

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EMC CORPORATION

Petitioner

v.

PERSONALWEB TECHNOLOGIES, LLC

Patent Owner

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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)<sup>1</sup>

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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

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<sup>1</sup> 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 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

### *Introduction*

On December 12, 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 to discuss the propriety of EMC's demonstrative exhibit (Ex. 1097<sup>2</sup>) and the usage of "October 1993 Walnut Creek CD-ROM" at the final oral hearing, which is scheduled for December 16, 2013. The oral arguments for all six above-identified *inter partes* reviews will be merged and conducted at the same time.

### *No New Evidence*

EMC indicated that it intends to use the physical copy of the "October 1993 Walnut Creek CD-ROM," as a demonstrative. Ex. 1097, p. ii. PersonalWeb opposed and argued that using the CD-ROM would be inappropriate.

At a final oral hearing, a party may rely upon evidence that has been submitted previously in the proceeding and only may present arguments relied upon in the papers submitted previously. *Patent Trial Practice Guide*, 77 *Fed. Reg.* 48756, 48768 (Aug. 14, 2012). Demonstrative exhibits should not include new evidence or arguments. *CBS Interactive Inc. v. Helferich Patent Licensing, LLC.*, Case IPR2013-00033, Paper 118.

The Board agreed with PersonalWeb that the physical copy of the CD-ROM is *new evidence*. Indeed, although a *picture* of the CD-ROM was submitted

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<sup>2</sup> For the purpose of clarity and expediency, IPR2013-00085 is representative and all citations are to IPR2013-00085 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

previously (Ex. 1052), a *physical copy* of the CD-ROM has not been filed in any of the above-identified proceedings, nor has it been served on PersonalWeb.

Introducing new evidence at this late juncture—when the trial issues had been briefed fully by both parties—would prejudice PersonalWeb, who would not have the opportunity to respond or challenge the authentication of the CD-ROM.

For the foregoing reasons, EMC is not authorized to use the *physical copy* of the “October 1993 Walnut Creek CD-ROM” at the final oral hearing. EMC, however, may present a *picture* of the CD-ROM, as a demonstrative (Ex. 1097, slide 21), because the picture was submitted previously (Ex. 1052) in support of the Declaration of Mr. Jason S. Sadofsky (Ex. 1081).

#### *Motion to Exclude Demonstratives*

During the conference call, PersonalWeb sought leave to file a motion to exclude any of EMC’s demonstrative slides that are not discussed substantively at the oral hearing. PersonalWeb also requested that its motion to exclude evidence (Paper 55) be applicable to EMC’s demonstrative slides to the extent that they contain the same content as the evidence sought to be excluded. PersonalWeb’s requests are not authorized for the reasons stated below.

Demonstrative exhibits are not evidence. As noted by the Board, demonstrative exhibits merely include evidence or arguments that have been submitted previously in the proceeding. They should not contain new evidence or arguments. PersonalWeb has not identified, nor alleged, that any of EMC’s demonstrative slides contain new evidence or arguments. The Board also noted that no substantive paper submitted by EMC is referring to, or relying upon, the

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

demonstrative slides. Therefore, PersonalWeb has not provided sufficient reasons as to why a motion to exclude any of EMC's demonstrative slides is necessary.

In consideration of the foregoing, it is hereby:

ORDERED that EMC is not authorized to use the *physical copy* of the "October 1993 Walnut Creek CD-ROM" at the final oral hearing; and

FURTHER ORDERED that PersonalWeb is not authorized to file a motion to exclude EMC's demonstrative exhibit (Ex. 1097).

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