

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INTERNATIONAL BUSINESS MACHINES CORPORATION  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC  
Patent Owner.

---

Case IPR2014-00180  
Patent 7,634,666

---

Before DAVID C. McKONE, JAMES A. TARTAL, and MIRIAM L. QUINN,  
Administrative Patent Judges.

QUINN, Administrative Patent Judge.

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

On July 2, 2014, we held a conference call between respective counsel for Petitioner and Patent Owner, and Judges Quinn, Tartal, and McKone. Petitioner requested the call to request authorization for a motion to file additional information under 37 C.F.R. § 42.123(b). A court reporter was present. Patent Owner also sought to conference with the panel regarding the filing of a motion to amend. Because it is expected that a transcript of the conference call will be filed as an exhibit, this order summarizes the rulings of the panel and sets forth the procedure to follow in contacting the Board, if the need arises during this trial.

#### A. MOTION TO FILE SUPPLEMENTAL INFORMATION

Petitioner seeks authorization to file a transcript of a named inventor, Dr. Chang, because, according to Petitioner, the testimony would be instructive as to the operation of the patent-at-issue and as to claim construction and because the testimony reveals statements inconsistent with positions taken by Patent Owner in the Preliminary Response. Because the testimony is sought to be introduced more than one month after institution of trial, Petitioner further argued that it could not have been reasonably obtained earlier. Patent Owner objected to the filing of the testimony questioning the “remote” relevance that inventor testimony would have on any claim for which trial has been instituted.

After consideration of the parties’ arguments and contentions, we denied Petitioner’s request because we were unpersuaded by the argument that the inventor testimony is relevant to a claim for which trial has been instituted. Specifically, the general relevancy of an inventor’s testimony regarding the operation of the invention has little relevance to our proceedings. The possibility that it might be useful in understanding the invention is not significant enough to show that consideration of the information would be in the interests of justice to allow additional testimony on issues already developed by Petitioner on the record.

No argument presented demonstrated a need for the inventor testimony. Indeed, the plea for its submission focused on its utility to the panel's understanding of the technology or assistance in claim construction, a utility that seems generic in nature and untethered to any specific claim for which trial has been instituted. Furthermore, at this stage of the proceeding, when Patent Owner has not filed yet its Response, we find unpersuasive the argument that the inventor testimony is offered as evidence of Patent Owner's inconsistent statements made in the preliminary response. A Patent Owner's Response—not the preliminary response—is the brief controlling the positions of Patent Owner during trial.

To alleviate the concerns Petitioner demonstrated regarding our denial of the request to file the inventor testimony, we advised that in its reply, Petitioner may have an opportunity to respond to any argument made in the Patent Owner Response. Petitioner should point out how the evidence is responsive to any such argument by Patent Owner. Attempting to introduce evidence in a reply without anchoring that evidence to a responsive argument increases the risk that the panel may disregard portions or all of the reply. It is premature, at this juncture, to reach a decision on whether the inventor testimony would be allowable in a reply because Patent Owner has not filed its response.

Accordingly, Petitioner's request for authorization to file supplemental information under 37 C.F.R. § 42.123 (b) is denied.

B. PATENT OWNER MOTION TO AMEND

Patent Owner sought to confer with the panel regarding its intent to file a contingent motion to amend. After a brief discussion concerning the form and substance of the proposed substitute claims and the evidence that must be included in such a motion, the panel found the conference requirement satisfied and authorized the filing of the motion to amend.

C. MISCELLANEOUS

During the call, the panel raised the concern that the parties did not seem to be coordinating their efforts to contact the Board in an appropriate manner. Patent Owner argued it had not had the opportunity to consider the specific testimony sought to be filed before the Board was contacted by Petitioner. If the situation arises in the future, the following procedure for contacting the Board should be followed:

- 1) Before contacting the Board, the parties shall identify to each other, with specificity and clarity, the document, testimony, or other matter, including the precise portion thereof, that is in dispute.
- 2) The parties shall meet and confer to address the specifically identified issues and shall each weigh the merits and reasonableness of the contentions at issue and the possibility of a compromise.
- 3) Jointly, the parties shall contact the Board at [trials@uspto.gov](mailto:trials@uspto.gov) to identify to the Board the dispute and certify that the parties reasonably conferred on the matter in an attempt to resolve the issue.
- 4) Jointly, the parties shall indicate several dates/times during which the parties would be available for a conference with the panel.

- 5) The parties shall be prepared to discuss the attempts made to resolve the dispute, the authorization requested from the Board, and the basis for the request.

The parties are reminded that our mission is to conduct the just, speedy, and inexpensive resolution of the trial. We seek the parties' cooperation in respecting that mission and following the Board procedures.

*Order*

It is

ORDERED that Patent Owner has conferred regarding the filing of a motion to amend in satisfaction of 37 C.F.R. § 42.221(a);

FURTHER ORDERED that Petitioner's request for authorization to file supplemental information under 37 C.F.R. § 42.123(b) is denied; and

FURTHER ORDERED that the parties shall follow the procedure for contacting the Board outlined in this decision.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.