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Paper 69
Entered: September 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, ZTE (USA), INC.,
SAMSUNG ELECTRONICS CO., LTD.,
LG ELECTRONICS INC., HUAWEI DEVICE USA, INC.,
HUAWEI DEVICE CO. LTD., HUAWEI TECHNOLOGIES CO. LTD.,
HUAWEI DEVICE (DONGGUAN) CO. LTD.,
HUAWEI INVESTMENT & HOLDING CO. LTD.,
HUAWEI TECH. INVESTMENT CO. LTD., and
HUAWEI DEVICE (HONG KONG) CO. LTD.,
Petitioner,

v.

CYWEE GROUP LTD,
Patent Owner.

Case IPR2018-01257 (Patent 8,552,978 B2)
Case IPR2018-01258 (Patent 8,441,438 B2)

Before PATRICK M. BOUCHER, KAMRAN JIVANI, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

A conference call was held with the parties on September 5, 2019. Three issues were discussed. The parties were notified of the panel's decisions on all three issues at the conclusion of the call, and those issues and decisions are memorialized herein.

I. DECLARATION BY SHUN-NAN LIOU

First, a Declaration by Shun-Nan Liou, an inventor named on the challenged patents, was filed by Patent Owner as Exhibit 2020.[1] As uncompelled direct testimony, such a Declaration "must be submitted in the form of an affidavit." 37 C.F.R. § 42.53(a). In defining an "affidavit," our regulations refer to the provisions of 37 C.F.R. § 1.68 and 28 U.S.C. § 1746. *See* 37 C.F.R. § 42.2. The former of these, i.e., 37 C.F.R. § 1.68, requires that a declarant be warned, on the same document, that "willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001)." The latter, i.e., 28 U.S.C. § 1746, provides that unsworn declarations may substitute for sworn declarations if accompanied by a statement in substantially the form, "I declare . . . under penalty of perjury under the laws of the United States of America that the foregoing is true and correct." Exhibit 2020 includes neither statement, and Patent Owner requested authorization on the call to file a substitute exhibit that includes the required language but which is otherwise identical to the previously filed exhibit. Petitioner opposes.

In Petitioner's Surreply in Opposition to Patent Owner's Motion to Amend, Petitioner observes that Dr. Liou's "statement is not in the form of

[1] Citations are to IPR2018-01257. Similar papers and exhibits have been filed in both proceedings.

an affidavit, as required by 37 C.F.R. §42.53(a)," and asserts that Petitioner "notified CyWee of this in its objections of Aug. 7, 2019, but CyWee made no correction." Paper 64, 1–2. Petitioner's objection of August 7, 2019, states: "Google further objects under FRE 802 and 37 C.F.R. 42.53(a) because the exhibit is an alleged out-of-court statement of an individual that does not meet any hearsay exception and is not in the form of an affidavit." Paper 49, 2–3.

Petitioner's Surreply in Opposition to Patent Owner's Motion to Amend cites *FedEx v. Ronald A. Katz Tech.*, CBM2015-00053, Paper 9 at 7–8 (PTAB June 29, 2015). In that case, a declaration filed by a petitioner was given no weight in determining whether to institute a covered business method review because the declaration was not sworn under penalty of perjury and did not include any statements or warnings as to the truth of the statements or the ramifications of making false statements. *FedEx*, Paper 9 at 7. Conversely, Patent Owner drew our attention during the call to *Fidelity Information Services, LLC v. Mirror Imaging, LLC*, CBM2017-00064, Paper 54 (PTAB Jan. 2, 2019), in which a panel granted an oral motion to file a corrected declaration to add the language required by 18 U.S.C. § 1001. In *Fidelity*, the party opposing filing of the corrected declaration had, as here, duly objected. *Fidelity*, Paper 54 at 6.

Patent Owner's attempt to cure Dr. Liou's defective Declaration is untimely, and the only reason offered by Patent Owner for that untimeliness during the call was "inadvertence." *See* 37 C.F.R. § 42.64(b)(2) ("The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection."). But our regulations accord us with discretion to

excuse a late action "on a showing of good cause or upon a Board decision that consideration on the merits would be in the interest of justice." 37 C.F.R. § 42.5(c)(3).

We find the circumstances in this proceeding more akin to those in *Fidelity* than to those in *FedEx*, and accordingly exercise such discretion to authorize filing of the Corrected Declaration. Specifically, in *FedEx*, the Board was confronted with a preliminary record that included no attempt by the proffering party to cure the defective declaration. By contrast, in *Fidelity*—as in this proceeding—the proffering party made a specific effort to cure. But even more relevant to our determination is the fact that, notwithstanding the defectiveness of Dr. Liou's Declaration, Petitioner nonetheless proceeded to cross-examine Dr. Liou. *See* Paper 58 (Notice of Deposition of Shun-Nan Liou). Petitioner thus appears to have pursued a strategy that would allow it to use Dr. Liou's cross-examination testimony if something productive were uncovered, and to seek to suppress Dr. Liou's direct testimony if that cross-examination proved unproductive. Under these circumstances, we find it in the interest of justice to allow Patent Owner to cure the defect in Dr. Liou's Declaration. *Cf. Apple Inc. v. Evolved Wireless*, IPR2016-01228, Paper 27 at 10–11 (PTAB Nov. 30, 2017) (giving no weight to an unsworn declaration where the opposing party forwent cross-examination).

II. PATENT OWNER'S REPLY IN SUPPORT OF MOTION TO TERMINATE

Second, Petitioner contends that a paragraph of Patent Owner's Reply in Support of its Motion to Terminate, specifically the paragraph beginning

on the last line of page 3 of Paper 65,[2] includes improper new argument and evidence. In particular, Petitioner identifies Exhibits 2046 and 2048, as well as pages 5–21 of Exhibit 2047, as evidence that it contends is not properly responsive to arguments made in Petitioner's Opposition to Patent Owner's Motion to Terminate, i.e., Paper 51.[3] Petitioner requests authorization to file a motion to strike the identified portion of Paper 65, as well as the identified exhibits, or, in the alternative, to file a surreply to address Patent Owner's argument.

During the call, Patent Owner did not oppose Petitioner's alternative request, even in light of the specific observation that this alternative request would provide Petitioner with the last written word on this argument. In light of this agreement, we authorize Petitioner to file a surreply in support of its Opposition to Patent Owner's Motion to Terminate, limited to addressing the argument and evidence discussed in the paragraph beginning on the last line of page 3 of Paper 65. In granting this authorization, we deny Petitioner's request to file the surreply at a time after the date of the oral hearing. Such timing would deprive the panel of having the full authorized briefing by the parties on the termination issue available at the time of the hearing, which we find unproductive.

[2] A public redacted version of Paper 65 is available in the record as Paper 66.
[3] A public redacted version of Paper 51 is available in the record as Paper 52.

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