

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2015-00369
Case IPR2015-00373¹
Patent 6,128,290

Before JAMESON LEE, MATTHEW R. CLEMENTS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

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

¹ This order addresses issues that are the same in all cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

On February 26, 2016, Patent Owner requested a conference call to seek the Board's authorization to file three exhibits that, according to Patent Owner, were inadvertently not filed with Patent Owner's Motion for Observation of Cross-Examination of Petitioner's witness, Dr. Hu (Paper 29²):

1. Declaration of the inventor, Philip P. Carvey, as provided in Apple Inc.'s Responsive Claim Construction Brief in *DSS Technology Management, Inc. v. Lenovo (United States), Inc.*, No. 6:13-cv-00919-JDL (E.D. Tex.);
2. Declaration of Dr. Hu as provided in Apple Inc.'s Responsive Claim Construction Brief in *DSS Technology Management, Inc. v. Lenovo (United States), Inc.*, No. 6:13-cv-00919-JDL (E.D. Tex.); and
3. International Standard, ISO/IEC 3309, Fifth edition, 1993-12-15 (reaffirmed 1999).

Patent Owner also sought to discuss a vehicle for responding to Petitioner's Response to Patent Owner's Motion for Observation.

On February 29, 2016, a conference call was held between counsel for Petitioner, counsel for Patent Owner, and Judges Lee, Clements, and Boudreau. We address each of Patent Owner's requests in turn.

² Citations are to IPR2015-00369. Similar papers were filed in IPR2015-00373.

Authorization to File Documents as Exhibits

Patent Owner contends that Dr. Hu's cross-examination testimony is inconsistent with the above-identified documents and they are, therefore, properly part of its Motion for Observation.

Declarations

Petitioner stated that the Declaration of Mr. Carvey is already in the record as pages 36–38 of Exhibit 1007, the Declaration of Dr. Hu is already in the record as pages 40–56 of Exhibit 1007. Patent Owner does not dispute that the Declarations of Mr. Carvey and of Dr. Hu are already in the record at those pages of Exhibit 1007. Because both declarations are already in the record, we do not authorize Patent Owner to file those documents again as new exhibits.

The time has passed for having Patent Owner correct its Motion for Observation to refer to these materials by exhibit number and page number, but the panel is now aware of where these documents are in the record. The panel understands the references in Observations #6 and #7 to Apple's Responsive Claim Construction Brief in the district court litigation to refer to Exhibit 1007. The Board advised both parties, though, that for future cases, a Motion for Observation is most helpful to a panel when the cross-examination testimony is related to a precisely identified portion of an exhibit. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,769 (August 14, 2012).

ISO Standard

With respect to the ISO standard, Patent Owner contends that Dr. Hu asked to see it during her deposition and testified that it was something she

considered in her analysis. Petitioner countered that the ISO standard document was shown at Dr. Hu's exhibit, but was not marked as a deposition exhibit. It is undisputed that Dr. Hu did not address the ISO standard in her direct testimony. Moreover, as Petitioner pointed out, the ISO standard is not cited in any of Patent Owner's observations in its Motion for Observation. Patent Owner argued that the ISO standard should, nevertheless, be filed as an exhibit because it supports the testimony of Patent Owner's expert. We do not agree. The time for filing exhibits in support of Patent Owner's expert was at the time of Patent Owner's Response. Under these circumstances, we do not authorize Patent Owner to file the ISO standard as an exhibit.

*Patent Owner's Request to File a
Reply to Petitioner's Response to
Patent Owner's Motion for Observation*

Patent Owner sought authorization to file a Reply to Petitioner's Response (Paper 31) because, according to Patent Owner, Petitioner's Response was improper attorney testimony. Patent Owner identified, for example, the language in Petitioner's Response to Observation No. 2 stating, "Dr. Hu's testimony regarding Mr. Dezmelyk's lack of understanding was in the context of point-to-multipoint systems. Dr. Hu's testimony is therefore consistent." Paper 31, 2. The panel found the identified language no more argumentative than the language of the Observation itself. As a result, we do not authorize Patent Owner to file a Reply to Petitioner's Response to Patent Owner's Motion for Observation.

IPR2015-00369 and IPR2015-00373
Patent 6,128,290

ORDER

Accordingly, it is:

ORDERED that Petitioner's request to file three documents as exhibits is *denied*; and

FURTHER ORDERED that Petitioner's request to file a Reply to Petitioner's Response to Patent Owner's Motion for Observation is *denied*.

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