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Paper 9
Entered: March 21, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01898 (Patent 8,434,020 B2)[1]
Case IPR2015-01899 (Patent 8,713,476 B2)

Before JAMESON LEE, DAVID C. MCKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges.*

CHERRY, *Administrative Patent Judge*.

ORDER

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

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[1] This Order addresses issues that are identical in both cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

An initial conference call was originally scheduled in this case. The parties requested that it be re-scheduled, but, after considering the request, the panel has decided that an initial conference call is not necessary at this time. If the parties have any matter they wish to discuss with the panel, they may contact the trial paralegals to request a call.

We note the following guidance given to the parties during an initial conference call in in a related co-pending *inter partes* review, *LG Electronics, Inc. v. Core Wireless Licensing S.A.R.L.*, Case IPR2015-01983 (PTAB Mar. 18, 2016) (Paper 10):

> The parties should not to use the Motion to Exclude for any purpose other than to raise admissibility issues under the Federal Rules of Evidence. If an issue arises with regard to a paper being out of proper scope, e.g., belatedly raising new issues or belatedly submitting new evidence, the parties shall contact the Board in a timely manner to raise the matter.
>
> Supplemental evidence is not the same as supplemental information, and that the rules do not contemplate more than one cycle of objection to evidence and subsequent supplemental evidence to cure the objection.
>
> A motion for Observation on Cross-Examination should not be argumentative and that the entry for each identified item is limited to one short paragraph. It does not mean that arguments can be presented so long as they are less than one short paragraph in length. Also, circumventing the length requirement by use of footnote is inappropriate.

Consistent with the guidance given the parties in IPR2015-01983, if Patent Owner decides to file a motion to amend claims, it must request a conference call with the Board more than two weeks prior to the due date of such a motion, so that a conference call may be arranged at least two weeks prior to the due date of such a motion and so that the parties will have sufficient time to consider any guidance we may provide. With respect to any feature Patent Owner proposes to add by way of a substitute claim, Patent Owner should be aware of the duty of candor requirement under 37 C.F.R. § 42.11. The initial focus should be on the individual features proposed to be added, and secondary references making up deficiencies of a primary reference are pertinent. 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.").

IPR2015-01898 (Patent 8,434,020 B2)
IPR2015-01899 (Patent 8,713,476 B2)

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