

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON, INC.
Petitioner

v.

BLUE CALYPSO, LLC
Patent Owner

Cases CBM2013-00033 (Patent 8,155,679)
CBM2013-00034 (Patent 8,457,670)
CBM2013-00035 (Patent 7,664,516)
CBM2013-00044 (Patent 8,452,646)
CBM2013-00046 (Patent 8,438,055)¹

Before JONI Y. CHANG, MICHAEL W. KIM, and BARBARA A. BENOIT,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

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

¹ This Order addresses issues that are identical in all five cases. Therefore, we issue one order to be filed in each of the cases. The parties, however, are not authorized to use this style heading in any subsequent papers.

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On May 8, 2014, a telephone conference call was held between respective counsel for the parties, and Judges Chang, Kim, and Benoit for the above-identified proceedings.² Petitioner initiated the call to discuss whether Patent Owner waived the argument—Ratsimor³ is not a “printed publication”—as Patent Owner did not serve an objection to evidence under 37 C.F.R. § 42.64(b), concerning Ratsimor’s publication date.

During the conference call, Petitioner also requested three additional pages for its Reply. Patent Owner sought leave to file a motion to submit supplemental information. We address each of the parties’ issues in turn.

1. The differences between admissibility of evidence and sufficiency of evidence

Petitioner argued that, because Patent Owner failed to serve an objection to evidence under 37 C.F.R. § 42.64(b) for Petitioner’s expert declaration regarding Ratsimor’s publication date (Ex. 1008 ¶ 2), Patent Owner waived the argument that Ratsimor is not a “printed publication” under 35 U.S.C. § 102(b). According to Petitioner, Patent Owner’s failure to serve an objection to evidence deprived Petitioner the opportunity to provide supplemental evidence.

Patent Owner disagreed with Petitioner’s contention, arguing that an objection under 37 C.F.R. § 42.64(b)(1) is related to the *admissibility* of evidence

² For the purpose of clarity and expediency, we treat CBM2013-00033 as representative, and all citations are to CBM2013-00033 unless otherwise noted.

³ Ratsimor, Olga, et al., Technical Report TR-CS-03-27 “Intelligent Ad Hoc Marketing Within Hotspot Networks,” published November 2003 (Ex. 1006). Petitioner relies upon Ratsimor for at least one of the instituted grounds of unpatentability. Paper 10, 40.

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(e.g., authenticity or hearsay), which is not a requirement for challenging the *sufficiency* of the evidence to prove a particular fact (e.g., the weight of the evidence). According to Patent Owner, its argument—Petitioner fails to provide *sufficient* evidence to establish that Ratsimor is a “printed publication”—is related to the *sufficiency* of the evidence, and, therefore, such an argument is submitted appropriately in a patent owner response.

As support, Patent Owner directed our attention to the discussion in *Bloomberg Inc. v. Markets-Alert Pty Ltd.*:

As explained by the Board, parties may raise issues related to admissibility of evidence (e.g., authenticity or hearsay) in a motion to exclude. *See* 37 C.F.R. §§ 42.64 and 42.62. In contrast, issues related to credibility and the weight of the evidence should be raised in responses and replies. Further, a motion to exclude may not be used to challenge the sufficiency of the evidence to prove a particular fact, or to present arguments that should have been presented in responses or replies. For instance, arguments related to the issue of whether a U.S. patent or U.S. application publication is prior art under 35 U.S.C. § 102(e) against a substituted claim should be presented in a reply rather than in a motion to exclude.

CBM2013-00005, slip op. at 5, (PTAB Nov. 15, 2013) (Paper 56).

Patent Owner further informed the Board that Patent Owner is *not* challenging the *admissibility* of Petition’s expert testimony (Ex. 1008 ¶ 2). Nor will Patent Owner file a motion to exclude that evidence.

We agree with Patent Owner that an objection to evidence under 37 C.F.R. § 42.64 is not necessary to preserve its right to challenge the *sufficiency* of evidence in a patent owner response. In fact, such an objection would not have been proper if there is no basis for challenging the *admissibility* of evidence.

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We are not persuaded by Petitioner's contention that Patent Owner waived the argument that Ratsimor is not a "printed publication," unless Patent Owner has served an objection to evidence under 37 C.F.R. § 42.64(b), concerning Ratsimor's publication date. Petitioner is confusing two separate and distinct challenges:

(1) the *admissibility* of evidence (e.g., authenticity or hearsay), which requires the opposing party to serve an objection to evidence under 37 C.F.R. § 42.64(b), in order to preserve the right to file a motion to exclude evidence; and (2) the *sufficiency* of evidence to prove a particular fact (e.g., whether the evidence is *sufficient* to demonstrate, by a preponderance of evidence, that a reference is a "printed publication" under 35 U.S.C. § 102(b)). As Patent Owner indicated during the conference call, it is not challenging the *admissibility* of evidence (e.g., authenticity or hearsay).

To support its position, Petitioner directed our attention to the decisions entered in *LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, slip op. 4 (PTAB Mar. 5, 2013) (Paper 17), and *Motorola Solutions, Inc. v. Mobile Scanning Tech., LLC*, IPR2013-00093, slip op. 2 (PTAB July 16, 2013) (Paper 39). However, neither case relates to waiver of argument. In fact, both cases are related to the *admissibility* of evidence (e.g., authenticity or hearsay), rather than, as here, the *sufficiency* of evidence. In *LKQ*, the decision dismissed the patent owner's motion to exclude evidence, where patent owner alleged that the evidence was *unauthenticated* and *inadmissible hearsay*. *LKQ*, slip op. at 4. The main issue in that decision is that patent owner's motion to exclude was filed *prematurely* in a patent owner preliminary response, and, as noted in the decision, patent owner should have followed the procedure under 37 C.F.R. § 42.64 for objecting to the

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admissibility of the evidence. *Id.* In *Motorola Solutions*, the decision granted the petitioner’s request to file supplemental evidence in response to patent owner’s contention made also in a patent owner preliminary response, that the documents had not been *authenticated*. *Motorola Solutions*, slip op. at 2. Therefore, those cases cited by Petitioner do not support Petitioner’s position that Patent Owner’s argument for the *sufficiency* of evidence is waived and cannot be presented in a patent owner response, unless an objection to evidence under 37 C.F.R. § 42.64 has been served.

We also are not persuaded by Petitioner’s argument that Patent Owner’s action—merely challenging the *sufficiency* of evidence, rather than challenging both the *admissibility* and *sufficiency* of evidence—prejudice Petitioner. As we explained during the conference call, Petitioner may file a Reply with supporting evidence responding to Patent Owner’s argument.

For the foregoing reasons, we determine that Patent Owner did not waive its argument that Ratsimor is not a “printed publication” under 35 U.S.C. § 102(b).

2. *Three additional pages for Petitioner’s Reply*

Petitioner requested three additional pages for its Reply should the Board determine that Patent Owner did not waive the “printed publication” argument. Patent Owner opposed Petitioner’s request, arguing that Petitioner, as the moving party, has the burden of proof to establish that the challenged claims are unpatentable. According to Patent Owner, Petitioner should have submitted sufficient showing, in its Petition, to establish that Ratsimor is a “printed publication.” In response, Petitioner noted that the Board, in the Decision on

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