

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC CORPORATION

Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC

Patent Owner.

Cases IPR2013-00082 (Patent 5,978,791)

IPR2013-00083 (Patent 6,415,280)

IPR2013-00084 (Patent 7,945,544)

IPR2013-00085 (Patent 7,945,539)

IPR2013-00086 (Patent 7,949,662)

IPR2013-00087 (Patent 8,001,096)¹

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge*

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

¹ This Order addresses issues that are identical in all six cases. Therefore, we exercise our discretion to issue one opinion to be filed in each of the six cases. The parties, however, are not authorized to use this style heading in any subsequent papers. Note that the petitioners for IPR2013-00082 and IPR2013-00083 are EMC Corporation and VMware, Inc.

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On June 17, 2013, a telephone conference call was held between respective counsel for the parties and Judges Turner, Chang, and Zecher. The telephone conference call was initiated by PersonalWeb, seeking clarification on whether EMC's exhibits (Ex. 1042-1072²) filed as supplemental evidence in response to PersonalWeb's evidentiary objection (Paper 28) comply with 37 C.F.R. § 42.64.

During the conference call, PersonalWeb alleged that EMC's supplemental evidence is not responsive to PersonalWeb's evidentiary objections, and requested that all of those EMC's exhibits be expunged from the record for each trial. PersonalWeb further requested an extension of time for filing a patent owner response should the Board decline to expunge those exhibits.

At the outset, the Board noted that PersonalWeb's evidentiary objection is unduly broad. Notably, PersonalWeb objects to references (*e.g.*, Browne, Langer, and Kantor³) that are not relied upon by EMC to support any of the instituted grounds of unpatentability. *See* Decision on Institution, entered May 17, 2013, Paper 21, p. 33 (All of the instituted grounds of unpatentability are based on U.S.

² For the purpose of clarity and expediency, IPR2013-00082 is representative and all citations are to IPR2013-00082 unless otherwise noted.

³ Shirley Browne et al., "*Location-Independent Naming of Virtual Distributed Software Repositories*," University of Tennessee Technical Report CS-95-278 (Feb. 1995)(Ex. 1002)("Browne").

Albert Langer, "*Re: dl/describe (File Descriptions)*," post to the "alt.sources" newsgroup on Aug. 7, 1991 (Ex. 1003)("Langer").

Frederick W. Kantor, "*FWKCS™ Contents_Signature System Version 1.22*," Zipfile FWKCS122.ZIP (Aug. 10, 1993)(Ex. 1004)("Kantor").

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Patent 5,649,196 issued to Woodhill). And none of the six *inter partes* reviews were instituted based on Browne.

Although PersonalWeb indicated that it has filed the same evidentiary objection for all six *inter partes* reviews for consistency, the Board nevertheless reminded the parties to be mindful that an *inter partes* review is a focused proceeding, and a final determination must be issued not later than one year after the date of institution, except for good cause. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). Filing the same broad evidentiary objection in all six trials, without considering whether such an objection would be meaningful for the particular trial, causes unnecessary delay and increases costs to the Board and opposing party. All portions of Part 42, Title 37, Code of Federal Regulations, including 37 C.F.R. § 42.64, are construed to secure the just, speedy, and inexpensive resolution of every proceeding.⁴

The Board next noted that if, upon reconsidering EMC’s original evidence in light of the supplemental evidence, PersonalWeb is still of the opinion that the original evidence is inadmissible, PersonalWeb may file a motion to exclude such

⁴ 37 C.F.R. § 42.1(b); 35 U.S.C. 316(a)(6) (“The Director shall prescribe regulations. . . (6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or *to cause unnecessary delay or an unnecessary increase in the cost of the proceeding.*” Emphasis added.) 35 U.S.C. §§ 316(b) and 326(b) (“In prescribing regulations under this section, the Director shall consider the effect of any such 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* instituted under this chapter.” Emphasis added.)

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evidence. 37 C.F.R. § 42.64(c). But any motion to exclude must identify any objections in the record and must explain those objections. Further, a motion to exclude must be tailored narrowly, objecting to only evidence that is relied upon by EMC to support the instituted grounds of unpatentability in the *particular* trial. Therefore, PersonalWeb should not expect the Board to sort through a broad motion to exclude evidence.

Additionally, the Board clarified that EMC may rely on the supplemental evidence *only* for the issues raised by PersonalWeb's evidentiary objection or motion to exclude under 37 C.F.R. § 42.64. Should EMC find it necessary to rely on the submitted supplemental evidence for other purposes (*e.g.*, in its reply to the patent owner's response or an opposition to a motion to amend claims), EMC should seek authorization from the Board. In the situation where authorization is granted, the Board would provide PersonalWeb an opportunity to object to the supplemental evidence relied upon by EMC in its brief. Therefore, the Board determined that it is not necessary to expunge EMC's exhibits filed as supplemental evidence in response to PersonalWeb's evidentiary objection.

To increase efficiency and minimize delays, the Board encouraged the parties to work together on the evidentiary issues and deposition of declarants. While the due date for filing the patent owner response is July 25, 2013 (DUE DATE 1, Notice of Stipulation, Paper 38), the due date for filing a motion to exclude evidence is November 7, 2013 (DUE DATE 4). Therefore, PersonalWeb has nearly five months from the filing of EMC's supplemental evidence to file a motion to exclude. Moreover, the parties may stipulate to different dates for DUE DATES 1 through 3 (earlier or later, but no later than DUE DATE 4).

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Accordingly, the Board determined that it is not necessary to modify DUE
DATE 1 at this time.

It is

ORDERED that EMC's exhibits filed as supplemental evidence in response
to PersonalWeb's evidentiary objection will not be expunged; and

FURTHER ORDERED that no extension of time for filing the patent
owner response is authorized.

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