

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RACKSPACE US, INC. and RACKSPACE HOSTING, INC.,  
Petitioners,

v.

PERSONALWEB TECHNOLOGIES, LLC and  
LEVEL 3 COMMUNICATIONS,  
Patent Owners.

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Cases IPR2014-00057 (Patent 5,978,791)  
IPR2014-00058 (Patent 8,099,420)  
IPR2014-00059 (Patent 6,415,280)  
IPR2014-00062 (Patent 7,802,310)  
IPR2014-00066 (Patent 6,928,442)<sup>1</sup>

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Before 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 overlapping issues in the above-identified cases. Therefore, we issue one order to be filed in all cases. The parties, however, are not authorized to use this style heading in subsequent papers.

Cases IPR2014-00057 (Patent 5,978,791); IPR2014-00058 (Patent 8,099,420); IPR2014-00059 (Patent 6,415,280); IPR2014-00062 (Patent 7,802,310); IPR2014-00066 (Patent 6,928,442)

On April 15, 2014, the Board instituted the above-identified *inter partes* reviews and entered a Scheduling Order that sets forth the due dates for the parties to take action for all of the cases, ensuring that the reviews will be completed within one year of institution. Papers 9, 10.<sup>2</sup> An initial conference call was held on April 29, 2014, between respective counsel for Patent Owners and Petitioners, and Judges Chang and Zecher. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 10), as well as any motions that the parties intend to file. Patent Owners (Paper 12) and Petitioners (Paper 11) each filed a list of proposed motion(s). The following issues were discussed.

#### *Trial Schedule*

During the conference call, the Board indicated that the schedules for the above-identified proceedings had been coordinated and that oral argument would be combined. The Board explained that the oral argument transcript would be useable across all proceedings, given the similarity in claimed subject matter and overlapping asserted prior art.

Petitioners indicated that it does not foresee, at this time, any problems with meeting its due dates. Upon inquiry from the Board, Patent Owners indicated that it will not file a motion to amend claims and, therefore, DUE DATE 3 in the Scheduling Order is not necessary. Patent

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<sup>2</sup> For the purpose of clarity and expediency, we treat IPR2014-00057 as representative, and all citations are to IPR2014-00057 unless otherwise noted.

Cases IPR2014-00057 (Patent 5,978,791); IPR2014-00058 (Patent 8,099,420); IPR2014-00059 (Patent 6,415,280); IPR2014-00062 (Patent 7,802,310); IPR2014-00066 (Patent 6,928,442)

Owners further noted that the parties will stipulate to different dates for DUE DATES 1 and 2. The Board asked the parties to file a notice of the stipulation, specifically identifying the changed due dates.

*Combined Cross-Examination of Petitioners' Declarant*

Patent Owners expressed the desire to coordinate and combine discovery between the above-identified proceedings. Petitioners agreed to a combined cross-examination of each Petitioners' declarant. The Board explained that the parties should coordinate the day and time limits for cross-examination of each Petitioners' witness appearing in all five proceedings. The Board further indicated that the transcript of the combined cross-examination will be useable in all of the above-identified proceedings.

*Motion to Exclude Evidence*

As explained by the Board, Patent Owners are not required to seek prior authorization for filing a motion to exclude evidence under 37 C.F.R. § 42.64(c), a motion for observation regarding cross-examination of reply witness, and a response to observation. *See* Paper 10, 6. The Board also explained that the scope of a motion to exclude evidence was limited to arguments to exclude evidence believed to be inadmissible. The Board noted that arguments regarding the sufficiency or weight of evidence, or concerning an allegedly improper scope of a reply, would not be proper in a motion to exclude evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,765, 48,767 (Aug. 14, 2012).

Cases IPR2014-00057 (Patent 5,978,791); IPR2014-00058 (Patent 8,099,420); IPR2014-00059 (Patent 6,415,280); IPR2014-00062 (Patent 7,802,310); IPR2014-00066 (Patent 6,928,442)

A motion to exclude evidence also must include the following:

- (a) Identify where in the record the objection originally was made;
- (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
- (c) Address objections to exhibits in numerical order; and
- (d) Explain each objection.

*Id.*

*Motion to Submit Supplement Information under 37 C.F.R. § 42.123.*

Petitioners sought leave to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123. In particular, Petitioners indicated that they seek to file an expert declaration addressing the claim constructions of certain claim terms in the following three proceedings: IPR2014-00057, IPR2014-00058, and IPR2014-00062. Petitioners alleged that the Board failed to adopt all of Petitioners' claim constructions in those three proceedings. Petitioners expressed the desire to submit a new expert declaration to demonstrate why the Board's claim constructions in its Decision on Institution (Paper 9) are incorrect. Petitioners argued that the Board should authorize the filing of a motion to submit such new testimonial evidence because Petitioners' request was made within one month from the institution date and the evidence would be relevant to a claim for which trial had been instituted. Petitioners also alleged that Patent Owners would not be prejudice, as Patent Owners will have the opportunity to cross-examine the new expert declarant before filing the patent owner responses.

Cases IPR2014-00057 (Patent 5,978,791); IPR2014-00058 (Patent 8,099,420); IPR2014-00059 (Patent 6,415,280); IPR2014-00062 (Patent 7,802,310); IPR2014-00066 (Patent 6,928,442)

Patent Owners opposed and argued that such evidence regarding claim construction should have been presented at the time of filing the petition. According to Patent Owners, such late submission of evidence regarding claim construction would prejudice Patent Owners, who are preparing for discovery and patent owner responses in all five proceedings. Patent Owners requested the authorization to file an opposition should the Board grant Petitioners' request.

We are not persuaded by Petitioners' argument that the Board should grant its request because it was made within one month from the institution date and the evidence would be relevant to a claim for which trial had been instituted. An important consideration in determining whether to authorize the filing of a motion to submit supplemental information is that the above-identified proceedings must be completed within one year of institution. 35 U.S.C. § 316(a)(11). Consequently, all of the Board's trial rules are "construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA post-grant proceedings take into account "the efficient administration of the Office" and "the ability of the Office to timely complete [instituted] proceedings"). Petitioners' new expert declaration for each of the three proceedings would impact Patent Owners' ability to file its patent owner responses timely in all five above-identified proceedings. Petitioners have not explained sufficiently why its motion is necessary in that regard.

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