

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO HOLDING COMPANY, INC., LENOVO (UNITED STATES)
INC., AND MOTOROLA MOBILITY LLC,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2019-01278 (Patent 8,020,083 B1)
IPR2019-01279 (Patent 8,510,407 B1)¹

Before JAMES A. WORTH, AMBER L. HAGY, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

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

On August 31, 2020, we held a teleconference in the above-captioned proceedings. Judges Worth, Hagy, and Fenick participated, along with Petitioner's counsel John Alemanni and Patent Owner's counsel Perry

¹ This Order applies to each of the listed cases. The parties are not authorized to use this caption for subsequent papers.

IPR2019-01278 (Patent 8,020,083 B1)

IPR2019-01279 (Patent 8,510,407 B1)

Goldberg. A court reporter transcribed the teleconference, and Petitioner agreed to file the transcript as an exhibit in each proceeding.

Patent Owner requested authorization to file, in each proceeding, a motion to strike allegedly new evidence and argument in Petitioner's Reply relating to the prior art status of Berg². In our Institution Decision in each proceeding, we concluded "based on the indicia on the face of Berg, and in light of the additional evidence cited by Petitioner, that there is a reasonable likelihood that Berg qualifies as a printed publication." IPR2019-01278, Paper 8, 9; IPR2019-01279, Paper 7, 9 (citing, in each case, *Hulu, LLC v. Sound View Innovs., LLC*, IPR2018-01039, Paper 29 at 13, 17–18 (PTAB Dec. 20, 2019) (precedential)). Patent Owner did not address the status of Berg as a printed publication in the Patent Owner Response in either proceeding. *See generally*, IPR2019-01278, Paper 20; IPR2019-01279, Paper 18. In each proceeding, our Scheduling Order cautioned that any arguments for patentability not raised in the Patent Owner Response may be deemed waived. IPR2019-01278, Paper 9, 7; IPR2019-01279, Paper 8, 7; *see also* 37 C.F.R. § 42.23(a). Petitioner included in its Reply in each proceeding an argument that Berg properly qualifies as a printed publication. IPR2019-01278, Paper 22, 12–14; IPR2019-01279, Paper 21, 11–13. In each proceeding, Petitioner specifically noted that Patent Owner had not addressed this issue in its Patent Owner Response. IPR2019-01278, Paper 22, 12 n.4; IPR2019-01279, Paper 21, 11 n.5. Patent Owner argued during the teleconference that to address this issue in its sur-replies would require

² Berg is an article by Clifford Berg titled "How Do I Create a Signed Castanet Channel?". IPR2019-01278, Ex. 1007; IPR2019-01279, Ex. 1009; *see* IPR2019-01278, Ex. 1005; IPR2019-01279, Ex. 1005.

IPR2019-01278 (Patent 8,020,083 B1)

IPR2019-01279 (Patent 8,510,407 B1)

additional expense and time, including requiring cross-examination of Petitioner’s reply witness.

Our Trial Practice Guide describes that “[i]n most cases, the Board is capable of identifying . . . and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply,” and that therefore “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019³ (“Consolidated TPG”), 80. The Trial Practice Guide, however, also indicates that in some cases, including where “whether an issue is new or evidence is belatedly presented may be beyond dispute” and where the prejudice to a party of not striking such material is great, “the facts may merit considering a motion to strike.” *Id.* at 80–81. In light of Patent Owner’s arguments of prejudice and in view of the acknowledgement in the Petitioner’s Replies that this issue was not addressed by the Patent Owner in the Patent Owner Responses, we conclude that this may be one of the rare situations in which the remedy of striking a portion of a brief may be merited, and we grant authorization, in each proceeding, for the Patent Owner to file a motion to strike related to arguments and evidence relating to the prior art status of Berg.

Patent Owner additionally requested leave to depose Petitioner’s technical expert (Dr. Madisetti) regarding other allegedly new arguments in the Petitioner’s Replies, noting that Patent Owner wishes to have the opportunity to discover whether Petitioner’s technical expert would disagree

³ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

IPR2019-01278 (Patent 8,020,083 B1)

IPR2019-01279 (Patent 8,510,407 B1)

with these arguments. In each proceeding, Petitioner submitted a declaration from Dr. Madisetti with its Petition but did not submit a supplemental declaration from Dr. Madisetti with its Reply. IPR2019-01278, Ex. 1003; IPR2019-01279, Ex. 1003. Our Trial Practice Guide contemplates that expert depositions after a Petitioner's Reply will be cross-examinations relating to a new expert declaration submitted with a reply, and states that "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any *reply witness*." Consolidated TPG 73–74 (emphasis added) (citing *Belden Inc. v. Berk–Tek, LLC*, 805 F.3d 1064, 1081–82 (Fed. Cir. 2015)); *see also id.* at 7–8. While it did not chose to do so in either proceeding, Patent Owner could have deposed Dr. Madisetti during the time period after institution and before filing the Patent Owner's Response. *Id.* at 6–7. While Patent Owner alleges the Reply in each proceeding contains additional new arguments, Patent Owner has not chosen to request authorization for a motion to strike relating to these alleged new arguments and related evidence, but only requested authorization for a motion to strike relating to the Berg issue. Patent Owner may address the merits of any allegedly new arguments in sur-reply. *See id.* at 80. However, as Petitioner's technical expert is not a reply witness and no good cause has been adduced for allowing the requested deposition, we decline Patent Owner's request for leave to cross-examine Petitioner's technical expert in these proceedings.

Patent Owner additionally has requested authorization to submit, in and with the Patent Owner's sur-replies, new arguments and evidence directly responsive to Petitioner's Replies. The Trial Practice Guide describes the scope of a sur-reply and submissions of evidence with a sur-

IPR2019-01278 (Patent 8,020,083 B1)

IPR2019-01279 (Patent 8,510,407 B1)

reply, and should Patent Owner exceed these, we may disregard such new issues or belatedly presented evidence, and, additionally, Petitioner may file a motion to exclude per the schedule set forth in our scheduling orders or seek authorization to file a motion to strike. Consolidated TPG 79–81. Therefore we will not provide any specific authorization regarding such submissions.

While Patent Owner requested authorization to file motions to strike within a week of the Reply (*see* Consolidated TPG 81), due to technical issues on the part of the Board, this request was not addressed promptly, and any rulings in these proceedings on the motions to strike we authorize herein will likely not issue until September 8, 2020. We note that, in IPR2019-01278, the due date (DUE DATE 3) for Patent Owner to file a sur-reply is currently set by joint stipulation for September 9, 2020. IPR2019-01278, Paper 19, 2–3; IPR2019-01278, Paper 21. We additionally note that two different dates appear for DUE DATE 3 in the joint stipulation in IPR2019-01279. IPR2019-01279, Paper 19, 2 (setting DUE DATE 3 to Saturday, September 19, 2020), 3 (setting DUE DATE 3 to September 16, 2020); IPR2019-01279, Paper 20. Given the unforeseen delay and this ambiguity, we will set DUE DATE 3 in each case to September 18, 2020, and set DUE DATE 4 in each case to September 21, 2020.

It is

ORDERED that, in each proceeding, Patent Owner may file a motion to strike arguments in the Petitioner’s Reply relating to the prior art status of Berg and evidence filed in support of these arguments, by September 2, 2020, limited to three pages.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.