Telefonaktiebolaget LM Ericsson) and Petitioner (TCL Corporation, TCL Communication Technology Holdings, Ltd., TCT Mobile Limited, TCT Mobile Inc., and TCT Mobile (US) Inc.). A court reporter was on the conference call, and Patent Owner will enter the transcript in the record of each proceeding in due course. A subject of the call was consolidation of the eight *inter partes* reviews challenging the '931 patent.

Petitioner and Patent Owner have agreed among themselves how to consolidate depositions taken in the various IPRs. Neither party opposes further consolidation of these cases in general. The parties, however, do not agree about how to conduct further consolidation. For example, the parties do not agree whether the grounds in each IPR should be consolidated into a single IPR and the other cases terminated. *See, e.g., Samsung Elec. Co., Ltd. v. Affinity Labs of Texas, LLC,* IPR2014-01181 (PTAB), Paper 15 (consolidating two cases with IPR2014-01181; terminating the two consolidated cases). Nor do the parties agree, should the eight cases be consolidated, as to length limitations for patent owner responses filed under 37 C.F.R. § 42.120 or Petitioner's reply to patent owner responses.

Based on prior art asserted and the dates scheduled for oral argument (if requested), the eight cases challenging the '931 patent fall into two sets of four IPRs each:

(i) IPR2015-01602, IPR2015-01637, IPR2015-01641, IPR2015-01646 (collectively, "the IPR2015-01602 set"), and

(ii) IPR2015-01674, IPR2015-01676, IPR2015-01761, IPR2015-01806 (collectively, "the IPR2015-01674 set").

In each case of the IPR2015-01602 set, Petitioner asserts various claims of the '931 patent are unpatentable in view of U.S. Patent No. 6,009,338, ("Iwata") and U.S. Patent No. 5,748,185 ("Stephan"). Oral argument, if requested, for those cases is scheduled for October 26 or October 27, 2016. Similarly, in each case of the IPR2015-01674 set, Petitioner asserts U.S. Patent No. 5,892,475 ("Palatsi") and U.S. Patent No. 4,566,001("Moore"). Oral argument for these cases is set for December 15, 2016.

Under the present circumstances, we determine that resulting efficiencies for both the parties and the Office warrant consolidating at least patent owner responses filed under 37 C.F.R. § 42.120 and any reply in each case of the IPR2015-01602 set and in each case of the IPR2015-01674 set. *See* 37 C.F.R. § 42.122(a) ("Multiple proceedings. Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter."); *see also* U.S.C. § 316(b) (mandating rules for *inter partes* proceedings to be promulgated to take into account the "regulation on the economy, the integrity of the patent system, the efficient

administration of the Office, and the ability of the Office to timely complete proceedings").

Accordingly, Patent Owner shall file an identical, consolidated patent owner response under 37 C.F.R. § 42.120 in each case in the IPR2015-01602 set. Likewise, Patent Owner also shall file an identical, consolidated patent owner response in each case in the IPR2015-01674 set. In other words, Patent Owner shall file one consolidated patent owner response in IPR2015-01602, IPR2015-01637, IPR2015-01641, and IPR2015-01646, and Patent Owner shall file another consolidated patent owner response in IPR2015-01674, IPR2015-01676, IPR2015-01761, and IPR2015-01806.

Similarly, Petitioner shall file an identical, consolidated reply to the patent owner response in each case in the IPR2015-01602 set and shall file an identical, consolidated reply to the patent owner response in each case in the IPR2015-01674 set.

After considering the grounds, the common prior art, and claims challenged in the IPR2015-01602 set and the IPR2015-01674 set, we authorize Patent Owner to file each consolidated patent owner response up to two-and-a-half (2½) times the length limit provided in 37 C.F.R. § 42.24(b)(2)—up to 35,000 words for each consolidated patent owner response. Similarly, we authorize Petitioner to file each consolidated reply to the patent owner response up to two-and-a-half (2½) times the length limit provided in 37 C.F.R. § 42.24(b)(1)—up to 14,000 words for each consolidated reply to patent owner response. Patent Owner and Petitioner shall use a case caption to reflect the consolidation of the patent owner responses and replies in accordance with the attached examples.

To ensure oral hearing, if requested, for each case in the IPR2015-01602 set will occur on the same date, we reset the date for oral hearing for IPR2015-01641 to October 27, 2016.

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Example Case Caption for the IPR2015-01602 Set of Cases

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Patent RE43,931 E

Example Case Caption for the IPR2015-01674 Set of Cases

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