

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner

v.

YISSUM RESEARCH DEVELOPMENT COMPANY OF THE
HEBREW UNIVERSITY OF JERUSALEM
Patent Owner

Case IPR2013-00219
Patent 7,447,284 B2¹

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
JAMES B. ARPIN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

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

¹ IPR2013-00327 has been joined with this proceeding.

On March 31, 2014, counsel for the respective parties and Judges Medley, Easthom, and Arpin participated in a conference call. The purpose of the conference call was to address Patent Owner's request for an early ruling on Patent Owner's objections to evidence. *See* Paper 39 (Patent Owner's Objections).

According to Patent Owner, Petitioner filed a second declaration of Dr. Darrell (Ex. 1044) as part of its Reply to Patent Owner's Response (Paper 37, "Reply"), which improperly exceeds the scope of the reply permitted under 37 C.F.R. § 42.23(b). Patent Owner contends that paragraphs 23–26 of that declaration, which discuss the prior art reference to Asahi (Ex. 1010), improperly add new evidence under 37 C.F.R. § 42.23(b), because neither the Petition (Paper 3) nor Dr. Darrell's first declaration (Ex. 1013), discuss Asahi in the particular context discussed in the second declaration. During the conference, Petitioner argued that those paragraphs constitute a proper reply to Patent Owner's Response (Paper 35), because the declarant addresses relevant arguments about Asahi raised for the first time by Patent Owner in that paper.

A ruling on the evidentiary objection at this stage is premature. As explained during the call, whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b), is left to the ultimate determination of the Board. Specifically, we will determine whether a reply and evidence are outside the scope of a proper reply and evidence when we review all of the parties' submissions and prepare the final written decision. If there are improper arguments or evidence, or both, presented with a reply, we may exclude the reply and related evidence.

Patent Owner also requested a similar early ruling on its objection to "Wikipedia" evidence (Ex. 1042) attached to Petitioner's Reply. Patent Owner objects to that evidence for reasons similar to those discussed above, and also

because that evidence allegedly violates FRE (Federal Rules of Evidence) 901 (authentication). As discussed during the conference, Patent Owner may attach a relevant objection, based on FRE 901, which Patent Owner served on Petitioner, and submit a motion to exclude that evidence pursuant to the Scheduling Order. *See* 37 CFR § 42.64 (b), (c); Paper 17 (Scheduling Order). We will address the objections and motions to exclude in any final written decision.

During the conference, we cautioned the parties that objections to evidence should be *served*, instead of *filed*, and discussed the possibility of expunging all of the objections currently of record. *See* 37 C.F.R. § 42.64. Although we decline to expunge the objections at this time, we admonish the parties to follow the requirements of our rules regarding future objections.

It is

ORDERED that Patent Owner's request for an early ruling on its objections to evidence, prior to a final written decision, is denied for the reasons set forth above.

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