

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

I. INTRODUCTION

On December 21, 2016, pursuant to Patent Owner's request, we conducted a telephone conference to determine whether to authorize Patent Owner (1) to file a surreply in response to Petitioner's Reply, Paper 32¹ ("the Reply"), and (2) to move to strike the Declaration of Dr. Michael Lewis, Ex. 1009² ("the Lewis Declaration"). Attorneys for both parties and Judges Giannetti, Jefferson, and Weatherly attended the conference.

A. REQUEST TO FILE A SURREPLY

Patent Owner requests authorization to file a surreply in response to arguments raised in Petitioner's Reply. Patent Owner was asked to identify arguments in the Reply that Patent Owner believed to be new and nonresponsive to arguments raised in Patent Owner's Response, Paper 23³ ("the PO Resp."). Patent Owner identified none.

Nevertheless, Patent Owner contends that a surreply is warranted to address Petitioner's arguments relating to claim interpretation based upon portions of the file history of the patents-at-issue. In response, Petitioner contends that its arguments were responsive to positions on claim interpretation that Patent Owner advanced in the Patent Owner Response. We agree. Moreover, because the prosecution history is evidence that existed prior to the institution of these proceedings, both parties have had ample opportunity in the papers already filed to rely upon such evidence to support their respective positions.

¹ Paper 31 in each of CBM2016-00013, -00014, and -00015.

² Exhibit 1008 in CBM2016-00013.

³ Paper 22 in each of CBM2016-00013, -00014, and -00015.

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Patent Owner also contends that a surreply will allow it to introduce evidence relating to the parties' positions on claim interpretation that were advanced in the related district court proceedings. Both parties agree that such evidence existed before Patent Owner filed its Patent Owner Response. Accordingly, such evidence could have been raised by either party in connection with their respective filings of the Patent Owner Response or the Reply. If Patent Owner had wished to proffer such evidence, it could have done so in connection with its Patent Owner Response, and Petitioner would have had an opportunity to respond in its Reply.

In its e-mail to the Board of December 14, 2016, Patent Owner also identified other reasons that it contends justify its need for a surreply. Those reasons include contentions that Petitioner "distorts" facts or testimony and "inaccurately asserts lack of written description." We are not persuaded that any of these reasons warrant the filing of a surreply. Distortions and inaccuracies in the parties' respective positions are discernable from the evidence and argument already of record.

A surreply is not a vehicle for Patent Owner simply to have the last word. Based upon our consideration of the arguments presented during the conference call and the record of the proceedings to date, we are unpersuaded that a surreply is justified and do not authorize Patent Owner to file such a surreply.

**B. REQUEST FOR AUTHORIZATION TO MOVE TO STRIKE THE LEWIS
DECLARATION**

Patent Owner seeks authorization to move to strike the Lewis Declaration in its entirety, based upon the principles set forth in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). We informed Patent Owner that a motion to strike the Lewis Declaration is not the

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appropriate vehicle for seeking such relief. Rather, such relief may be given, if at all, in response to a motion to exclude evidence filed pursuant to the procedures set forth in 37 C.F.R. § 42.64, the filing of which does not require prior authorization from the Board. We also reminded Patent Owner that, for the Board to consider the merits of a motion to exclude the Lewis Declaration, the motion must meet the procedural requirements set forth in 37 C.F.R. § 42.64(b), (c). Accordingly, we deny Patent Owner's request for authorization to move to strike the Lewis Declaration.

II. ORDER

For the reasons expressed above, it is:

ORDERED that Patent Owner's request for authorization to file a surreply is *denied*; and

FURTHER ORDERED that Patent Owner's request for authorization to move to strike the Lewis Declaration is *denied*.

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PETITIONER:

Joseph E. Palys
Naveen Modi
Phillip Citroën
PAUL HASTINGS LLP
AMS-Walgreens-PH@paulhasting.com

Holly Hawkins Saporito
Joshua Weeks
ALSTON & BIRD LLP
holly.saporito@alston.com
joshua.weeks@alston.com

PATENT OWNER:

Michael A. Messina
Ajay A. Jagtiani
Mae Hong
MILES & STOCKBRIDGE P.C.
Messina-PTAB@milesstockbridge.com
ajagtiani@milesstockbridge.com
mhong@milesstockbridge.com