

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

BLACKBERRY LTD.,
Patent Owner.

Case IPR2017-01619
Case IPR2017-01620
(Patent 8,489,868 B2)¹

Before SALLY C. MEDLEY, ROBERT J. WEINSCHENK, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

¹ This order addresses an issue that is identical in both cases. We exercise discretion to issue one order to be filed in both cases. The parties, however, are not authorized to use this style heading.

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On August 1, 2018, Patent Owner requested a conference call to seek authorization to file motions to strike. A conference call was held on August 9, 2018, attended by counsel for the parties and Judges Medley, Weinschenk, and Moore. A court reporter was also present, and the parties agreed to file the transcript as an exhibit in both cases in due course.

Patent Owner alleges that the following material from Petitioner's Replies is improper because it is not responsive to Patent Owner's argument that Petitioner failed to carry its burden to show the Gong reference was a printed publication: (1) pages 24–25 of Petitioner's Reply in IPR2017-01619 (starting "Additional evidence . . ."), (2) pages 24–25 of Petitioner's Reply in IPR2017-01620 (starting "Additional evidence . . ."), and (3) Exhibits 1038–45 in both proceedings. Petitioner disagrees, and observes that Patent Owner was aware of this material by virtue of it having been served in January of this year, in response to Patent Owner's Objections to Evidence.

Under the particular circumstances of these cases, we deny Patent Owner's request for a motion to strike and, instead, exercising our discretion under 37 C.F.R. § 42.20(d), authorize Patent Owner to file a single, five page Sur-Reply in both cases. The Sur-Reply may only address (1) pages 24–25 of Petitioner's Reply in IPR2017-01619 (starting "Additional evidence . . ."), (2) pages 24–25 of Petitioner's Reply in IPR2017-01620 (starting "Additional evidence . . ."), and (3) Exhibits 1038–45 in both proceedings. The Sur-Reply may not present or argue new evidence or testimony, except as relates to deposition testimony of declarants Jodi L. Gregory and Dr. Li Gong.

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Accordingly, it is:

ORDERED that Patent Owner is authorized to file a Sur-Reply in both cases, the two documents to be substantively identical, limited to addressing (1) pages 24–25 of Petitioner’s Reply in IPR2017-01619 (starting “Additional evidence . . .”), (2) pages 24–25 of Petitioner’s Reply in IPR2017-01620 (starting “Additional evidence . . .”), and (3) Exhibits 1038–45 in both proceedings;

FURTHER ORDERED that the Sur-Reply may not exceed five pages;

FURTHER ORDERED that no new evidence other than deposition testimony of Jodi L. Gregory and/or Dr. Li Gong shall be submitted with or addressed in the Sur-Reply;

FURTHER ORDERED that the Sur-Reply shall be filed by August 24, 2018, or, in the event that Jodi L. Gregory and/or Dr. Li Gong are deposed, five business days after completion of the deposition(s); and

FURTHER ORDERED that Petitioner is not authorized to file responsive submissions.

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