

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC
Patent Owner.

IPR2015-01681 (Patent 7,764,231)¹
IPR2015-01687 (Patent 7,764,231)
IPR2015-01708 (Patent 7,525,484)
IPR2015-01711 (Patent 7,525,484)
IPR2015-01712 (Patent 7,298,327)
IPR2015-01713 (Patent 8,032,153)

Before KEVIN F. TURNER, RICHARD E. RICE, DAVID C. McKONE,
JAMES A. TARTAL, BARBARA A. PARVIS, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

ORDER
Joint Motions to Limit Petition
37 C.F.R. § 42.71

¹ The parties are not authorized to use this case caption, or to file consolidated papers.

IPR2015-01681, IPR2015-01687, IPR2015-01708, IPR2015-01711,
IPR2015-01712, and IPR2015-01713
Patents 7,298,327, 7,525,484, 7,764,231, and 8,032,153

On November 24, 2015, the parties filed a Joint Motion to Limit Petition (“Motions”) in each of the above cited proceedings, per the attached APPENDIX, seeking to limit the claims challenged in these proceedings pursuant to an agreement by Patent Owner not to assert certain claims against the Petitioners in a concurrent pending action or any future action. The parties also filed a Joint Submission of Narrowing Agreement (e.g., IPR2015-01712, Paper 8), with joint requests to treat as confidential the submitted Narrowing Agreement (e.g., IPR2015-01712, Ex. 2001), in each proceeding.

As provided in the APPENDIX, the Petition in each proceeding presents challenges as to the “Original Claims,” and the current motions propose to limit the challenged claims to the “Limited Claims” in each proceeding, i.e., removing specific claims from each. A copy of the Narrowing Agreement was provided in each proceeding, along with joint requests to treat that agreement as confidential. *See* APPENDIX.

As noted by the parties in the Motions, these proceedings are still in their preliminary stages, and decisions have not been made yet whether to institute trials. Motions 3–4. In addition, limiting the proceedings facilitates the Board’s goal of resolving *inter partes* reviews in a just, speedy, and inexpensive manner. *See* 37 C.F.R. § 42.1(b).

Accordingly, it is

ORDERED that the parties’ Joint Motions to Limit the Petition in these proceedings are GRANTED; and

FURTHER ORDERED that the Petition in in each of these proceedings is limited as follows:

IPR2015-01681, limited to claims 25 and 82;

IPR2015-01681, IPR2015-01687, IPR2015-01708, IPR2015-01711,
IPR2015-01712, and IPR2015-01713
Patents 7,298,327, 7,525,484, 7,764,231, and 8,032,153

IPR2015-01687, limited to claims 17, 20, and 25;

IPR2015-01708, limited to claims 1, 25, and 51;

IPR2015-01711, limited to claim 27;

IPR2015-01712, limited to claims 1, 2, 44, and 60;

IPR2015-01713, limited to claims 1, 3, and 15; and

FURTHER ORDERED that the Narrowing Agreement, with Exhibit numbers listed in the APPENDIX, be treated as business confidential information, be designated “Board Only,” and be kept separate from the files of the involved patents.

IPR2015-01681, IPR2015-01687, IPR2015-01708, IPR2015-01711,
IPR2015-01712, and IPR2015-01713
Patents 7,298,327, 7,525,484, 7,764,231, and 8,032,153

PETITIONER:

Brian W. Oaks
Douglas M. Kubehl
Chad C. Walters
Ross G. Culpepper
BAKER BOTTS LLP
brian.oaks@bakerbotts.com
doug.kubehl@bakerbotts.com
chad.walters@bakerbotts.com
ross.culpepper@bakerbotts.com

PATENT OWNER:

Sean Luner
DOVEL AND LUNER, LLP
sean@dovellaw.com

Steven C. Sereboff
SOCAL IP LAW GROUP LLP.
ssereboff@.socalip.com

IPR2015-01681, IPR2015-01687, IPR2015-01708, IPR2015-01711, IPR2015-01712, and IPR2015-01713
 Patents 7,298,327, 7,525,484, 7,764,231, and 8,032,153
 APPENDIX

PATENT NUMBER	CASE No.	PAPER	ORIGINAL CLAIMS	LIMITED CLAIMS	NARROWING AGREEMENT
7,764,231	IPR2015-01681	9	25, 26, 36, and 82	25 and 82	Ex. 2008
7,764,231	IPR2015-01687	7	17, 20, 25, and 26	17, 20, and 25	Ex. 2004
7,525,484	IPR2015-01708	7	1, 2, 6, 24, 25, 51, 71, and 72	1, 25, and 51	Ex. 2003
7,525,484	IPR2015-01711	6	27, 39, and 62	27	Ex. 2001
7,298,327	IPR2015-01712	7	1, 2, 3, 5, 17, 18, 28, 44, 60, 61, and 76	1, 2, 44, and 60	Ex. 2001
8,032.153	IPR2015-01713	7	1, 3, 15, 16, 20, 21, 23, 27, and 29	1, 3, and 15	Ex. 2001