

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Cases

IPR2014-00500 (Patent 5,790,793)
IPR2014-00501 (Patent 7,136,392 B2)¹

Before MICHAEL W. KIM, PATRICK R. SCANLON, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order addresses overlapping issues in these cases. Therefore, we issue one order applicable to both cases. The parties are not authorized to use this style heading in subsequent papers.

IPR2014-00500 (Patent 5,790,793)
IPR2014-00501 (Patent 7,136,392 B2)

During the initial telephone conference call in the above proceedings held on September 29, 2014, Petitioner indicated it would seek authorization to file additional information via a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123. IPR2014-00500, Paper 17; IPR2014-00501, Paper 18. We directed Petitioner to provide the additional information to Patent Owner, and we directed the parties to then discuss the additional information. *Id.*

A conference call in the above proceedings was held on October 3, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Kim, Scanlon, and Kalan. The purpose of the call was to review the parties' discussions on the additional information and their impact on Petitioner's request. During this call, Petitioner stated that a partial consensus had been reached between the parties. Specifically, Petitioner indicated that some of the additional information was documentary evidence that the parties agreed should be served but not filed.

Petitioners further indicated, however, that some of the additional information was declaratory evidence, which Petitioner asserted needed to be filed, rather than served, pursuant to 37 C.F.R. § 42.53(d)(2). Patent Owner disagreed, contending that the declaratory evidence should be served, not filed. In support of this position, Patent Owner stated that 37 C.F.R. § 42.53(d)(2) does not seem applicable in the present instance. Patent Owner also stated that the proposed declarations and related exhibits are responsive curative evidence, not supplemental information under 37 C.F.R. § 42.123, and allowing curative evidence to be filed, rather than served, would be inconsistent with Board precedent.

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In response to Patent Owner's comments, Petitioner reiterated its concern that, if not permitted to file the declaratory evidence at this point in the proceedings, Petitioner would be prohibited from filing by 37 C.F.R. § 42.53(d)(2).

After consideration of the parties' positions, we do not authorize Petitioner to file a motion to submit the declaratory evidence under 37 C.F.R. § 42.123. The declaratory evidence seems to be offered strictly in response to Patent Owner's objections and, therefore, is supplemental evidence under 37 C.F.R. § 42.64(b)(2), which is served, not filed. Regarding Petitioner's concerns about 37 C.F.R. § 42.53(d)(2), we note that Petitioner will be considered to have asked for permission to file the declaratory evidence prior to any applicable cross-examination. Furthermore, to the extent evidentiary objections remain, and Patent Owner files a motion to exclude evidence, Petitioner will have an opportunity to file the declaratory evidence with its opposition to the motion to exclude.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123 is DENIED.

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