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IPR2013-00194, Paper No. 33
IPR2013-00195, Paper No. 27
CBM2013-00013, Paper No.34
Date Entered: February 3, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner

v.

PI-NET INTERNATIONAL, INC.
Patent Owner

Case No. IPR2013-00194

Patent 8,108,492 B2

Case No. IPR2013-00195

Patent 5,987,500

Case No. CBM2013-00013

Patent 8,037,158 B2

Before KARL D. EASTHOM, JONI Y. CHANG, and
BRIAN J. McNAMARA, Administrative Patent Judges.

McNAMARA, *Administrative Patent Judge.*

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

On January 31, 2014, the Board conducted a teleconference with the parties to consider a request by SAP America, Inc. (“Petitioner”) for authorization to file a motion to strike Exhibit C of a Motion to Amend filed by Pi-Net International, Inc. (“Patent Owner”) in IPR2013-00194 (Paper 31) and in IPR2013-00195 (Paper 26) (collectively, “Motions To Amend”), as improperly circumventing the 18 pages¹ allocated to Patent Owner for the motions. Petitioner also sought authorization to file a motion to strike the declarations of litigation experts Bardash and Easttom in Patent Owner’s Response and/or Motions to Amend as lacking relevance. Petitioner also requested the conference to discuss Patent Owner’s confusing labeling of exhibits. Finally, Petitioner asked to discuss references in the Motions To Amend and, in the corresponding Patent Owner’s Response, to exhibits that Patent Owner did not upload through PRPS, including exhibits designated R25, R43, R44, R46 and R52.²

During the conference, it quickly became clear that the incorrect labeling of Patent Owner’s exhibits limited the scope of substantive conversations that could be conducted. The incorrect exhibit labeling occurred in IPR2013-00194, IPR2013-00195 and CBM2013-00013. The Board authorized Patent Owner to file correctly designated exhibits and corrected papers referencing those exhibits in all three proceedings within 5 calendar days from January 31, 2014, i.e., by February 5, 2014. No substantive changes are authorized.

¹ On January 17, the Board authorized Patent Owner to exceed the 15 page limit imposed under 37 C.F.R. § 42.24(a)(1)(v), permitting up to 18 pages in each case. IPR2013-00194, Paper 30; IPR2013-00195, Paper 23.

² We note that these exhibit designations would not be proper exhibit numbers for Patent Owner in this proceeding.

Cases IPR2013-00194; IPR2013-00195; CBM2013-00013
Patents 8,108,492 B2; 5,987,500; 8,037,158 B2

The Motions To Amend filed by Patent Owner exceed the authorized page limit. In addition, they include Exhibit C. Exhibit C is a lengthy chart which purports to identify the support in the specification for the proposed amendment. Exhibit C in the IPR2013-00194 Motion To Amend is 91 pages. Exhibit C in the IPR2013-00195 Motion To Amend is 62 pages. The Board advised the parties that Exhibit C in each case is improper. As we advised Patent Owner in the conference prior to filing, the body of the Motion To Amend must set forth the support in the original disclosure for the amended claim. Merely designating in a table where each claim limitation is described in the original disclosure may be insufficient to demonstrate support of the claimed subject matter as a whole. IPR2013-00194, Paper 27, IPR2013-00195, Paper 20. During the teleconference on January 31, 2014, Patent Owner offered to correct the Motions To Amend to address the page limit issues. Petitioner opposed, arguing that it already had agreed to several extensions of the due date for filing of the Patent Owner Response and the Motion To Amend.

The Board noted that the record is such that it cannot properly evaluate Patent Owner's pleadings, but is also cognizant that further delays could prejudice Petitioner. Therefore, the Board authorized Patent Owner to file a corrected Motion To Amend in IPR2013-00194 and IPR2013-00195 within 5 calendar days of January 31, 2014 teleconference. Petitioner is not authorized to file a motion to strike. The Board will evaluate the Motions To Amend and decide whether they comply with the rules.

During the conference, Petitioner also raised its objections to the Bardash and Easttom declarations. Petitioner argues that these declarations are irrelevant because they are taken from the district court litigation, where the applicable standards differ from those applied by the Board. Patent Owner offered to

Cases IPR2013-00194; IPR2013-00195; CBM2013-00013
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withdraw the declarations and substitute another declaration concerning the level of skill in the art. Patent Owner suggested that the parties discuss an acceptable compromise outside the conference. Patent Owner is reminded that no substantive changes are permitted to the Motion To Amend.

Petitioner is not authorized to file a motion to strike the Bardash and Easttom declarations. However, Petitioner may consider filing a motion to exclude the evidence at an appropriate time.

Finally, there was disagreement during the conference about whether exhibits had been mentioned in Patent Owner's pleadings and not uploaded or whether any exhibits actually relied upon by the Patent Owner were not uploaded. The Patent Owner must upload as exhibits all documents cited in its papers and must correct all uploading errors within 5 calendar days of the January 31, 2014 teleconference.

Patent Owner is advised that any document which fails to comply with the Board's rules will be expunged.

It is ORDERED that Patent Owner shall file correctly designated exhibits and corrected papers referencing those exhibits in IPR2013-00194, IPR2013-00195, and CBM2013-00013 not later than February 5, 2014. No substantive change to any paper is authorized and Patent Owner must represent that no substantive changes have been made;

it is FURTHER ORDERED that Patent Owner file a corrected Motion To Amend not to exceed 18 pages in IPR2013-00194 and IPR2013-00195 not later than February 5, 2014. No substantive changes to the Motions To Amend are authorized and Patent Owner must represent that no substantive changes have been made;

Cases IPR2013-00194; IPR2013-00195; CBM2013-00013
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it is FURTHER ORDERED that Patent Owner upload all references cited in any pleading not later than February 5, 2014;

it is FURTHER ORDERED that any paper filed by Patent Order that is not in compliance with the Board's rules and procedures will be expunged;

it is FURTHER ORDERED that Petitioner is not authorized to file any motion to strike.

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