

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MPH TECHNOLOGIES OY,  
Patent Owner.

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Case IPR2019-00819 (Patent 7,620,810 B2)  
Case IPR2019-00820 (Patent 7,937,581 B2)<sup>1</sup>

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Before KAMRAN JIVANI, JOHN D. HAMANN, and  
STACY B. MARGOLIES, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order addresses an issue pertaining to the listed cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2019-00819 (Patent 7,620,810 B2)  
IPR2019-00820 (Patent 7,937,581 B2)

On May 21, 2020, Petitioner sent an email requesting a call to seek authorization to file a motion to strike Patent Owner’s Sur-Reply, or, in the alternative, to file a Sur-Sur-Reply, in each of the proceedings. Ex. 3002.<sup>2</sup> On May 27, 2020, we held the call with Judges Jivani, Hamann, and Margolies and respective counsel for the parties. During the call, the parties presented arguments as to Petitioner’s requests, and we took the requests under advisement. A transcript of the call was filed as Exhibit 1021 (“Tr.”). For the reasons we provide below, we deny Petitioner’s requests at this time.

During the call, Petitioner argued that Patent Owner “rais[es] a brand new theory”—the parties also interchangeably refer to this issue as a “new argument”—in Section II of its Sur-Replies. Tr. 5:18–21, 7:6–8. According to Petitioner, Patent Owner “concedes that it is, in fact, a new theory.” *Id.* at 6:1–6 (citing Paper 29 (Patent Owner Sur-Reply), 5 n.1). Petitioner argued that our Trial Practice Guide provides for striking a portion of a sur-reply that clearly relies on a new theory not included in the reply. *See id.* at 5:8–17 (citing Consolidated Trial Practice Guide 80 (Nov. 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>) (“TPG”). In the alternative, Petitioner requests authorization to file Sur-Sur-Replies to address what Petitioner contends is a new argument in Patent Owner’s Sur-Replies. *Id.* at 5:3–7.

As we noted during the call, our Trial Practice Guide explains that “[i]n most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the

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<sup>2</sup> We cite only to the relevant documents in IPR2019-00819. Substantially the same documents, in relevant part, also were filed in IPR2019-00820.

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

proper scope of reply or sur-reply.” TPG, 80. In response, Petitioner argued that the circumstances here are not like most cases. Tr. 7:9–8:8, 8:13–9:20. First, Petitioner argued that “this is a brand new technical argument that [it] did not have the opportunity to respond to,” and which “cuts to the heart of” a fundamental aspect of the Petition. *Id.* at 7:20–22, 9:4–7. Second, Petitioner argued that “[P]atent [O]wner has conceded, in effect, this is an argument that[ is] a brand new argument.” *Id.* at 8:2–5. Third, Petitioner argued that being a brand new argument, it is “outside the scope of the rules.” *Id.* at 8:6–8.

Patent Owner argued that it did not admit that its Sur-Replies raise a new theory. *Id.* at 10:5–8. Patent Owner also argued that “the [B]oard is perfectly capable of determining if an argument is new or evidence is new, and assigning it the proper weight, if any.” *Id.* at 11:2–5. Patent Owner also requested that if the Board grants Petitioner’s request for Sur-Sur-Replies, that the Board also grant Patent Owner an additional brief, i.e., Sur-Sur-Sur-Replies. *Id.* at 13:14–20.

We are not persuaded that the circumstances here are different than those “in most cases, where the Board is capable of identifying new issues . . . when weighing the evidence at the close of trial, and disregarding any new issues . . . that exceeds the proper scope of . . . sur-reply.” TPG, 80. Petitioner’s arguments, listed above, are not pertinent to whether the circumstances here differ from most cases in a relevant way. For example, whether a sur-reply argument is “brand new” is the question in all such cases, and if the argument is new, it is tautological that there would have been no opportunity to respond to it. Moreover, whether an argument cuts to

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

the heart of the Petitions, as Petitioner alleges, is inapposite to the Board's capability of identifying whether the argument is new.

At this time, we determine that the issue of whether the identified portion of the Sur-Replies is of proper scope will be addressed, if necessary, in our Final Written Decisions. As such, we also deny Petitioner's alternative request for authorization to file Sur-Sur-Replies because if we identify a new argument in Patent Owner's Sur-Replies, it can be disregarded. Furthermore, although at this time we do not deem it necessary to resolve whether Patent Owner's Sur-Replies raise a new argument prior to the Final Written Decisions or via formal briefing, the parties may address the argument and whether it is new during oral argument. To the extent the panel determines that this issue warrants additional briefing, an Order will be issued, providing such instruction to the parties.

In view of the foregoing, for each of the proceedings, it is hereby ORDERED that Petitioner's request for authorization to file a Motion to Strike is *denied*; and

FURTHER ORDERED that Petitioner's request for authorization to file a Sur-Sur-Reply is *denied*.

IPR2019-00819 (Patent 7,620,810 B2)  
IPR2019-00820 (Patent 7,937,581 B2)

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