

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALGREEN CO., AHOLD USA, INC., DELHAIZE AMERICA, LLC,
AND PUBLIX SUPER MARKETS, INC.,
Petitioner,

v.

ADVANCED MARKETING SYSTEMS, LLC,
Patent Owner.

Cases CBM2016-00012
CBM2016-00013
CBM2016-00014
CBM2016-00015
Patents 8,219,445 B2
8,370,199 B2
8,538,805 B2

Before THOMAS L. GIANNETTI, TREVOR M. JEFFERSON, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER
Expunging Documents
37 C.F.R. § 42.5

CBM2016-00012, -00013, -00014, and -00015
Patent 8,219,445 B2; 8,370,199 B2; and 8,538,805 B2

On September 27, 2016, Patent Owner requested a conference call to “seek guidance” on whether the following papers were properly filed:

1. Petitioner’s Objections to Patent Owner’s Evidence, Paper 24;¹
2. Updated Patent Owner’s Response to Petition Pursuant to 37 C.F.R. § 42.220, Paper 25;²
3. Patent Owner’s Response to Petitioner’s Objections to Patent Owner’s Evidence, Paper 26;³ and
4. Declaration of Steven R. Kursh, Ph.D., CSDP, CLP in Support to Patent Owner’s Response to Covered Business Method Review of U.S. Patent No. 8,219,445; 8,538,805; and 8,370,199, Exhibit 2024.⁴

On September 28, 2016, we informed the parties via e-mail that they should not use e-mail communications with the Board to “seek guidance” on the meaning of the Rules governing these proceedings. We also informed the parties that we would issue an order in due course dealing with the Papers and Exhibit identified above.

Paper 24 constitutes Petitioner’s objections to evidence submitted by Patent Owner with its Patent Owner Response. Petitioner properly filed Paper 24 pursuant to 37 C.F.R. § 42.64(b)(1), and that paper shall, therefore,

¹ Petitioner filed a similar paper enumerated as Paper 23 in CBM2016-00013 through -00015.

² Patent Owner filed a similar paper enumerated as Paper 24 in CBM2016-00013 through -00015.

³ Patent Owner filed a similar paper enumerated as Paper 25 in CBM2016-00013 through -00015.

⁴ Patent Owner filed a similar declaration, also enumerated as Exhibit 2024 in CBM2016-00013 through -00015.

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remain in the record. Rule 42.64(b)(2) specifies that Patent Owner “may respond to the objection by serving supplemental evidence within ten business days of service of the objection.”

Presumably, Patent Owner prepared Paper Nos. 25 and 26 and Exhibit 2024 as its response to Petitioner’s evidentiary objections. Our Rules neither require nor contemplate that such a response should be filed with the Board. Service of such a response is the only act authorized under the Rules; filing of the response was not authorized. Nevertheless, Patent Owner filed Paper Nos. 25 and 26 and Exhibit 2024 without authorization. Because Paper Nos. 25 and 26 and Exhibit 2024 were filed without authorization, we expunge them from the record.

Patent Owner also inquired “whether filing a document utilizing the PTAB E2E system is considered service to the other party or if separate service is required.” We refer Patent Owner to 37 C.F.R. § 42.6(e) for the answer to its inquiry, which sets forth the procedures for “[s]ervice” of papers in these proceedings. To the extent that Patent Owner has not properly served Paper Nos. 25 and 26 and Exhibit 2024 under Rule 42.6(e), we expect counsel to resolve any such issues surrounding service of those documents amicably and without further guidance from the Board.

Accordingly, it is:

ORDERED that Paper Nos. 25 and 26 and Exhibit 2024 are *expunged* from the record in CBM2016-00012; and

FURTHER ORDERED that Paper Nos. 24 and 25 and Exhibit 2024 are *expunged* from the record in CBM2016-00013 through -00015.

CBM2016-00012, -00013, -00014, and -00015
Patent 8,219,445 B2; 8,370,199 B2; and 8,538,805 B2

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