

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARL ZEISS SMT GMBH
Petitioner

v.

NIKON CORPORATION
Patent Owner

Case IPR2013-00362
Patent 7,348,575 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

A conference call was held on June 3, 2014, involving respective counsel for Petitioner and Patent Owner, and Judges Medley, Blankenship, and Clements. The purpose of the call was for Patent Owner to seek authorization to file a motion to strike the Petitioner's Reply (Paper 22, "Reply") and the declaration of Mr. Richard Juergens (Exhibit 1036).¹ Other issues were discussed as well, and are addressed herein.

Proper procedure for requesting a conference call

The parties were reminded of the proper procedure for requesting a conference call and the appropriate content of any email filed with the Board regarding a conference call. In particular, an email requesting a conference call should copy the other party to the proceeding, indicate generally the relief being requested or the subject matter of the conference call, state whether the opposing party opposes the request, and include times when all parties are available. See Technical Issue 3 on the Board's website (<http://www.uspto.gov/ip/boards/bpai/prps.jsp>).

Motion to Strike

According to Patent Owner, Petitioner filed a second declaration of Mr. Richard Juergens in support of Petitioner's Reply to Patent Owner's Response, and the declaration, and the reply which relies on the declaration, improperly exceed the scope of what is permitted under 37 C.F.R. § 42.23(b). Specifically, Patent Owner argued that Petitioner relied, for the

¹ Although the request for the conference call requests striking all supporting exhibits filed with the Petitioner's reply, we understand that Patent Owner seeks authorization only to strike Exhibit 1036.

first time, upon results of testing performed by Mr. Juergens that should have been presented in connection with Petitioner's Petition. Petitioner argued that the evidence and arguments presented in its Reply were necessitated by the arguments made in the Patent Owner's Response.

Upon consideration of the arguments made, the Board has determined that a ruling 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 determination of the Board. Specifically, the Board will determine whether a reply and evidence are outside the scope of a proper reply and evidence when the Board reviews all of the parties' briefs and evidence and prepares the final written decision. If there are improper arguments and evidence presented with a reply, the Board may exclude the reply and related evidence. Accordingly, Patent Owner's request to file a motion to strike is *denied*.

In addition to the above, the Board explained that a motion to exclude would not be the proper forum for raising the same arguments presented during the call for excluding either the Reply or Exhibit 1036. The parties may raise issues related to admissibility of evidence (e.g., authenticity or hearsay) in a motion to exclude. *See* 37 C.F.R. §§ 42.64 and 42.62. In contrast, issues related to credibility, the weight of the evidence, or the sufficiency of evidence should not be raised in the form of a motion to exclude.

Motion for observation

As discussed, Patent Owner is permitted to cross-examine reply declarants, and if necessary, Patent Owner may file a motion for observation regarding cross-examination of a reply witness by DUE DATE 4. Per the Scheduling Order (Paper 11), a motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit ____, on page ____, lines ____, the witness testified ____.
That testimony is relevant to the ____ [stated or argued] on
page ____, lines ____ of _____. The testimony is relevant because
_____.

Each observation should not exceed one short paragraph. The Board may decline consideration or entry of argumentative observations. A motion for observation is limited to 15 pages and is due by DUE DATE 4. Petitioner may file a response by DUE DATE 5, limited to 15 pages.

Case IPR2013-00362
Patent 7,348,575 B2

It is

ORDERED that Patent Owner's request to file a motion to strike is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file a motion for observation on cross-examination by DUE DATE 4 consistent with this order; and

FURTHER ORDERED that Petitioner is authorized to file a response to any motion for observation by DUE DATE 5 consistent with this order.

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