

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 3, 2014 between respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Arbes, and Anderson. Petitioner requested the call to address the motions to exclude filed by Patent Owner in the proceedings. *See* IPR2013-00080, Paper 65 (“Mot.”); IPR2013-00081, Paper 57.² Petitioner has not yet filed oppositions to the motions.

During the call, Petitioner argued that the motions to exclude were improper and should be stricken because (1) Patent Owner did not identify where in the record objections were made to the evidence sought to be excluded under 37 C.F.R. § 42.64(c), (2) the motions contain new arguments and are not directed solely to the admissibility of evidence, and (3) Patent Owner improperly submitted nine new exhibits with its motion in Case IPR2013-00080 (Exhibits 2039-2047). Patent Owner responded that Petitioner’s arguments are premature because briefing on the motions has not been completed. Patent Owner also argued that its motions properly assert that evidence submitted by Petitioner is inadmissible because Petitioner mischaracterizes certain testimony in the record, and that Patent Owner should be permitted to submit new evidence for the purpose of showing that other evidence is inadmissible.

As explained during the call, apart from one issue discussed below, we agree with Patent Owner that Petitioner’s arguments are premature. The usual procedure, as contemplated by the Scheduling Order in the instant proceedings, is for a party to file a motion to exclude, the opposing party to file an opposition, and the moving party to file a reply. The Board then

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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decides the motion to exclude when the Board reviews all of the pertinent papers and prepares a final written decision. Petitioner has not shown a sufficient reason for departing from that procedure with respect to all of the issues presented by the motions except one.

One of Patent Owner's newly submitted exhibits in Case IPR2013-00080 is a new, seven-page declaration from Dr. Xin Wang (Exhibit 2045). During the call, the Board questioned Patent Owner as to why the declaration was appropriate in the context of a motion to exclude evidence submitted by Petitioner. Patent Owner responded that Dr. Wang's testimony was necessary to explain why two statements in Petitioner's reply are incorrect. First, Patent Owner moved to exclude two exhibits submitted by Petitioner regarding Windows XP, and argued in its motion that Petitioner misrepresented the exhibits in its reply by asserting that Windows XP installer software was in widespread commercial use "by February of 1997." *See* Mot. 9-11. Petitioner acknowledged during the call that its statement regarding February 1997 was incorrect. Thus, there is no dispute as to the timing of Windows XP and no need for declarant testimony on the issue. Second, Patent Owner moved to exclude certain testimony regarding U.S. Patent No. 5,933,497 ("Beetcher"), again citing an alleged misrepresentation of the record in Petitioner's reply. *See* Mot. 11-14. Upon further inquiry, however, Patent Owner acknowledged that the factual issue regarding Beetcher could be explained sufficiently in the motion itself without the need for declarant testimony. Therefore, based on the parties' representations during the call, declarant testimony is unnecessary on both points raised by Patent Owner.

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Moreover, regardless of the purported need for new declarant testimony, we are not persuaded that the declaration is appropriate under the circumstances. Although Patent Owner characterizes Dr. Wang's declaration as being offered only to show the inadmissibility of other evidence submitted by Petitioner, it is not so limited. Rather, Dr. Wang makes factual statements directly responding to arguments made by Petitioner. A motion to exclude, however, is not an opportunity to file a sur-reply. *See* 37 C.F.R. § 42.64(c); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) ("A motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact."). The late stage of these proceedings, and the Board's need to complete them in a timely manner, also weighs against permitting new declarant testimony in connection with Patent Owner's motion. As explained during the call, Dr. Wang's declaration will be expunged and Patent Owner may re-file its motion to exclude without reference to the declaration.

In consideration of the foregoing, it is hereby:

ORDERED that Exhibit 2045 is expunged from the record of Case IPR2013-00080;

FURTHER ORDERED that Patent Owner's motion to exclude in Case IPR2013-00080 (Paper 65) is considered *withdrawn*, and Patent Owner may re-file its motion to exclude, without reference to Exhibit 2045, by February 4, 2014; and

FURTHER ORDERED that Petitioner may file an opposition to the re-filed motion to exclude by February 6, 2014.

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