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Paper No. 17
Entered: April 27, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OPENTV, INC.,
Patent Owner.

Case IPR2015-00969
Patent 5,884,033

Before JAMES B. ARPIN, DAVID C. MCKONE, and SCOTT C. MOORE, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

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

A conference call for IPR2015-00969 was held on April 26, 2016, among Judges Arpin, McKone, and Moore; counsel for Petitioner (Mark Miller); and counsel for Patent Owner (Daniel Tucker). Patent Owner requested authorization to file a sur-reply to respond to what it characterizes as new arguments raised in Petitioner's Reply. For the reasons set forth below, we *deny* Patent Owner's request.

In the Petition, Petitioner requested construction of, *inter alia*, two claim terms, "filters specifying immediate action" and "filters specifying deferred action." Paper 1 ("Pet."), 15–20. As part of its argument, Petitioner discussed the prosecution history of the '033 patent. *Id.* at 17 (quoting Ex. 1007)). In the Preliminary Response, Patent Owner offered competing constructions and argument. Paper 6 ("Prelim. Resp."), 4–9. We considered the parties' respective positions as well as constructions of the terms given by a district court in a related matter. Paper 8 ("Dec."), 7–11. We preliminarily concluded that the district court construction was largely appropriate and construed the terms consistently therewith, but declined to adopt a requirement that the filters "operate between the presentation and application levels of the seven-level OSI protocol model." *Id.* at 11 & n.2.

In its Response, Patent Owner again proposed constructions of "filters specifying immediate action" and "filters specifying deferred action," advancing the portion of the district court construction that we did not adopt. Paper 14 ("PO Resp."), 14–15. In its argument, Patent Owner contends that prosecution history disclaimer support its constructions. *Id.* at 15–21. In its Reply, Petitioner argues that prosecution history disclaimer does not support Patent Owner's construction. Paper 16 ("Reply"), 2–6.

Patent Owner contends that certain arguments in the Reply exceed the proper scope of a reply and requests that it be authorized to file a sur-reply to respond to those allegedly new arguments. During the teleconference, Patent Owner identified the following allegedly new arguments: (1) the record does not indicate how the limitation arising from the disclaimer would be implemented in the claims; (2) the limitation Patent Owner seeks to add to the constructions from the Decision would improperly introduce new matter under 35 U.S.C. § 132; and (3) the limitation Patent Owner seeks to add would render the claims invalid for failing to comply with the written description requirement.

Our Rules state that "[a] reply may only respond to arguments raised in the corresponding opposition or patent owner response." 37 C.F.R. § 42.23(b). During the teleconference, we reminded the parties that we have the discretion to consider whether an argument exceeds the proper scope of a reply and, if so, to disregard such an argument. *See* Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (August 14, 2012).[1] We informed the parties that, as part of our deliberation process, we would consider the scope of Petitioner's Reply and, consistent with our Rules and our Trial Practice

[1] "A reply may only respond to arguments raised in the corresponding opposition. § 42.23. While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply. Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing."

Guide, exercise our discretion to consider or disregard Petitioner's Reply arguments as appropriate. The parties agreed to this course of action. Accordingly, there is no need for a sur-reply at this time.

I. ORDER

Patent Owner's request for authorization to file a sur-reply is *denied*.

IPR2015-00969
Patent 5,884,033

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