

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

HAMMOND DEVELOPMENT INTERNATIONAL, INC.,
Patent Owner.

IPR2020-00020 (Patent 9,264,483), IPR2020-00080 (Patent 10,264,032),
IPR2020-00081 (Patent 10,270,816), IPR2020-00214 (Patent 9,716,732),
IPR2020-00298 (Patent 9,456,040), IPR2020-00305 (Patent 9,716,732),
IPR2020-00306 (Patent 10,193,935), IPR2020-00411 (Patent 9,420,011),
IPR2020-00412 (Patent 9,456,040), IPR2020-00413 (Patent 10,193,935),
IPR2020-00414 (Patent 9,705,937), IPR2020-00415 (Patent 9,705,937)¹

Before BRIAN J. McNAMARA, MICHELLE N. WORMMEESTER,
AMBER L. HAGY, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

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

¹ We exercise our discretion to issue one order to be entered in each case. The parties are not authorized to use a caption identifying multiple cases. This is not an expanded panel. The panel for IPR2020-00020 and IPR2020-00080 includes Judges McNamara, Wormmeester, and Hagy. The panel for the other proceedings includes Judges Wormmeester, Hagy, and Sawert.

On June 11, 2020, a conference call was conducted among respective counsel for the parties, and Judges McNamara, Wormmeester, Hagy, and Sawert. A copy of the transcript has been entered into the record. *See* IPR2020-00020, Ex. 1020.² During the call, the parties discussed the request by Petitioner Google LLC (“Petitioner”) to submit, in each of the captioned matters, a substitute expert declaration to replace the declaration of Petitioner’s expert witness, Dr. Leonard Forys, which request was opposed by Patent Owner Hammond Development Int’l (“Patent Owner”). *Id.* Counsel for Petitioner stated that, for reasons unrelated to Dr. Forys’ work in these matters, Dr. Forys can no longer serve as an expert witness for Google. *Id.* Counsel for Patent Owner stated that Patent Owner opposed this request on the basis that Petitioner had not provided sufficient explanation as to the reason underlying Petitioner’s determination. *Id.*

Subsequent to the call, on June 19, 2020, the Board issued an Order stating that Petitioner’s requested relief would be granted, conditioned on Petitioner’s counsel filing a certification as outlined in the Order, and subject to objections, if any, filed by Patent Owner after receipt of the certification. Paper 12, 3 (“June 19th Order”). Petitioner filed the required certification on June 23, 2020 (Paper 13), and the deadline for Patent Owner’s objections passed without submission.

On July 1, 2020, after the deadline for Patent Owner’s objections, counsel for Petitioner advised the Board in an email that “[t]he parties have met and conferred regarding procedures for filing the substitute declarations,” and “propose the following procedure”:

² Citations to the record herein are to the record in IPR2020-00020. Similar papers have been filed in the other captioned cases.

- Petitioner will file substitute declarations for its substitute expert that are identical to its previous expert's declaration (Ex-1003 in each proceeding), with the following revisions:
 - The substitute declarations will delete the qualifications section of Petitioner's previous expert, but provide blank paragraph numbering to preserve the original paragraph numbering of the substantive portions of the declarations;
 - A new qualifications section will be added at the end of the declarations with additional numbered paragraphs to reflect the qualifications of the substitute expert; and
 - The substitute declarations will be signed by Petitioner's substitute expert.
- The parties ask that the Board consider references in the Petitions and other filed documents to the original expert declarations (Ex-1003 in each proceeding) to refer to the substitute declarations (to be Ex-1021 in each proceeding).
- Petitioner will file the substitute declarations with updated Exhibit Lists promptly for all currently-instituted proceedings, and shall work diligently to file substitute declarations in proceedings in which a decision to institute has not yet been made.

Ex. 3001.

Counsel for Petitioner also advised that the parties "have further met and conferred regarding schedule adjustments and expect to file adjusted schedules to accommodate the substitution of experts." *Id.*

In view of the fact that Petitioner has timely filed the certification as required in the June 19th Order and Patent Owner has not objected, the panels hereby grant Petitioner's requested relief, according to the terms and procedures as set forth above, which Petitioner represents have been agreed to by the parties.

Although Petitioner has not stated a date certain by which it will have filed all of the substitute declarations, the Board expects that all such substitute declarations will be filed no later than July 31, 2020. Petitioner should advise the Board promptly if this date is unworkable or otherwise contrary to the parties' agreement. This deadline is not intended to extend any earlier deadline that may have been agreed to by the parties.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file substitute expert declarations in each of the captioned cases is granted;

FURTHER ORDERED that Petitioner shall file the substitute expert declarations in each of the captioned proceedings no later than July 31, 2020;

FURTHER ORDERED that, in filing the substitute expert declarations, Petitioner shall file substitute declarations for its substitute expert that are identical to its previous expert's declaration (Ex. 1003 in each proceeding), with the following revisions: (1) the substitute declarations will delete the qualifications section of Petitioner's previous expert, but provide blank paragraph numbering to preserve the original paragraph numbering of the substantive portions of the declarations; (2) a new qualifications section will be added at the end of the declarations with additional numbered paragraphs to reflect the qualifications of the substitute expert; and (3) the substitute declarations will be signed by Petitioner's substitute expert.

FURTHER ORDERED that the Board will consider references in the Petitions and other filed documents to the original expert declarations (Ex. 1003 in each proceeding) to refer to the substitute declarations (to be Ex. 1021 in each proceeding).

FOR PETITIONER:

Erika H. Arner
Kevin D. Rodkey
John M. Mulcahy
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP
erika.arner@finnegan.com
kevin.rodkey@finnegan.com
john.mulcahy@finnegan.com

FOR PATENT OWNER:

Andrew J. Wright
Joseph P. Oldaker
Matthew C. Juren
NELSON BUMGARDNER ALBRITTON P.C.
andrew@nbafirm.com
joseph@nbafirm.com
matthew@nbafirm.com
DG-Hammond-IPR@nbafirm.com