

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC,
Patent Owner.

Case IPR2016-00754
Patent 8,559,635 B1

Before KARL D. EASTHOM, TRENTON A. WARD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

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

A conference call was held on April 26, 2017 and attended by respective counsel for the parties. The conference was scheduled to discuss Petitioner's request for authorization to file a motion to strike the Declaration of Dr. Timothy Dorney In Support of Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend (Ex. 2140, "Dorney Reply Declaration") or, in the alternative, to file a Sur-Reply to Patent Owner's Motion to Amend. During the conference, Petitioner indicated that it wished to move to strike the Dorney Reply Declaration on the basis that it improperly included information, filed for the first time, which purports to identify specification support for the proposed amended claims. Petitioner argued that this information should have been submitted along with Patent Owner's Motion to Amend. Alternatively, Petitioner stated that should the Board not authorize a motion to strike, it requests authorization to file a Sur-Reply to Patent Owner's Motion to Amend to address the new information in the Dorney Reply Declaration.

Patent Owner opposes the request to file a motion to strike on the basis that the information included in the Dorney Reply Declaration was properly included to address arguments raised in Petitioner's Opposition to Patent Owner's Motion to Amend regarding the lack of support in the specification for the proposed amended claims. Patent Owner also opposes Petitioner's alternative request for authorization to file a Sur-Reply on the same basis.

Our Rules require that "[a] reply may only respond to arguments raised in the corresponding opposition . . . or patent owner response." *See* 37 C.F.R. § 42.23(b). This reasoning applies equally to reply declarations, submitted to support a party's reply brief. *See Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369–70 (affirming exclusion of reply brief and supporting declaration). Our Trial Practice Guide provides that "a reply that raises a new issue or belatedly presents evidence

will not be considered. . . . The Board will not attempt to sort proper from improper portions of a reply.” Here, we decline to authorize a motion to strike, because not only has other requested relief been authorized below, the Board ordinarily is capable of determining at the close of evidence whether new arguments were raised and disregarding any improper reply evidence.

Additionally, during the call, Petitioner confirmed that it filed Objections (Paper 29) to evidence submitted by Patent Owner with its Reply to the Motion to Amend and specifically objected to the Dorney Reply Declaration, Exhibit 2140. We note that Petitioner is free to preserve this objection by filing a motion to exclude under 37 C.F.R. § 42.64, without prior authorization, to address any evidentiary objections to the Dorney Reply Declaration.

Patent Owner confirmed during the conference that the Dorney Reply Declaration, Ex. 2140, contains much of the same testimony submitted in the Declaration of Dr. Timothy Dorney In Support of Patent Owner’s Contingent Motion to Amend (Ex. 2130, “Dorney Declaration”) filed along with Patent Owner’s Motion to Amend. Petitioner stated on the call that it was concerned primarily with its ability to address new information submitted in the Dorney Reply Declaration, Ex. 2140, that was not included in the Dorney Declaration, Ex. 2130. Accordingly, we hereby authorize Petitioner to file a Sur-Reply to Patent Owner’s Motion to Amend limited to addressing only the new information included in Exhibit 2140 that was not included in Exhibit 2130. The Sur-Reply shall be limited to five pages and must be filed no later than May 17, 2017.

Accordingly, Petitioner’s request for authorization to file a motion to strike Patent Owner’s Exhibit 2140 is *denied* and Petitioner’s request for authorization to file a Sur-Reply to Patent Owner’s Motion to Amend is *granted*.

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ORDER

Accordingly, it is hereby

ORDERED that Petitioner may file a Sur-Reply to Patent Owner's Motion to Amend limited to addressing only the new information included in Ex. 2140 that was not included in Ex. 2130; and

FURTHER ORDERED that the Sur-Reply shall be limited to five pages and be filed no later than May 17, 2017.

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