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Paper No. 26
Entered: October 26, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., HTC CORPORATION, HTC AMERICA, INC., MICROSOFT CORPORATION, MICROSOFT MOBILE OY, MICROSOFT MOBILE, INC., SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., and ZTE (USA) INC.,
Petitioners,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Cases IPR2016-00757, IPR2016-01228, IPR2016-01229, IPR2016-01345
Patent 7,881,236 B2

Before WILLIAM V. SAINDON, PATRICK M. BOUCHER, and TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER
Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

Pursuant to our authorization, Patent Owner filed a Motion for Submission of Supplemental Information Under 37 C.F.R. § 42.123(b) (Paper 38, "Mot."), which Petitioners oppose (Paper 39, "Opp."). For the reasons set forth below, the motion is *denied*.

I. BACKGROUND

Trial in IPR2016-00757 was instituted on December 2, 2016. Paper 11. Trial in IPR2016-01228 was instituted on December 27, 2016. IPR2016-01228, Paper 8. Trial in IPR2016-01229 was instituted on December 27, 2016. IPR2016-01229, Paper 8. Trial in IPR2016-01345 was instituted on December 2, 2016, and was consolidated with IPR2016-00757. IPR2016-01345, Paper 8. Oral argument in these proceedings was held on August 8, 2017.

In the instant motion, Patent Owner requests entry into the record of these proceedings excerpts from the deposition transcript of Dr. Villasenor, Exhibit 2011 ("Patent Owner's Submission of Proposed Supplemental Information Pursuant to Motion filed Under 37 C.F.R. § 42.123(b)"). The deposition of Dr. Villasenor was taken in *Evolved Wireless, LLC v. Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc.*, C.A. 15-545-SLR-SRF (N.D. Cal.). Ex. 2011, 2. Pursuant to the Order in which Patent Owner was granted leave to file the instant motion, Petitioners were "authorized to file as an exhibit excerpts from the same deposition transcript from which Patent Owner submits excerpts in order that the testimony proffered by Patent Owner may be understood in context and for completeness." Paper 37, 2. Petitioners filed Exhibit 1048 ("Samsung Petitioners' Submission in Response to Proposed Supplemental Information from Patent Owner Pursuant to Motion filed Under 37 C.F.R. § 42.123(b)").

Although submission of these exhibits was authorized, Exhibit 2011 and Exhibit 1048 have not been entered as evidence of record in these proceedings.[1]

These proceedings involve challenges to the claims of US 7,881,236 B2 ("the '236 patent," Ex. 1001). A central issue in these proceedings relates to construction of the word "if" as recited in the claims of the '236 patent. *See* Mot. 2–3. Patent Owner contends, "[t]he supplemental information is highly relevant to the central issue of claim construction present in all proceedings" and "[t]he proposed deposition testimony of Dr. Villasenor demonstrates how one of ordinary skill in the art construes the term 'if' in the '236 patent." *Id*. at 2.

II. ANALYSIS

Patent Owner's motion is filed under 37 C.F.R. § 42.123(b) which governs "Late submission of supplemental information" defined as submission of supplemental information "more than one month after the date the trial is instituted." 37 C.F.R. § 42.123(b) provides: "[t]he motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice."

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[1] Paper 37, 3 ("FURTHER ORDERED that any Proposed Supplemental Information submitted in exhibits in support of papers filed in accordance with this Order are provided merely for consideration of the Motion for Submission of Supplemental Information and is not entered as evidence of record and shall not be cited as evidence in any paper other than papers filed in accordance with this Order, unless later entered by explicit order of the Board.").

A. Timeliness of the Submission of Supplemental Information

Patent Owner's Motion comes very late in these proceedings. Patent Owner has submitted its responses to the petitions, discovery has been conducted and is closed, the Petitioners have submitted their replies, and oral argument has been held. All that remains is for the final written decisions to be entered.

Along with its responses, Patent Owner submitted the Declaration of Todor Cooklev, Ph.D. *See* Exhibit 2006. Patent Owner relied on the Cooklev Declaration in the claim construction section of its response. Paper 22, 15–17. In the replies, Petitioners argued the Cooklev Declaration was defective because it was unsworn and compares the preferred embodiment to the prior art. *See* Paper 28 at 6–7. Thus, earlier in these proceedings, Patent Owner had the opportunity to obtain and submit testimony on the issue of claim construction. To the extent Patent Owner's efforts in this regard were lacking, these circumstances do not establish any lack of opportunity.

Patent Owner contends that the supplemental information reasonably could not have been obtained earlier because "[t]he transcript of Samsung's expert, Dr. Villasenor, was not available until Sept. 12, 2017." Mot. 1. Petitioners argue that Patent Owner's Motion "is an eleventh-hour effort to replace a defective declaration submitted together with PO's Response." Opp. 1. According to Petitioners, the issue is not whether Patent Owner had earlier access to Dr. Villasenor's opinions but whether Patent Owner "could have obtained earlier expert opinion" on claim construction. *Id*. at 2. We agree with Petitioners.

All parties, including Patent Owner, have had a full and fair opportunity to be heard on claim construction. Patent Owner could have

earlier obtained and submitted testimony or other evidence on claim construction.

B. Interests-of-Justice

Patent Owner's primary argument in support of its contention that consideration of the proffered supplemental information is in the interests-of-justice is that Dr. Villasenor's testimony is highly relevant to the central issue of claim construction. Mot. 2–4. Petitioners oppose consideration on the basis that Dr. Villasenor's testimony is not relevant because it is "extrinsic evidence" and because Dr. Villasenor used the wrong claim construction standard.[2] Opp. 2–4.

"A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. §42.100(b). *See also Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131, 2144 (2016) ("the regulation represents a reasonable exercise of the rulemaking authority that Congress delegated to the Patent Office"). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Expert testimony is considered extrinsic evidence, which is less relevant than the intrinsic evidence of the claims, the specification, and the file history when the meaning is clear from this intrinsic evidence. *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54

[2] In District Court litigation, claims are construed in accordance with *Phillips v. AWH Corp*., 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc)).

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