

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDIATEK INC. and  
MEDIATEK USA INC.,  
Petitioner,

v.

NIPPON TELEGRAPH AND TELEPHONE CORPORATION,  
Patent Owner.

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Case IPR2020-01404  
Patent 7,280,551 B2

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Before GREGG I. ANDERSON, CHARLES J. BOUDREAU, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

A conference call in the above matter was requested by Petitioner and held on December 11, 2020. *See* Ex. 3001 (December 4, 2020, email from Petitioner’s counsel). Judges Anderson, Boudreau, and Beamer participated in the call, along with counsel for MediaTek Inc. and MediaTek USA Inc. (“Petitioner”) and Nippon Telegraph and Telephone Corporation (“Patent Owner”). The request was to receive Board “authorization to file a 6-page reply limited to responding to the [Preliminary Response’s<sup>1</sup>] newly-proposed construction of ‘mandatory channel.’” Ex. 3001.

Petitioner first argues good cause for allowing it to reply is present because Patent Owner took a different position on the construction of “mandatory channel” than that asserted here during prosecution of a related European patent application. According to Petitioner, the position taken during the European prosecution is consistent with Petitioner’s argument that “mandatory channel” has a “plain meaning” and inconsistent with Patent Owner’s proposed construction in the Preliminary Response. Petitioner alleges it did not discover the European prosecution issue until after the Preliminary Response was filed. Petitioner also requested authorization to file the relevant papers from the European prosecution. Petitioner further alleges good cause exists because it could not have anticipated the testimony of Patent Owner’s expert, James Geier (Ex. 2005), filed with the Preliminary Response. *See* Ex. 2005 ¶ 70 (testifying to Patent Owner’s proposed construction of “mandatory channel”).

Patent Owner disputes that Petitioner did not know of its claim construction position. According to Patent Owner, its claim construction

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<sup>1</sup> Paper 8 (“Prelim. Resp.”).

position was asserted prior to the filing of this proceeding in infringement contentions filed in the parallel District Court proceedings and in a confidential exchange of correspondence.

Subject to the following, we grant the Petitioner's request to file a reply. The reply shall be limited to the construction of "mandatory channel."

Our rules require that a petition include how the challenged claim is to be construed. 37 C.F.R. § 42.104(b)(3). The Petition does not allege a construction for "mandatory channel" or any other term. *See* Paper 2 ("Petition", "Pet."), 18 ("Claim terms are construed herein using the *Phillips* standard. 37 C.F.R. §42.100(b). "). Petitioner has proposed that "mandatory channel" be given its "plain meaning" in the parallel District Court proceeding. *See* Prelim. Resp. 15 (citing Ex. 2013 ("Defendant's Constructions" in District Court)). Accordingly, at this stage of the proceeding, Petitioner may not change its claim construction position as asserted in the Petition. *See* 37 C.F.R. § 42.104 ("... the petition must set forth ... (b)(3) How the challenged claim is to be construed."). Petitioner may argue why it disagrees with the claim construction asserted by Patent Owner. Further, Petitioner is not authorized to file the papers from the European prosecution or any other additional evidence.

Accordingly, it is:

ORDERED that the request is *granted* and on or before December 16, 2020, Petitioner may file a Preliminary Reply, not to exceed six (6) pages, limited to the construction of "mandatory channel" as alleged in the Preliminary Response;

FURTHER ORDERED that Patent Owner may file a Preliminary Sur-reply on or before December 21, 2020, not to exceed six (6) pages, responding to Petitioner's Preliminary Reply; and

FURTHER ORDERED that no additional evidence may be submitted by either party.

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Patent No. 7,280,551 B2

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