

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

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

Case IPR2015-01985
Patent 8,713,476 B2

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

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

An initial telephone conference call was held on April 13, 2016. The participants were respective counsel for the parties and Judges Lee, McKone, and Cherry. Neither party identified any motion it presently contemplates filing. Neither party proposed any change to the due dates set in the Scheduling Order entered March 17, 2016 (Paper 8). The parties provided a brief update on the status of the related lawsuit pending in the Eastern District of Texas.

Although not discussed on the call, we want to provide the parties with certain guidance in this case. The parties are directed 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.

The parties are reminded that 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.

If Patent Owner 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. With respect to any feature the 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 that secondary references making up deficiencies of a primary reference are

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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.”).

ORDER

It is

ORDERED that a motion to exclude shall be used only to address admissibility issues under the Federal Rules of Evidence; and

FURTHER ORDERED that any conference call to discuss a motion to amend claims by the Patent Owner shall take place at least two weeks prior to the due date of such a motion;

FURTHER ORDERED that for any “to confer” call with respect to a motion to amend claims, Patent Owner shall be prepared to indicate how it understands the duty of candor under 37 C.F.R. § 42.11 insofar as secondary or complementary prior art references are concerned; and

FURTHER ORDERED that all due dates set in the Scheduling Order entered March 17, 2016 (Paper 8) remain unchanged at this time.

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