

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2016-01381
Patent 8,773,356 B2

MICHAEL R. ZECHER, NEIL T. POWELL, and
MINN CHUNG, *Administrative Patent Judges.*

POWELL, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5(a) and 42.7(a)

I. DISCUSSION

On August 28, 2017, Immersion Corporation (“Patent Owner”), filed a Motion for Observation regarding the cross-examination testimony of Patrick Baudisch, Ph.D., the reply witness for Apple Inc. (“Petitioner”). Paper 24. As expected, Patent Owner filed its Motion for Observation along with a transcription of the cross-examination testimony of Dr. Baudisch. Ex. 2013. In addition, Patent Owner filed two other new exhibits with its Motion for Observation. Exs. 2011, 2012.

As we explained in the Scheduling Order, a motion for observation on cross-examination is a mechanism to draw our attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. Paper 8, 4. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. *Id.* at 4-5. An observation, however, is not an opportunity to raise new issues, e.g., by introducing or filing new evidence that was not presented and developed previously during the course of trial. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). We may decline consideration or entry of observations in certain circumstances where a party raises new issues. *See id.*

Apart from the transcription of the cross-examination testimony of Dr. Baudisch (Ex. 2013), which provides the necessary context for each of Patent Owner’s observations, the guidance noted above does not permit Patent Owner to introduce or file new, additional evidence with its Motion for Observation that has uncertain evidentiary value, and for which no filing authorization has been

provided. Consequently, based on the particular circumstances of this case, we exercise our authority under 37 C.F.R. § 42.7(a) to expunge Patent Owner's Motion for Observation, along with new Exhibits 2011 and 2012. Nonetheless, we will afford Patent Owner another opportunity to refile the same observations regarding the cross-examination testimony of Dr. Baudisch; however, Patent Owner must delete any citation to these new exhibits. No new, additional evidence is permitted to be introduced or filed with the corrected Motion for Observation, without prior authorization from the panel.

II. ORDER

Accordingly, it is:

ORDERED that, pursuant to 37 C.F.R. 42.7(a), Patent Owner's Motion for Observation regarding the cross-examination testimony of Dr. Baudisch (Paper 24) and Exhibits 2011 and 2012 are expunged from the record of this proceeding;

FURTHER ORDERED that Patent Owner is authorized to refile the same observations regarding the cross-examination testimony of Dr. Baudisch, but must delete any citation to Exhibits 2011 and 2012;

FURTHER ORDERED that Patent Owner's corrected Motion for Observation is due no later than Thursday, August 31, 2017; and

FURTHER ORDERED that Patent Owner shall not file or introduce new, additional evidence with its corrected Motion for Observation.

IPR2016-01381
Patent 8,773,356 B2

For PETITIONER:

James Heintz
Apple-immersion-IPRs@dlapiper.com

Brian Erickson
Brian.erickson@dlapiper.com

For PATENT OWNER:

Michael Fleming
mflaming@irell.com

Babak Redjaian
bredjaian@irell.com