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Paper 26
Entered: December 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

VEDANTI SYSTEMS LIMITED,
Patent Owner.

Case IPR2016-00212[1]
Patent 7,974,339 B2

Before MICHAEL R. ZECHER, JUSTIN T. ARBES, and JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

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

[1] Case IPR2016-00215 has been consolidated with this proceeding.

On December 2, 2016, Patent Owner sent an email to Trials@uspto.gov seeking a conference call to request authorization to file a motion to strike certain purported new arguments raised in Petitioner's Reply or, in the alternative, to request authorization to file a Sur-Reply of five pages. According to Patent Owner, Petitioner's Reply developed new arguments related to the Spriggs reference and introduced a new "Supplemental Declaration" from Dr. John R. Grindon. Patent Owner also contends that Petitioner's Reply includes a new "obvious to try" argument.

On December 6, 2016, a conference call was held with Judges Zecher, Arbes, and Hudalla, and respective counsel for the parties. During the call, Petitioner argued that its Reply develops no new theories and merely responds to arguments contained in Patent Owner's Response. Similarly, Petitioner argues Dr. Grindon's Supplemental Declaration is keyed to respond to arguments in Patent Owner's Response.

Generally, "[a] reply may only respond to arguments raised in the corresponding . . . patent owner response." 37 C.F.R. § 42.23(b). In accordance with this regulation, we will determine whether Petitioner's Reply contains evidence or argument that is outside the scope of Patent Owner's Response. Specifically, when we review the entire trial record and prepare the Final Written Decision, we will determine whether the scope of Petitioner's Reply and accompanying evidence is proper. If there are improper arguments and evidence presented with Petitioner's Reply, we may, for example, only consider Petitioner's arguments and evidence that are properly rooted in the Petition. For these reasons, we are unpersuaded that a motion to strike is warranted, so we do not authorize Patent Owner to file a motion to strike.

Nevertheless, under the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.20(d) and grant Patent Owner's request for authorization to file a five-page Sur-Reply. Our decision to authorize a Sur-Reply is heavily influenced by the fact that Petitioner's Reply is accompanied by and cites extensively to Dr. Grindon's new Supplemental Declaration, which spans 125 paragraphs and 41 pages. *See* Ex. 1030. Accordingly, we authorize Patent Owner to file a five-page Sur-Reply. During the call, Patent Owner did not present any persuasive reason why new evidence would need to be filed with the Sur-Reply. Consequently, no new evidence or testimony of any kind is permitted to be introduced or filed with the Sur-Reply.

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a motion to strike is *denied*;

FURTHER ORDERED that Patent Owner's alternative request for authorization to file a Sur-Reply is *granted*;

FURTHER ORDERED that Patent Owner's Sur-Reply is limited to five pages;

FURTHER ORDERED that Patent Owner shall file its Sur-Reply no later than Tuesday, December 13, 2016;

FURTHER ORDERED that no new evidence or testimony of any kind shall be introduced or filed with Patent Owner's Sur-Reply; and

FURTHER ORDERED that Petitioner is not authorized to file a responsive submission.

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