

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

ACHATES REFERENCE PUBLISHING, INC.
Patent Owner

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

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

¹ This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. 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 24, 2014 between respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Arbes, and Anderson.² The call was requested by Patent Owner to seek authorization to file (1) a motion to re-file certain errata sheets, and (2) a motion for additional discovery. After hearing from the parties during the call, the Board took both matters under advisement.

Errata Sheets

Patent Owner previously filed improper errata sheets for the depositions of its two declarants, Mr. Dmitry Radbel and Dr. Xin Wang (Exhibits 2033 and 2036 in each proceeding). The Board expunged the errata sheets because Patent Owner did not obtain prior authorization for filing them and because the errata sheets made substantive changes that materially altered the witnesses' testimony. *See* IPR2013-00080, Paper 61; IPR2013-00081, Paper 52. During the call, Patent Owner sought authorization to file a motion to re-file the expunged errata sheets. Patent Owner argued that the Board should exercise its discretion with respect to management of the record under 37 C.F.R. § 42.7(a) and permit the errata sheets to be entered "for the limited purpose of preserving the record for appeal" (i.e., challenging the Board's application of its rules in expunging the errata sheets). Patent Owner stated that it was not requesting that the Board consider the errata sheets in rendering a final written decision in each proceeding; rather, the errata sheets would only exist in the record for purposes of appeal.

² A court reporter was present on the call. The parties shall file the transcript of the call as an exhibit in the instant proceedings.

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Petitioner responded that the Board properly exercised its discretion to expunge the errata sheets and that, as the Board determined in the previous Order, the time for Patent Owner to cure any issue with the witnesses' substantive testimony was on redirect examination, not in an errata sheet afterwards. Petitioner further argued that there is no basis for including the improper errata sheets in the record because any appeal from the instant proceedings will be an appeal of the Board's decision on the patentability of the challenged claims, not the Board's application of its rules.

Pursuant to 37 C.F.R. § 42.7(a), "[t]he Board may expunge any paper directed to a proceeding . . . that is not authorized under this part or in a Board order or that is filed contrary to a Board order." The errata sheets at issue were not authorized under the Board's rules or any Order in the instant proceedings, for all of the reasons stated in the previous Order. *See* IPR2013-00080, Paper 61; IPR2013-00081, Paper 52. Thus, expunging them was appropriate under the circumstances. We are not persuaded that the previous Order was in error or that the errata sheets should be re-filed for purposes of appeal only. Specifically, Patent Owner has not explained sufficiently why it would be appropriate to add the unauthorized errata sheets to the record, but not consider the documents when the Board reviews the entire record of each proceeding and renders a final written decision on the patentability of the challenged claims. Accordingly, a motion to re-file the expunged errata sheets is not authorized.

Additional Discovery

Petitioner, in its response to Patent Owner's statement of fact 129 in Patent Owner's response, admitted that QuickOffice, Inc. ("QuickOffice")

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(a previously dismissed co-defendant in the related litigation between the parties) “has entered into at least one form of an agreement related to app[lication] development with Petitioner prior to the Petition being filed.” *See* IPR2013-00080, Paper 59 at 4; IPR2013-00081, Paper 50 at 4. During the call, Patent Owner sought authorization to file a motion for additional discovery of that agreement under 37 C.F.R. § 42.51(b)(2). According to Patent Owner, the agreement is relevant to the issue of whether QuickOffice is a “real party-in-interest” or “privy” of Petitioner and, therefore, whether the Petition in each proceeding is time-barred under 35 U.S.C. § 315(b). Again, Patent Owner argued that the material only would be entered for purposes of appeal, and would not be considered by the Board. Patent Owner also argued that the requested discovery would serve judicial economy because the agreement could be considered for the first time on appeal, avoiding the potential need for a remand to the Board for additional fact-finding on the Section 315(b) issue.

Petitioner opposed Patent Owner’s request, arguing that the time period for discovery has passed and the record should not be changed at this stage of the proceedings. Petitioner also pointed out that the Board previously denied Patent Owner’s motion for additional discovery on the Section 315(b) issue, and Patent Owner did not request rehearing of that decision. *See* IPR2013-00080, Paper 18 (discovery request for copies of certain “agreements” between Petitioner and its co-defendants, including QuickOffice); IPR2013-00081, Paper 17.

We are not persuaded to authorize a motion for additional discovery. The time period for discovery set forth in the Scheduling Orders in the instant proceedings has expired. An oral hearing took place on February 26,

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2014, and the Board will enter a final written decision in each proceeding, based on the existing record, by June 3, 2014. Patent Owner has not given a sufficient reason for adding to the record at this late stage, or explained adequately why it would be appropriate to supplement the record with material that will not be considered on the merits.

Patent Owner's delay in seeking authorization to file a motion for additional discovery also weighs against granting its request. Petitioner filed its responses to Patent Owner's statements of fact on January 13, 2014. Patent Owner, however, did not request a conference call to seek authorization until February 21, 2014, more than a month later and less than one week before the oral hearing. Accordingly, a motion for additional discovery is not authorized.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is not authorized to file a motion to re-file the expunged errata sheets of Mr. Radbel and Dr. Wang, and is not authorized to file a motion for additional discovery of the agreement between Petitioner and QuickOffice.

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