

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

IPR2020-01139 (Patent 8,382,186 B2)
IPR2020-01142 (Patent 8,833,834 B2)¹

Before MITCHELL G. WEATHERLY, JAMES A. WORTH,
MICHAEL L. WOODS, and ARTHUR M. PESLAK,
Administrative Patent Judges.

PESLAK, *Administrative Patent Judge.*

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

¹ This Order applies to both proceedings. The parties are not authorized to use this caption.

IPR2020-01139 (Patent 8,382,186 B2)

IPR2020-01142 (Patent 8,833,834 B2)

A conference call was held on September 13, 2021, between Judges Peslak, Weatherly, Woods, and Worth and counsel for the parties to discuss Patent Owner's email to the Board dated September 9, 2021. Ex. 3001. In that email, Patent Owner requested authorization to:

- 1) File the Second Supplemental Declaration of Mr. Ray Sherman, the Second Supplemental Declaration of Dr. Tim A. Osswald, and Stipulations attached to the email;
- 2) File new evidence with its Sur-reply in each referenced case including new expert testimony; and
- 3) File a Motion to Strike portions of Petitioner's Reply in each case and the Declarations of Dr. Paul Koch (Ex. 1041), Mr. Mark Strachan (Ex. 1042), and Mr. Dan Perreault (Ex. 1044).²

Ex. 3001. Patent Owner represented in its email that the parties met and conferred and were unable to reach agreement on items 2 and 3. *Id.* Patent Owner further represented that Petitioner did not oppose the request in item 1.

During the telephone conference, Patent Owner made two additional requests. First, Patent Owner sought authorization to file certain documents introduced during the cross-examination depositions of Petitioner's declarants as exhibits. Second, Patent Owner sought authorization to file errata sheets executed by Patent Owner's witnesses after review of their deposition testimony. Petitioner did not object to the first request but objected to the filing of the errata sheets.

² We refer to the papers and exhibits filed in IPR2020-01139. We understand that similar documents were filed in IPR2020-01142.

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After considering the arguments of counsel, it is hereby:

ORDERED that Patent Owner's request to file the Second Supplemental Declaration of Ray Sherman, the Second Supplemental Declaration of Tim A. Osswald, and the Stipulations attached to the email of September 9, 2021, is *granted*;

FURTHER ORDERED that Patent Owner's request to file new evidence including expert testimony with its Sur-reply is *denied*;

FURTHER ORDERED that Patent Owner's request to file a Motion to Strike is *granted*;

FURTHER ORDERED that Patent Owner may file the Motion to Strike, limited to 15 pages, no later than September 22, 2021;

FURTHER ORDERED that Petitioner may file an Opposition to the Motion to Strike, limited to 15 pages, no later than September 29, 2021;

FURTHER ORDERED that Patent Owner may file a Reply to Petitioner's Opposition, limited to 10 pages, no later than October 6, 2021;

FURTHER ORDERED that no further briefing is authorized;

FURTHER ORDERED that Patent Owner is authorized to file the exhibits introduced during the cross-examination of Petitioner's witnesses as exhibits enumerated in the 2000 series; and

FURTHER ORDERED that the parties are directed to meet and confer with respect to the deposition errata sheets and make a good faith attempt to resolve the question of whether the errata sheets should be filed pursuant to the Board's rules and practices.

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For PETITIONER:

Mark Walters

LOWE GRAHAM JONES PLLC

walters@lowegrahamjones.com

Ralph Powers

Jason Fitzsimmons

Stephen Merrill

STERNE KESSLER GOLDSTEIN & FOX PLLC

tpowers-ptab@sternekessler.com

jfitzsimmons-ptab@sternekessler.com

smerrill-ptab@sternekessler.com

For PATENT OWNER:

Jefferson Perkins

PERKINS IP LAW GROUP LLC

jperkins@perkinsip.com

David Wille

Chad Walters

Clarke Stavinhoa

BAKER BOTTS LLP

David.wille@bakerbotts.com

chad.walters@bakerbotts.com

Clarke.stavinhoa@bakerbotts.com