

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.  
Petitioner

v.

ACHATES REFERENCE PUBLISHING, INC.  
Patent Owner

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Case IPR2013-00080 (Patent 6,173,403)  
Case IPR2013-00081 (Patent 5,982,889)<sup>1</sup>

Before HOWARD B. BLANKENSHIP, JUSTIN T. ARBES, and  
GREGG I. ANDERSON, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

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<sup>1</sup> This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. Other than the motion papers expressly authorized herein, the parties are not authorized to use this style heading for any subsequent papers.

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A conference call in the above proceedings was held on February 11, 2014 between respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Arbes, and Anderson. The following issues were discussed.

*Emails Produced as Additional Discovery*

The Board previously granted Petitioner’s motion for additional discovery of certain email communications exchanged directly between Patent Owner’s two declarants, Mr. Dmitry Radbel and Dr. Xin Wang. The Board stated in the decision that “[i]f, after receiving the email communications, Petitioner believes that additional action is necessary, it may request a conference call with the Board.” *See* IPR2013-00080, Paper 66 at 9; IPR2013-00081, Paper 58 at 9.

Petitioner argued during the call that a small number of the emails produced by Patent Owner are relevant to the credibility of Mr. Radbel and Dr. Wang and, therefore, impact the weight the Board should give to their testimony. For example, according to Petitioner, the witnesses made statements in the emails regarding the asserted prior art that are inconsistent with opinions they later expressed in their declarations. Petitioner sought authorization to file the allegedly relevant emails as exhibits and to file observations regarding the emails, using the same procedures the Board follows for observations on cross-examination of a witness. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767-68 (Aug. 14, 2012) (“Trial Practice Guide”). Patent Owner opposed Petitioner’s request, arguing that observations are limited to cross-examination testimony, the emails would be improper supplemental information, and the emails are not

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relevant because the witnesses' opinions are expressed solely in their declarations. Patent Owner also argued that the emails are privileged and contain confidential information such that, if they are entered into the record of these proceedings, the emails should be filed under seal. The Board took the matter under advisement.

Under the circumstances and timing of these proceedings, we are persuaded that the emails at issue should be brought to the Board's attention so that the Board may consider them in assessing the testimony of Mr. Radbel and Dr. Wang, and that observations are the appropriate mechanism to do so. *See* 37 C.F.R. §§ 42.5(a), 42.20(d). The emails were not available when Mr. Radbel and Dr. Wang were cross-examined. As a result, Petitioner did not have an opportunity to question the witnesses about the emails and address them substantively in Petitioner's replies. This is similar to the normal situation when the Board permits observations—namely, when “cross-examination occurs after a party has filed its last substantive paper on an issue” and the cross-examination results in “testimony that should be called to the Board's attention.” *See* Trial Practice Guide, 77 Fed. Reg. at 48,767-68. Thus, we conclude that observations regarding the emails are appropriate.

Petitioner is authorized to file the limited number of emails discussed during the call and to file a motion for observation on those emails, and Patent Owner is authorized to file a response. As with observations on cross-examination, any observation must be a concise statement of the relevance of a precisely identified statement to a precisely identified argument or portion of an exhibit, and any response must be equally concise and specific. An observation (or response to an observation) is not an

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opportunity to raise new issues, re-argue issues, or pursue objections. Each observation should be in the following form:

In Exhibit \_\_\_, on page \_\_\_, lines \_\_\_, the witness said \_\_\_.  
This statement is relevant to the \_\_\_ on page \_\_\_ of \_\_\_. The  
testimony is relevant because \_\_\_.

The entire observation should not exceed one short paragraph. The Board may decline consideration or entry of excessively long or argumentative observations (or responses to observations).

As to Patent Owner’s request that the emails be filed under seal, Patent Owner has not explained sufficiently why the emails are privileged or why one party’s belief that a document (already produced) is privileged is a proper basis for sealing the document. *See* IPR2013-00080, Paper 57 at 2 n.1, Paper 66 at 8; IPR2013-00081, Paper 48 at 2 n.1, Paper 58 at 8. However, to the extent Patent Owner believes the emails contain “confidential information” and there is good cause for maintaining them under seal, Patent Owner is authorized to file a motion to seal. *See* 35 U.S.C. § 316(a)(7); 37 C.F.R. §§ 42.14, 42.54(a). The emails themselves, as well as Petitioner’s motion for observation and Patent Owner’s response citing the emails, will be provisionally sealed pending disposition of Patent Owner’s motion to seal. The parties are directed to the following guidance in the Trial Practice Guide, 77 Fed. Reg. at 48,760, regarding the scope of “confidential information” subject to a motion to seal:

The rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.

...

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*Confidential information:* The rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure 26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information. § 42.54.

The parties also are advised that any motion to seal must be filed with a proposed protective order. 37 C.F.R. § 42.54(a).

### *Conduct of the Hearing*

The Board previously entered an Order stating the procedure for the February 26, 2014 hearing in the instant proceedings. *See* IPR2013-00080, Paper 67; IPR2013-00081, Paper 59. The Order provides for sequential arguments, with arguments completed in Case IPR2013-00080 before those in Case IPR2013-00081. During the call, Patent Owner requested that a short break be held between arguments for the two cases. A short break will be permitted. Also, Petitioner requested that the parties argue the two cases together rather than in sequence. Patent Owner opposed the request. We are not persuaded that arguing the two cases together would be more efficient or otherwise preferable to arguing the two cases in sequence. Therefore, the procedure outlined in the Order will not be changed.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file, by February 17, 2014, a motion for observation on emails between Mr. Radbel and Dr. Wang produced by Patent Owner in these proceedings, limited to five pages;

FURTHER ORDERED that Petitioner is authorized to file, as exhibits in each of the instant proceedings, by February 17, 2014, copies of the emails that Petitioner references in its motion for observation;

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