

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 order 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.

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

On August 30, 2013, the following individuals participated in a conference call:

1. David Cavanaugh, counsel for Petitioners (“EMC”);
2. Joseph Rhoa, counsel for Patent Owner (“PersonalWeb”); and
3. Kevin Turner, Joni Chang, and Michael Zecher, Administrative Patent Judges.

During the conference call, EMC requested authorization to rely on supplemental evidence in its reply—namely, supplemental evidence (Ex. 1042-1072²) that was submitted previously pursuant to 37 C.F.R. § 42.64(b)(2), in response to PersonalWeb’s evidentiary objection (Paper 28). *See* Paper 41 at 4. PersonalWeb also requested authorization to object to any prior-filed supplemental evidence relied upon in EMC’s reply pursuant to 37 C.F.R. § 42.64(b)(1). Upon consideration of the parties’ requests, the Board authorized EMC to rely on prior-filed supplemental evidence in its reply, and authorized PersonalWeb to object to evidence relied upon in EMC’s reply, including any prior-filed supplemental evidence. Any objection to evidence must be served within five business days of the filing of EMC’s reply, and must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence in compliance with 37 C.F.R. § 42.64(b)(1).

EMC further sought guidance on whether the “printed publication” argument presented in the patent owner response should be addressed in its reply or in an

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

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

opposition to a motion to exclude. In its patent owner response, PersonalWeb argues that certain references (*i.e.*, Langer and Kantor³) relied upon by EMC to support the instituted grounds of unpatentability are not “printed publication.” Upon inquiry by the Board, PersonalWeb clarified that it intends to file a motion to exclude that will present arguments directed to inadmissibility of evidence based on the Federal Rules of Evidence. The Board indicated that EMC may address the “printed publication” argument in its reply and the inadmissibility arguments in its opposition to motion to exclude, in a level of detail that is necessary to rebut those arguments sufficiently.

EMC further requested additional pages for its reply. EMC contends that additional pages are needed to respond to issues raised in the patent owner response, which contains numerous arguments, including the “printed publication” argument, and claim constructions of terms that were not construed explicitly before. The Board noted that EMC had the opportunity to provide its claim constructions in its petition, and there are not many challenged claims. EMC reasonably could have foreseen the “printed publication” argument at the time of filing its petition. Moreover, EMC may rely upon prior-filed supplemental evidence and new testimony in its reply. Upon consideration of EMC’s request, the Board was not persuaded that additional pages should be authorized for EMC’s reply.

³ 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”).

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

In consideration of the foregoing, it is hereby:

ORDERED that EMC is authorized to rely on prior-filed supplemental evidence in its reply;

FURTHER ORDERED that PersonalWeb is authorized to object to any evidence relied upon in EMC's reply, including prior-filed supplemental evidence; any objection to evidence must be served within five business days of the filing of EMC's reply, and must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence in compliance with 37 C.F.R. § 42.64(b)(1); and

FURTHER ORDERED that EMC's request for additional pages to use in its reply is *denied*.

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