

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

FOCAL IP, LLC,
Patent Owner.

Case: IPR2016-01260¹
Patent 8,457,113 B2

Before JONI Y. CHANG and BARBARA A. PARVIS,
Administrative Patent Judges.

PARVIS, *Administrative Patent Judge.*

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

On July 6, 2017, a conference call was held with Judges Chang and Parvis and counsel for the parties in attendance. Patent Owner requested the conference call to ask for authorization to file motions to strike certain

¹ This Order addresses the same issues in the *inter partes* reviews listed in the Appendix. Therefore, we issue one Order to be filed in all of the cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

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portions of Declarations filed in support of Petitioners' Oppositions to Patent Owner's Motions to Amend, as well as certain of Petitioners' Replies and accompanying Declarations. Patent Owner seeks, as an alternative to filing motions to strike certain of Petitioners' Replies, authorization to file sur-replies. Petitioners opposed. During the call, Petitioner Cisco Systems Inc. requested re-filing its Replies in two proceedings, and Patent Owner opposed.

We first turn to Patent Owner's request to file motions to strike certain portions of Declarations filed in support of Petitioners' Oppositions to Patent Owner's Motions to Amend. Patent Owner, more specifically, contends that in IPR2016-01258, -01260, -01261, and -01262, Petitioners filed element-by-element analyses in the form of claim charts that exceed the scope of Petitioners' Oppositions. The claim charts are submitted as part of Declarations in each of IPR2016-01258 and IPR2016-01260, i.e., IPR2016-01258, Ex. 1042 and IPR2016-01260, Ex. 1045. In IPR2016-01261 and IPR2016-01262, the claim charts are submitted as separate exhibits, i.e., IPR2016-01261, Exs. 1067 and 1068 and IPR2016-01262, Exs. 1067 and 1068. According to Patent Owner, the element-by-element analyses in the claim charts pertain to all limitations of the proposed substitute claims, whereas the Oppositions address only two limitations.

Petitioners acknowledge that claim charts were filed in each of IPR2016-01258, -01260, -01261, and -01262, but contend that these charts need not be considered and simply preserve arguments in the event that the state of the law changes. In the alternative, Petitioners contend that the claim charts are duplicative of arguments made in the Oppositions.

We are not persuaded by Petitioners that submission of additional

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arguments in Declarations that exceed the scope of arguments presented in Oppositions is proper to preserve arguments. Further, to the extent that the claim charts are duplicative of arguments presented in the Oppositions, we need not have the same arguments presented twice. Accordingly, we treat Patent Owner's request as a request to expunge these exhibits (i.e., IPR2016-01258, Ex. 1042; IPR2016-01260, Ex. 1045; IPR2016-01261, Exs. 1067 and 1068; and IPR2016-01262, Exs. 1067 and 1068), without prejudice with respect to the Declarations. We authorize Petitioner, YMax Corporation, to refile the Declarations in each of IPR2016-01258 and IPR 2016-01260 without claim charts on or before July 12, 2017.

We next turn to Patent Owner's request for authorization to file motions to strike certain of Petitioners' Replies and accompanying Declarations, or, in the alternative, to file sur-replies. As we explained during the call, replies that present new issues or belatedly present evidence will not be considered. *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Patent Owner is not authorized to file a motion to strike or a sur-reply, but, instead, is authorized to file an itemized listing similar to that filed in another proceeding. *See Cisco Systems, Inc. v. TQ Delta LLC*, Case IPR2016-01009 (PTAB June 22, 2017) (Paper 19).

More specifically, we authorize Patent Owner to file a paper in each of IPR2016-01254, -01257, -01259, -01261, -01262, and -01263, limited to two pages, that provides an itemized listing, by page and line number, of what statements and evidence in Petitioner's Reply are deemed by Patent Owner to be beyond the proper scope of a reply. No argument is to be included in the contents of the submission. We also authorize Petitioner to

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file a responsive paper, in each of IPR2016-01254, -01257, -01259, -01261, -01262, and -01263, limited to two pages, which provides an item-by-item response to the items listed in Patent Owner's submission. Each item in Petitioner's responsive paper would identify that part of Patent Owner's Response, by page and line number, to which the corresponding item complained of by Patent Owner is provided as a response, if indeed that is the case. No argument is to be listed in the contents of the submission.

We now turn to Petitioner Cisco Systems Inc.'s request to re-file its Replies in IPR2016-01254 and IPR2016-01257. As authorized during the call July 6, 2017, Cisco Systems Inc. submitted redlined versions of the Replies via e-mail. Contrary to Patent Owner's argument during the call, the changes are typographical, not substantive. We, therefore, authorize Petitioner Cisco Systems Inc. to file its revised Reply as a new paper in each of IPR2016-01254 and IPR2016-01257. Petitioner also is authorized to file the LaPier patent (i.e., corrected Exhibit 1047 in IPR2016-01254 and corrected exhibit 1147 in IPR2016-01257). Additionally, Petitioner should file its redlined versions of the Replies as exhibits in IPR2016-01254 and IPR2016-01257.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, in each of IPR2016-01258 and IPR2016-01260, Petitioner's Declaration in support of its Opposition to Patent Owner's Motion to Amend (i.e., IPR2016-01258, Ex. 1042 and IPR2016-01260, Ex. 1045) shall be expunged without prejudice to Petitioner refiling each Declaration without claim charts on or before July 12, 2017;

FURTHER ORDERED that in IPR2016-01261, Petitioner's Claim

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Chart of Lewis Against Proposed Substitute Claim 183 and Claim Chart of LaPier Against Proposed Substitute Claim 183 (i.e., IPR2016-01261, Exs. 1067 and 1068) and in IPR2016-01262, Petitioner's Claim Chart of Lewis Against Proposed Substitute Claim 49 and Claim Chart of LaPier Against Proposed Substitute Claim 49 (i.e., IPR2016-01262, Exs. 1067 and 1068) shall be expunged;

FURTHER ORDERED Patent Owner is authorized to file a submission in each of IPR2016-01254, IPR2016-01257, IPR2016-01259, IPR2016-01261, IPR2016-01262, and IPR2016-01263, limited to two pages, that provides an itemized listing, by page and line number, of what statements and evidence in Petitioner's Reply are deemed by Patent Owner to be beyond the proper scope, and each submission is due July 14, 2017;

FURTHER ORDERED that Petitioners are authorized to file responsive submissions, limited to two pages, in each of IPR2016-01254, IPR2016-01257, IPR2016-01259, IPR2016-01261, IPR2016-01262, and IPR2016-01263, each of which provides an item-by-item response to the items listed in Patent Owner's submission, and such submissions are due July 21, 2017; and

FURTHER ORDERED that Petitioner Cisco Systems Inc. is authorized to file its revised Replies in IPR2016-01254 and IPR2016-01257, as well as the LaPier patent (i.e., corrected Exhibit 1047 in IPR2016-01254 and corrected exhibit 1147 in IPR2016-01257), and Petitioner further shall file its redlined versions of the Replies as exhibits in IPR2016-01254 and IPR2016-01257.

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