

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

I.M.L. SLU, and
DUODECAD IT SERVICES LUXEMBOURG S.À R.L.,
ACCRETIVE TECHNOLOGY GROUP, INC., ICF TECHNOLOGY, INC.,
and RISER APPS LLC,¹
Petitioners

v.

WAG ACQUISITION, LLC,
Patent Owner

Case IPR2016-01656
Patent 8,122,141 B2
Case IPR2016-01658
Patent 8,364,839 B2

Before TREVOR M. JEFFERSON, BRIAN J. McNAMARA, and
PATRICK M. BOUCHER, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge.*

ORDER
Trial Hearing
37C.F.R. § 42.70

¹¹ DUODECAD IT SERVICES LUXEMBOURG S.À R.L, et al. are present by virtue of the joinder of IPR2017-01179 to IPR2016-01658.

Hearing on the Merits

A trial in IPR2016-01656 and IPR2016-01658 was instituted on February 27, 2016. Paper 11² (“Decision to Institute”). A Scheduling Order entered at the same time set the date for oral hearing in each proceeding to November 30, 2017, if hearing is requested by the parties and granted by the Board. Paper 12 (“Scheduling Order”). On October 5, 2017, IPR2017-01179 brought by Duodecad IT Services Luxembourg S.À R.L., Accretive Technology Group, Inc., ICF Technology, Inc., and Riser Apps LLC (“Duodecad”) was terminated and joined to IPR2017-01658. In each proceeding, the parties have requested oral hearing pursuant to 37 C.F.R. § 42.70. The requests are GRANTED. We will conduct a consolidated hearing of IPR2016-01656 and IPR2016-01658.

Each party will have 45 minutes of total argument time. I.M.L. SLU (and for purposes of IPR2016-01658 Duodecad) (“Petitioner”) bears the ultimate burden of proof that the claims at issue in this review are unpatentable. Therefore, at oral hearing Petitioner will proceed first to present its case with regard to the challenged claims on which basis we instituted trial. Thereafter, WAG Acquisition, LLC (“Patent Owner”) will argue its opposition to Petitioner’s case. Petitioner may then use any time Petitioner reserved to rebut to Patent Owner’s opposition. Finally, Patent Owner may use any time it reserved solely to rebut Petitioner’s opposition to Patent Owner’s motion to amend.

Hearing on Motion For Discovery

² Paper numbers are provided for IPR2016-01656, unless otherwise noted.

In each proceeding Patent Owner has moved for discovery on matters relating to real party-in-interest issues. Although we have conducted several telephone conferences encouraging the parties to agree to appropriate discovery, the parties appear to have been unable to resolve issues concerning the scope of discovery. Therefore, following the hearing on the merits we will hear up to 15 minutes of argument from each side concerning the scope of discovery. Patent Owner has the burden of persuasion on its motion and will argue first, Petitioner may then oppose, and Patent Owner may use any time it reserved to rebut Petitioner's Opposition. We remind the parties of our earlier guidance that discovery in *inter partes* review is more narrow than that available in district court and must be tailored to the specific real party-in-interest issue. We also remind the parties that, having availed itself of this forum, Petitioner is required to make full disclosure in real party-in-interest matters. *See* 35 U.S.C. § 312(a)(2).

There is a strong public policy interest in making all information presented in these proceedings public, as the review determines the patentability of claims in an issued patent and thus affects the rights of the public. This policy is reflected in part, for example, in 35 U.S.C. § 316(a)(1) and 35 U.S.C. § 326(a)(1) which provide that the file of any *inter partes* review or post grant review be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion. Therefore the hearing will be open to the public for in-person attendance. Should the hearing on Patent Owner's discovery motion require discussion of confidential information, we will address the matter at that time.

The hearings will commence at 1:30 PM Eastern Time on November 30, 2017, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. In-person attendance will be accommodated on a first come first serve basis.

The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. Any demonstrative exhibits must be served seven business days before the hearing. 37 C.F.R. § 42.70(b). Demonstrative exhibits are not evidence and may not introduce new evidence or arguments. Instead, demonstrative exhibits should cite to evidence in the record. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case No. IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), and *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 118 (Oct. 23, 2013), regarding the appropriate content of demonstrative exhibits. Any issue regarding demonstrative exhibits should be resolved at least three days prior to the hearing by way of a joint telephone conference call to the Board. The parties are responsible for requesting such a conference sufficiently in advance of the hearing to accommodate this requirement. Any objection to demonstrative exhibits that is not timely presented will be considered waived. Demonstratives should be filed at the Board no later than two days before the hearing. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

Questions regarding specific audio-visual equipment should be directed to the Board at (571) 272-9797. **Requests for audio-visual equipment are to be made 5 days in advance of the hearing date. The**

request is to be sent to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.

The parties are reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript. The parties also should note that at least one member of the panel for each proceeding will be attending the hearings electronically from a remote location and that if a demonstrative is not filed or otherwise made fully available or visible to the judge presiding over the hearing remotely, that demonstrative will not be considered. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to all of the judges, the parties are invited to contact the Board at 571-272-9797.

The Board expects lead counsel for each party to be present in person at the oral hearing. However, lead or backup counsel may present the party's argument. If either party anticipates that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

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