

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EMC CORPORATION,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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Case IPR2016-01106  
Patent 6,516,442 B1

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Before BRIAN J. McNAMARA and MINN CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

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

On June 28, 2017, Patent Owner sent an email to the Board requesting authorization to file a motion to strike an argument from Petitioner's Reply (Paper 18, "Pet. Reply"), or, in the alternative, to file a sur-reply in response to the Petitioner's argument. Patent Owner indicates that Petitioner opposes Patent Owner's request. According to Patent Owner, Petitioner's Reply includes arguments and evidence as to why Reschke (Ex. 1003) discloses a full-duplex bus, which Patent Owner contends was presented improperly for the first time on reply. We deny Patent Owner's request for the reasons explained below.

With regard to Patent Owner's request for authorization to file a motion to strike an argument from Petitioner's Reply, upon consideration and review of the parties' papers, we are not persuaded that a motion to strike the Reply would be appropriate under the circumstances in this proceeding. A motion to strike is not, ordinarily, a proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope permitted under the rules. In the absence of special circumstance, we determine whether a reply and supporting evidence contain material exceeding the proper scope when we review all of the pertinent papers and prepare the final written decision. We may exclude all or portions of Petitioner's Reply and newly submitted evidence, or decline to consider any improper argument and related evidence, at that time. We are not persuaded that the propriety of the Reply arguments and evidence should be resolved prior to the final written decision and/or via formal briefing of a motion to strike, opposition, and reply. Accordingly, Patent Owner's request for authorization to file a motion to strike an argument from Petitioner's Reply

is *denied*. Should either party request a hearing (by DUE DATE 4 in the Scheduling Order (Paper 10)), however, the parties may address the issue further during oral argument.

With regard to Patent Owner's request for authorization to file a sur-reply in response to Petitioner's argument in Petitioner's Reply, a sur-reply is not ordinarily necessary, absent special circumstances, for similar reasons. In this proceeding, Patent Owner's request is denied for additional reasons. In our Decision on Institution (Paper 9, "Dec. on Inst.") instituting trial in this proceeding, we preliminarily construed the term "channel" to mean "a general-purpose, high-speed, point-to-point, full-duplex, bi-directional interconnect bus." Dec. on Inst. 19. Although Petitioner argued in the Petition (Paper 3, "Pet.") that a "channel" should be interpreted as "a communication path" (Pet. 14), Petitioner nonetheless asserted that Reschke discloses channels which are "bidirectional, point-to-point, full-duplex interconnect buses" (*id.* at 38). In support of its contention, Petitioner cited Figures 1, 2, 4A, and 4B of Reschke and their accompanying text. *Id.* at 38–41. In particular, Petitioner relied upon the disclosures in Figures 4A and 4B that purportedly show the "forward" and "reverse" portions of Reschke's channels. *Id.* at 39–41. The Patent Owner Preliminary Response (Paper 7, "Prelim. Resp.") focused on Figure 2 of Reschke and argued that Figure 2 shows Reschke's channels are not full-duplex. Prelim. Resp. 33–36.

In our Decision on Institution, we noted that Patent Owner did not address Petitioner's argument and evidence regarding Figures 4A and 4B of Reschke, and encouraged the parties to discuss further in their papers whether the "forward" and "reverse" pathways in the data switching

circuitry of Reschke identified by Petitioner can operate at the same time to provide full-duplex transmission. Dec. on Inst. 29–30.

Patent Owner in its Patent Owner Response (Paper 15, “PO Resp.”) asserted that our Decision on Institution engaged in “improper burden shifting” and declined our invitation to discuss the data switching circuitry described in Figures 4A and 4B of Reschke. PO Resp. 50–51. Our invitation to both parties to discuss the implications of the data switching circuitry disclosed in Figures 4A and 4B of Reschke in no way shifts the burden of proof, which remains on Petitioner. Having declined to discuss the data switching circuitry described in Figures 4A and 4B of Reschke in its Patent Owner Response, Patent Owner, instead, addressed Figures 4A, 4B, and 4C together in general terms as “Figure 4” and argued that “Figure 4 only shows communications crossing the buses in *one direction at a time*, not simultaneously.” *Id.* at 51. Patent Owner also continued to focus on Figure 2 of Reschke and argued that Figure 2 shows “Figure 4 does not disclose full-duplex communication across the data buses.” *Id.* at 52–53.

Petitioner, in contrast, affirmatively responded to our invitation in its Reply and provided further discussion of why Figures 4A, 4B, and 4C of Reschke allegedly disclose full-duplex channels. Pet. Reply 20–26.

In view of this record, it is clear that Patent Owner had an ample notice and sufficient opportunity to discuss the full-duplex channel issue in the Patent Owner Response, and presented arguments and evidence it deemed appropriate in the Patent Owner Response, including a general discussion of Figure 4 (i.e., Figures 4A–4C) of Reschke. To the extent Patent Owner now seeks to address in a sur-reply the details of the

disclosure in Figures 4A–4C of Reschke relied upon by Petitioner, Patent Owner has declined to do so in its Patent Owner Response by pointedly rejecting our specific request or invitation in our Decision on Institution to discuss whether the circuits depicted in Figures 4A and 4B of Reschke disclose a full-duplex bus. Having made its choice not to discuss this subject matter in its Patent Owner Response, Patent Owner’s request to file a sur-reply to address the same essentially amounts to a request for additional pages for the Patent Owner Response. Further, by declining our invitation, Patent Owner has specifically waived its argument on the issue we invited the parties to discuss in their papers. *See also* Scheduling Order 5 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”).

Accordingly, Patent Owner’s request for authorization to file a sur-reply in response to Petitioner’s argument in Petitioner’s Reply is *denied*. Patent Owner may address Petitioner’s argument at the Oral Hearing if one is scheduled in this proceeding.

#### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request for authorization to file a motion to strike an argument from Petitioner’s Reply, or, in the alternative, to file a sur-reply in response to the Petitioner’s argument is *denied*.

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