

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC.,
CANON FINANCIAL SERVICES, INC., FUJIFILM CORPORATION,
FUJIFILM HOLDINGS AMERICA CORPORATION,
FUJIFILM NORTH AMERICA CORPORATION, JVC KENWOOD
CORPORATION, JVCKENWOOD USA CORPORATION,
NIKON CORPORATION, NIKON INC., OLYMPUS CORPORATION,
OLYMPUS AMERICA INC., PANASONIC CORPORATION,
PANASONIC CORPORATION OF NORTH AMERICA,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Cases IPR2016-01211 (Patent 8,504,746 B2),
IPR2016-01213 (Patent 8,504,746 B2),
IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225
(Patent 8,966,144 B2)¹

Before JONI Y. CHANG, JENNIFER S. BISK, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

¹ This Order addresses the same issues for the above-identified cases. We, therefore, exercise our discretion to issue one order to be filed in each case.

IPR2016-01211 (Patent 8,504,746 B2)
IPR2016-01213 (Patent 8,504,746 B2)
IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225
(Patent 8,966,144 B2)

On August 2, 2017, a conference call was held among respective counsel for Petitioner and Patent Owner, and Judges Chang, Bisk, and Quinn. Patent Owner requested the call to seek the panel's guidance on how to address allegedly new arguments and supporting evidence filed with Petitioner's Reply in each of the above-identified proceedings, and to seek clarification whether motions to exclude would be a proper mechanism.

As we discussed during the conference call, a motion to exclude is not a proper mechanism to present argument that a reply and evidence filed in support of the reply are outside the scope of a proper reply under 37 C.F.R. § 42.23(b); and we will determine whether a reply and supporting evidence are outside the scope of a proper reply when we review all of the parties' briefs and prepare the final written decision. During the conference call, we also noted that other panels had authorized parties to file a two-page itemized listing or surreply in similar situations.

Patent Owner indicated that a two-page itemized listing would be sufficient for each proceeding, and requested our authorization for filing such a listing. Petitioner did not object to Patent Owner's request, but also requested our authorization to file a two-page responsive itemized listing.

Upon consideration of the parties' positions, we authorized Patent Owner to file a paper limited to two pages, in each above-identified proceeding, that lists, by page and line number, the specific statements in the Petitioner's Reply and evidence filed in support of the Petitioner's Reply that Patent Owner deems to be beyond the proper scope of a reply. No argument is to be included in the contents of the submission.

IPR2016-01211 (Patent 8,504,746 B2)
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(Patent 8,966,144 B2)

We also authorized Petitioner to file a responsive paper, limited to two pages, in each proceeding, to provide an item-by-item response to the items listed in Patent Owner's submission. Each item in Petitioner's responsive paper should identify specifically the part of Patent Owner's Response and/or expert declaration filed in support of Patent Owner's Response, by page and line number, to which the corresponding item complained of by the Patent Owner is provided as a response, if indeed that is the case. Petitioner should also identify, by page and line number, where in the Petition or other previously-filed paper or exhibit specifically discusses the issue raised in that item. No argument is to be included in the contents of the submission.

Accordingly, it is

ORDERED that, in each of the above-identified proceedings, Patent Owner is authorized to file a two-page itemized listing, as described above, within five business days from the date of this Order, and

FURTHER ORDERED that, in each of the above-identified proceedings, Petitioner is authorized to file a two-page responsive itemized listing, as described above, within five business days from the filing of Patent Owner's listing.

IPR2016-01211 (Patent 8,504,746 B2)
IPR2016-01213 (Patent 8,504,746 B2)
IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225
(Patent 8,966,144 B2)

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