



BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01124 (Patent 7,292,870 B2)
IPR2021-01125 (Patent 7,292,870 B2)
IPR2021-01126 (Patent 7,292,870 B2)
IPR2021-01129 (Patent 7,894,837 C1)¹

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION

Ordering Rehearing, Vacating Adverse Judgment, and Remanding to the
Patent Trial and Appeal Board Panel for Further Proceedings

¹ This Order applies to each of the above-listed proceedings.

IPR2021-01124 (Patent 7,292,870 B2)
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I. INTRODUCTION

On December 13, 2022, the Patent Trial and Appeal Board (“PTAB” or “Board”) issued a Judgment Granting Request for Adverse Judgment After Institution of Trial in each of the above-captioned cases. IPR2021-01124, Paper 13 at 3; IPR2021-01125, Paper 14 at 3; IPR2021-01126, Paper 13 at 3; IPR2021-01129, Paper 14 at 3 (“Adverse Judgments”).

I have considered the Board’s Adverse Judgments, and I initiate a *sua sponte* Director review and remand these proceedings to the Board for further determinations consistent with this Decision. *See Interim process for Director review* §§ 13, 22 (providing for *sua sponte* Director review and explaining that “the parties to the proceeding will be given notice” if Director review is initiated *sua sponte*).²

II. DISCUSSION

In June 2021, Apple Inc. (“Petitioner”) filed six petitions for *inter partes* review before the Board. IPR2021-01124, Paper 3; IPR2021-01125, Paper 3; IPR2021-01126, Paper 3; IPR2021-01129, Paper 3; IPR2021-01130, Paper 3; IPR2021-01131, Paper 3. All six cases were assigned to the same panel of Administrative Patent Judges, and the Board instituted *inter partes* review in all six cases. IPR2021-01124, Paper 7; IPR2021-01125, Paper 8; IPR2021-01126, Paper 7; IPR2021-01129, Paper 7; IPR2021-01130, Paper 7; IPR2021-01131, Paper 7. After institution, Zipit Wireless, Inc. (“Patent Owner”) filed Patent Owner Responses in IPR2021-01130 and IPR2021-01131, but did not file a Patent Owner Response in IPR2021-

² Available at <https://www.uspto.gov/patents/patent-trial-and-appealboard/interim-process-director-review>.

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01124, IPR2021-01125, IPR2021-01126, or IPR2021-01129 (the four proceedings at issue here).

The Board held a hearing on September 21, 2022, in IPR2021-01130 and IPR2021-01131, and a transcript of the hearing was entered into the record of those two cases. IPR2021-01130, Paper 29; IPR2021-01131, Paper 29 (“Tr”). At the end of that hearing, Patent Owner’s counsel was questioned, with reference to “the companion cases . . . IPR2021-01124, 1125, 1126 and 1129,” whether Patent Owner is “not contesting if a final written decision or adverse judgment was entered with respect to those IPRs.” Tr. 63:23–64:17. Patent Owner’s counsel responded, “Correct, Your Honor. If the Board determines that they have met their burden of proof with respect to those claims Zipit hasn’t filed any opposition.” *Id.* at 64:18–20. In light of Patent Owner’s statements, the Board entered adverse judgments, under 37 C.F.R. § 42.73(b)(4), determining that Patent Owner had abandoned the contests. IPR2021-01124, Paper 13; IPR2021-01125, Paper 14; IPR2021-01126, Paper 13; IPR2021-01129, Paper 14.

On the present record, however, I do not understand counsel’s statements to have been an unequivocal abandonment of the contest of these proceedings. Instead Patent Owner’s non-opposition was contingent on the Board determining that Petitioner met its burden of proving by a preponderance of the evidence that the challenged claims are unpatentable. “In an inter partes review . . . , the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence” and “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” 35 U.S.C. § 316(e); *Harmonic*

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Inc. v. Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (2012) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Accordingly, I vacate the Board’s adverse judgments and remand these proceedings back to the panel to either issue a show cause order clarifying whether Patent Owner is indeed abandoning the contest or to issue a final written decision addressing the patentability of the challenged claims.

No additional briefing from the parties is authorized. *See Interim process for Director review* § 13 (explaining that the Director may give the parties an opportunity for briefing if Director review is initiated *sua sponte*).

III. ORDER

Accordingly, based on the foregoing, it is:

ORDERED that *sua sponte* Director review of the Board’s Judgments Granting Request for Adverse Judgment After Institution of Trial (IPR2021-01124, Paper 13; IPR2021-01125, Paper 14; IPR2021-01126, Paper 13; IPR2021-01129, Paper 14) is initiated;

FURTHER ORDERED that the Judgments Granting Request for Adverse Judgment After Institution of Trial are vacated; and

FURTHER ORDERED that the cases are remanded to the panel for further proceedings consistent with this Decision.

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FOR PETITIONER:

W. Karl Renner
David Holt
Karan Jhurani
FISH & RICHARDSON P.C.
axf-ptab@fr.com
holt2@fr.com
jhurani@fr.com

FOR PATENT OWNER:

Stephen R. Risley
Cortney S. Alexander
KENT & RISLEY LLC
steverisley@kentrisley.com
cortneyalexander@kentrisley.com