

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases

IPR2016-00948 (Patent 8,641,525 B2)
IPR2016-00949 (Patent 9,089,770 B2)

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

Conduct of the Proceeding

37 C.F.R. § 42.5

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At Petitioner's request, a conference call was held on October 26, 2016. Judges Kauffman, Petravick, and Weatherly were on the call as well as counsel for the parties. The call discussed scheduling and evidence.

Scheduling

Petitioner explained that follow-up petitions, along with motions for joinder have been filed.

Patent Owner expressed a desire to delay due date 1 because of another *inter partes* review. Petitioner expressed a general willingness to agree to delay due date 1 if due dates 2–7 could be delayed a corresponding amount. Rather than engaging in a lengthy discussion with the Board considering a large number of options, it is preferable that the parties more fully develop tailored requests for relief before calling the Board. *See* IPR2016-00948, Paper 11 ¶ D.1. For example, here, the parties could have presented a joint proposed schedule, or absent agreement between the parties, each party each could have presented its own preferred schedule.

We authorize the parties to submit a joint motion to alter due dates 1–7 with the restriction that due dates 6 and 7 may not be delayed more than two weeks beyond their currently scheduled dates.

Evidence

Patent Owner asked whether its contention in the Preliminary Response that the statements of Dr. Donohoe recited in the Petition are inadmissible hearsay was a timely objection.¹ The relevant portion of the

¹ That contention can be found at Paper 7, 28.

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applicable rule provides, “[a]ny objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of trial.” 37 C.F.R. § 42.64(b)(1). Patent Owner contends that the rule can be read two ways: (1) objections must be submitted no later than ten days from institution of trial, meaning that objections prior to institution are permissible, or (2) objections may be served in the window of time from institution of trial to ten days after institution. Patent Owner explained that it had interpreted Rule 42.64 in the latter manner.

We are unaware of any Board decision that aligns with Patent Owner’s first interpretation; rather, the Board has consistently taken the second interpretation, holding that objections prior to institution are premature. *See, e.g., Commissariat À L’Energie Atomique Et Aux Energies Alternatives v. Silicon Genesis Corp.*, Case IPR2016-00832, slip op. at 22–23 (PTAB Sept. 28, 2016) (Paper 12); *see also Mitsubishi Plastics, Inc. v. Celgard LLC*, Case IPR2014-00524 (PTAB Oct. 15, 2014) (Paper 17) (expunging objections, in part, because they were filed prior to institution).

Any doubt regarding the panel’s interpretation of rule 42.64 was removed by our Institution Decision in which we explained that

Patent Owner’s assertion that Dr. Donohoe’s statements are inadmissible hearsay is premature. Rule 42.64 provides the framework for Patent Owner to object to information proffered as evidence and move to exclude objectionable material from evidence during the trial. *See* 37 C.F.R. § 42.64.

Paper 10, 5.

Patent Owner requested this call on October 21, 2016, more than ten days after entry of our Institution Decision on September 27, 2016.

Consequently, the time for objection has expired. 37 C.F.R. § 42.64(b)(1).

Beyond this shortcoming, objections should be filed as a separate paper and

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not with a preliminary response. *See* 37 C.F.R. § 42.6(a)(3) (prohibiting combined documents).

Although Patent Owner has not made an effective objection, the contentions in the Preliminary Response put Petitioner on notice that Patent Owner contends that Dr. Donohoe's statements are inadmissible hearsay. In light of this, we authorize Patent Owner to submit objections to the evidence at issue (Ex. 1007, Decl. Dr. Donohoe). We remind Patent Owner of the obligation to identify the ground for the objection with sufficient particularity to allow correction in the form of supplemental evidence. 37 C.F.R. § 42.64(b)(1).

Accordingly, it is:

ORDERED that, no later than five working days from entry of this order, the parties may submit a joint proposed schedule as outlined above;

ORDERED that, no later than two working days from entry of this order, Patent Owner may file objections as outlined above, and

FURTHER ORDERED, that Petitioner may elect to respond to Patent Owner's objections as permitted by 37 C.F.R. § 42.64(b)(2).

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