

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2015-01664
Patent 7,787,431 B2

Before JAMESON LEE, JUSTIN BUSCH, and J. JOHN LEE,
Administrative Patent Judges.

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

An initial telephone conference call was held on March 3, 2016. The participants were respective counsel for the parties and Judges Jameson Lee, Justin Busch, and John Lee. Neither party filed a list of proposed motions for discussion. The parties indicated that they were working on stipulating to changes in the due dates set in the Scheduling Order entered February 11, 2016 (Paper 8), but that the parties had no issues with Due Dates 6 and 7 of the Scheduling Order.

We directed the parties not to use the Motion to Exclude for any purpose other than admissibility issues under the Federal Rules of Evidence. If an issue arises with regard to a paper being out of proper scope, such as a reply, the parties shall contact the Board in a timely manner to raise the matter. We explained that all requests for conferences with the Board shall be preceded by a good faith effort to resolve any issue prior to Board involvement.

We explained to the parties that supplemental evidence (*see* 37 C.F.R. § 42.64) is distinct from supplemental information (*see* 37 C.F.R. § 42.123), and that the rules do not contemplate more than one cycle of objection to evidence and subsequent supplemental evidence to cure the objection.

We further explained to the parties that, even if a protective order has been entered, a motion to seal must be filed concurrently with any filing a party desires to be under seal. Such a motion will only be granted if the associated burden of proof has been met. With regard to the substantive requirements of a Motion to Seal, the parties are directed to *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2015-00736 (Papers 37, 38, 40)(PTAB 2015). A confidential version of a paper should be filed

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as “Parties and Board” in PRPS, and an appropriately redacted version of a document should be filed as “Public.”

Finally, we instructed Patent Owner that if it decides to file a motion to amend claims, it must request a conference call with the Board at least two weeks prior to the due date of such a motion, so that the parties will have sufficient time to consider any guidance we may provide. We also asked Patent Owner to be prepared to discuss, during the conference call, the duty of candor requirement under 37 C.F.R. § 42.11 with respect to any feature that it proposes to add to a challenged claim. In that connection, we direct attention of the parties to *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. at 3 (PTAB July 15, 2015) (Paper 42)

(Representative), which states:

Thus, when considering its duty of candor and good faith under 37 C.F.R. § 42.11 in connection with a proposed amendment, Patent Owner should place initial emphasis on each added limitation. Information about the added limitation can still be material even if it does not include all of the rest of the claim limitations. *See VMWare, Inc. v. Clouding Corp.*, Case IPR2014-01292, slip op. at 2 (PTAB Apr. 7, 2015) (Paper 23) (“With respect to the duty of candor under 37 C.F.R. § 42.11, counsel for Patent Owner acknowledged a duty for Patent Owner to disclose not just the closest primary reference, but also closest secondary reference(s) the teachings of which sufficiently complement that of the closest primary reference to be material.”).

Order

It is

ORDERED that all due dates set in the Scheduling Order entered February 11, 2016 (Paper 8) remain unchanged, unless and until the parties file a notice of stipulation changing any of Due Dates 1–5.

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