

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00020 (Patent 5,191,573)
Case CBM2013-00023 (Patent 5,966,440)¹

Before MICHAEL P. TIERNEY, JUSTIN T. ARBES, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

¹ This Order addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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Sur-Reply Regarding Obviousness Ground

In the Decision on Institution in each of the instant proceedings, we instituted a trial on two grounds as to all of the challenged claims: (1) anticipation by the CompuSonics system under 35 U.S.C. § 102, and (2) obviousness over the CompuSonics publications under 35 U.S.C. § 103(a). *See* CBM2013-00020, Paper 14 at 31-32; CBM2013-00023, Paper 12 at 32. At the oral hearing on May 6, 2014,² Patent Owner argued that it did not have a fair opportunity to respond to the obviousness ground because Petitioner did not assert the ground in its petitions and argued the issue for the first time in its replies, to which Patent Owner was not able to respond.

Under the particular factual circumstances of these cases, to ensure that Patent Owner has a full and fair opportunity to be heard on the issue of obviousness, we are persuaded to authorize, on an expedited basis, a sur-reply from Patent Owner in each proceeding. The sur-replies are limited to a single issue—responding to the arguments made by Petitioner in its papers and at the hearing that the challenged claims would have been obvious over the CompuSonics publications. Any sur-reply filed by Patent Owner shall not repeat arguments previously made or argue any other issue in these proceedings (e.g., anticipation). Patent Owner may, if necessary, submit new declaration testimony with its sur-replies. Should Patent Owner do so, Petitioner is authorized to cross-examine the witness(es) and file a motion for observation on cross-examination to alert the Board to any relevant testimony. Petitioner is reminded that an observation is not an

² A transcript of the hearing will be entered into the record of each proceeding as soon as possible.

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opportunity to raise new issues, re-argue issues, or pursue objections.

Each observation should be in the following form:

In Exhibit __, on page __, lines __, the witness testified __. This testimony is relevant to the __ on page __ of __. The testimony is relevant because __.

The entire observation should not exceed one short paragraph. We may decline consideration or entry of excessively long or argumentative observations.

Sealed Documents

On April 30, 2014, we granted three motions to seal filed in each of the instant proceedings, and ordered that certain papers and exhibits be maintained under seal. *See* CBM2013-00020, Paper 92; CBM2013-00023, Paper 88. On May 8, 2014, the parties filed a joint notice in each proceeding stating that they have agreed that the sealed materials may be unsealed and made available to the public. *See* CBM2013-00020, Paper 99; CBM2013-00023, Paper 95. Accordingly, the materials will be unsealed, and access to the materials in the Patent Review Processing System (PRPS) will be changed from “Parties and Board Only” to “Public.” The protective order entered in each proceeding shall remain in effect and govern the future treatment and filing of any confidential information in the proceedings.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file, in each of the instant proceedings, a sur-reply to Petitioner’s reply in the respective proceeding addressing only the issue set forth herein, by June 6, 2014, limited to 15 pages;

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FURTHER ORDERED that Patent Owner is authorized to file, with its sur-reply in each proceeding, new declaration testimony;

FURTHER ORDERED that if Patent Owner files new declaration testimony with its sur-reply in the respective proceeding, Patent Owner shall make the witness(es) available for cross-examination as soon as possible following the filing of the sur-reply, and Petitioner is authorized to file a motion for observation on cross-examination of the witness, by June 27, 2014, limited to 15 pages;

FURTHER ORDERED that no response to a motion for observation on cross-examination is authorized; and

FURTHER ORDERED that the following papers and exhibits are unsealed:

CBM2013-00020: Papers 52, 71, and 88, and Exhibits 4157-4163, 4256, and 4262; and

CBM2013-00023: Papers 49, 67, and 85, and Exhibits 4358-4364, 4414, and 4420.

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