

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 August 5, 2014, we held a conference call between respective counsel for Petitioner and Patent Owner, and Judges Quinn, Tartal, and McKone. Petitioner requested, again, authorization for a motion to file additional information under 37 C.F.R. § 42.123(b). A court reporter was present for a portion of the call. After consideration of the parties' positions, the panel denied Petitioner's request with prejudice. This order summarizes the request and ruling of the panel.

A. PETITIONER'S REQUEST

Petitioner contends that a redacted transcript of a named inventor, Dr. Cheng, should be authorized as supplemental information because that testimony is "highly relevant" to claim construction. In support of its request, Petitioner cites *Voice Techs. Group, Inc. v. VMC Systems, Inc.*, 164 F.3d 605 (Fed. Cir. 1999) and argues that Dr. Cheng's testimony bears directly on what the specification discloses, vis-à-vis the disputed terms. Petitioner argued that Patent Owner has recently filed its Patent Owner Response and that the proposed testimony would be responsive to the claim construction position of Patent Owner. Although the inventor's testimony is argued as supporting a broadest reasonable interpretation analysis of certain claim terms, Petitioner stated the reason for seeking to supplement the record under 37 C.F.R. § 42.123(b), instead of submitting the information as part of its Reply, is related to considerations of trial tactics concerning inclusion of the information in the record and the 15-page limit of Replies.

Petitioner also argued that should the panel authorize the motion, it would show sufficiently that the testimony could not have been reasonably obtained earlier, a showing required under Rule 123(b).

B. PATENT OWNER'S OPPOSITION

Patent Owner indicated it would oppose the motion, if authorization is granted, because of the uncertain significance that the proposed inventor testimony would have in the proceedings and the alleged lack of diligence in seeking the testimony of Dr. Cheng. Patent Owner did not state any facts evidencing deliberateness in delays to obtain the testimony.

C. ANALYSIS AND DECISION

After consideration of the parties' arguments and contentions, we denied Petitioner's request with prejudice. This is the second time Petitioner seeks authorization to file a motion for supplemental information to introduce into the record portions of the deposition of Dr. Cheng, obtained in the co-pending district court case. The panel denied the first request because we were unpersuaded by the argument that the inventor testimony is relevant to a claim for which trial has been instituted. In our Order dated July 3, 2014, we stated that the utility of that testimony to the panel's understanding of the technology or assistance in claim construction demonstrated, at best, general relevance untethered to any specific claim for which trial has been instituted. *See* Paper 22, at 2–3. During that first conference and in that Order we gave guidance to Petitioner that the appropriate introduction of the inventor testimony would be as support of its Reply, where Petitioner has an opportunity to address the arguments made by Patent Owner in the Response. We declined to advise the parties regarding whether the inventor testimony would be allowable in a reply because Patent Owner had not filed a Response at the time of the Order.

Since then, Patent Owner has filed a Response. Petitioner's renewal of the request for authorization was focused solely on whether the inventor testimony would be "highly relevant" to claim construction. We denied Petitioner's request

for multiple reasons. First, the relevance of the inventor testimony, however marginal, must be explained in order for the panel to give it proper consideration. *See* 37 C.F.R. § 42.104(b)(5) (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”). A motion to file supplemental information is not a vehicle for explaining the significance of that testimony. Nor is such a motion an opportunity to obtain extra pages for argument that properly should be presented in a reply. Therefore, if the inventor testimony supports the broadest reasonable interpretation, as argued by Petitioner, and its consideration would challenge either Patent Owner’s position or the panel’s claim construction, Petitioner is free to make its argument regarding that testimony in the Reply.

Second, we were not persuaded with Petitioner’s reliance on *Voice Techs. Group*. Although we recognize that, in a *Markman* hearing, inventor testimony has been found useful for the district court’s determination of claim scope, we also recognize that “inventor testimony is of little probative value for purposes of claim construction.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1370 n.5 (Fed. Cir. 2003); *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000) (explaining that “[i]n *Markman*, we addressed the . . . issue of litigation-derived inventor testimony in the context of claim construction, and concluded that such testimony is entitled to little, if any, probative value.”). Furthermore, our rules place limits on the introduction of evidence, regardless of whether it is relevant to claim construction, after trial has been instituted. *See* 37 C.F.R. § 42.123 (requiring in subsections (a) and (b) that supplemental information must be relevant to a claim for which the trial has been instituted, in subsection (b) further requiring that consideration of the supplemental information would be in

the interests-of-justice, or in subsection (c) that consideration of non-relevant information would be in the interests-of-justice). We were not persuaded by Petitioner's allegation that it would be able to show that the claim-construction-related-inventor testimony is "highly relevant," in this proceeding, to a claim for which trial has been instituted under Rule 123(b) such that, in the interests-of-justice, it should be introduced as supplemental information. The panel has ruled only on whether the testimony may be filed as supplemental information, not whether the testimony is admissible. To be clear, the panel has not precluded Petitioner from making its inventor-testimony-based arguments with regard to claim construction. Such arguments and evidence, however, must be presented, if at all, in Petitioner's Reply.

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

Order

It is

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

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