

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 September 25, 2020, we held a teleconference in the above-captioned proceedings. Judges Worth, Hagy, and Fenick participated, along

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

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with Petitioner's counsel John Alemanni and Patent Owner's counsel Perry Goldberg.

Petitioner requested authorization to file, in each proceeding, a motion to strike Patent Owner's Sur-Reply. Patent Owner's Sur-Reply in each proceeding references a Supplementary Declaration of Dr. Earl Sacerdoti. IPR2019-01278, Paper 28; IPR2019-01279, Paper 28. These supplementary declarations were filed, in each proceeding, contemporaneously with the filing of the Sur-Reply. IPR2019-01278, Ex. 2007; IPR2019-01279, Ex. 2007. Petitioner argued that the new evidence and references to it are impermissible, citing the Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019² ("Consolidated TPG"). The Consolidated TPG 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, 72. Patent Owner argued that the inclusion in the Sur-Reply in each proceeding of citations to the Supplementary Declaration of Dr. Earl Sacerdoti was necessary to address the Petitioner's Reply and that the statement in the Trial Practice Guide is not controlling, citing *Belden v. Berk-Tek LLC*, 805 F.3d 1064 (Fed. Cir. 2015).

In light of the parties' arguments, on the teleconference, we advised the parties that we would authorize Petitioner to file a motion to strike in each proceeding, and what the dates and page limits would be for those motions and any oppositions. This Order confirms that authorization.

² Available at

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

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It is

ORDERED that, in each proceeding, Patent Owner may file a motion to strike Patent Owner's sur-reply, by October 1, 2020, limited to four pages; and

FURTHER ORDERED that, in each proceeding, Petitioner may file an opposition to Patent Owner's motion to strike, by October 7, 2020, limited to four pages.

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