

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST TEK INTERACTIVE ENTERTAINMENT LTD.,
Petitioner,

v.

NOMADIX, INC.,
Patent Owner.

IPR2019-00211
(Patent 7,953,857 B2)
IPR2019-00253
(Patent 8,626,922 B2)¹

Before SALLY C. MEDLEY, DANIEL J. GALLIGAN, and
JASON W. MELVIN, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

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

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On July 10, 2019, a conference call was held involving counsel for the respective parties and Judges Medley, Galligan, and Melvin. The purpose of the conference call was to discuss (1) Patent Owner's opposed request to extend DUE DATES 1–3, and (2) Petitioner's opposed request to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(a)(1).

Adjustment of Dates

Per the Scheduling Order, the parties may stipulate different dates for at least DUE DATES 1–3. IPR2019-00211, Paper 7, 6; IPR2019-00253, Paper 7, 6. During the conference call, Patent Owner represented that Patent Owner will not file a Motion to Amend in either proceeding. As such, the parties ultimately stipulated to different dates for DUE DATES 1 and 2. The new DUE DATES for 1 and 2 are appended to this Order and supersede previous DUE DATES 1 and 2. The panel appreciates the parties' cooperation in stipulating to new DUE DATES 1 and 2.

Supplemental Information

Petitioner requests leave to file a motion to submit supplemental information (a supplemental affidavit from Gerard Grenier) pursuant to 37 C.F.R. § 42.123(a)(1) in response to objections filed by Patent Owner. Ex. 3001. As explained during the call, the proper course of curing an evidentiary objection is to serve supplemental evidence. *See* 37 C.F.R. § 42.64(b)(2). Petitioner represented that it has served supplemental evidence. Nonetheless, Petitioner maintains that in case Patent Owner includes substantive arguments in its Patent Owner Response regarding the sufficiency of evidence (e.g., Ex. 1012 (Declaration of Gerard Grenier)) to

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show that Rupp is prior art, Petitioner would like to file the supplemental affidavit from Gerard Grenier now. Patent Owner opposes the request, arguing that the supplemental evidence should have been filed with the Petition. In essence, Patent Owner opposes the submission of the supplemental evidence at any stage of these proceedings, as it would be prejudicial to Patent Owner.

As we explained during the call, Petitioner will have opportunity to respond to Patent Owner's Response in its Petitioner Reply and may file evidence in support of such arguments. Petitioner may also file the supplemental evidence to the extent necessary if Patent Owner files a motion to exclude. Based on the facts before us, Petitioner may introduce the evidence in the ordinary course of the proceedings without filing a separate motion to submit supplemental information and all that that entails (a Patent Owner opposition to the motion and a Petitioner reply to the motion). *See* 37 C.F.R. § 42.1(b).

We disagree with Patent Owner that the filing of such evidence in connection with Petitioner's Reply to Patent Owner's Response or to any Opposition to a Patent Owner Motion to Exclude would be prejudicial to Patent Owner. Patent Owner already has the supplemental affidavit of Gerard Grenier. Therefore, Patent Owner may cross-examine Mr. Grenier on his testimony prior to filing its Patent Owner Response. To the extent Patent Owner is of the impression that Mr. Grenier's supplemental affidavit fails to cure the objections Patent Owner made, Patent Owner may file a motion to exclude such evidence. Patent Owner, therefore, will have many opportunities to address the veracity of Mr. Grenier's testimony and will be provided due process. *See Hamilton Beach Brands, Inc. v. F'real Foods,*

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LLC, 908 F.3d 1328, 1339 (Fed. Cir. 2018) (distinguishing *SAS* because the party asserting the APA violation “had notice of the contested claim construction issues and an opportunity to be heard”).

It is

ORDERED that new DUE DATES 1 and 2 are appended to this Order and shall replace previous DUE DATES 1 and 2; and

FURTHER ORDERED that Petitioner’s request to file a motion to submit supplemental information is *dismissed* as moot.

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DUE DATE APPENDIX

DUE DATE 1 September 6, 2019

Patent Owner's response to the petition²

DUE DATE 2 November 19, 2019

Petitioner's reply to Patent Owner's response to petition

² As represented by Patent Owner, it will not file a Motion to Amend. Accordingly, DUE DATES 1 and 2 reflect Patent Owner's representation such that we have removed reference to the filing of a Motion to Amend.

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