

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.

ACTIVIDENTITY, INC.,  
Patent Owner.

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Case IPR2017-00338  
Patent 9,098,685 B2

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Before JAMES B. ARPIN, LYNNE E. PETTIGREW, and  
KEVIN C. TROCK, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION  
Denying Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(a)*

## I. DISCUSSION

EMC Corporation, (“Petitioner”) filed a request for *inter partes* review of claims 1, 3, 5, 7–9, 11, 13, 15, 16, and 19 (the “challenged claims”) of U.S. Patent No. 9,098,685 B2 (Ex. 1001, “the ’685 patent”). Paper 1 (“Pet.”). Intellectual Ventures I LLC (“IV”), the exclusive licensee of the ’685 patent (Paper 13), filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

In the Preliminary Response, IV contended that one of the prior art references relied on by Petitioner (Ex. 1005, “Neuman”) did not qualify as a prior art, printed publication because Petitioner had not established that Neuman was publicly available before the priority date of the ’685 patent. Prelim. Resp. 33–40. We disagreed.

With respect to Neuman, we stated,

Petitioner’s declarant, Dr. Neuman, is the author of the Neuman reference at issue. Ex. 1002 ¶¶ 69–70. Dr. Neuman’s declaration states expressly that his work was “published in a series of Internet Drafts with the Internet Engineering Task Force (IETF).” *Id.* at ¶ 69. Dr. Neuman’s declaration also states that “draft versions of these documents are made available for review and comment by members of the public by placing them in the IETF’s Internet-Drafts directory. This makes these working documents readily available to a wide audience, thus facilitating the process of review and revision. Such drafts were accessible to the public through the IETF’s website (www.ietf.org).” *Id.* Dr. Neuman states unequivocally that the reference at issue was “published on June 23, 1999,” which is before the priority date of the ’685 patent. *Id.* at ¶ 70. *On this record, Petitioner has made a sufficient showing that the Neuman reference qualifies as a prior art printed publication.*

Inst. Dec. 25 (emphasis added).

We determined that Petitioner had established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we instituted an *inter partes* review of the challenged claims of the '685 patent. Paper 9, 3 (“Inst. Dec.”).

Subsequent to the Institution Decision, on August 11, 2017, Petitioner filed an authorized Motion to Submit Supplemental Information seeking to enter Exhibits 1032–34 relating to the prior art status of the Neuman reference (Ex. 1005). Paper 15, 1; *see* Paper 16. IV filed an Opposition (Paper 17) to Petitioner’s Motion, and Petitioner filed a Reply (Paper 20) to IV’s Opposition. On October 17, 2017, IV filed the Patent Owner Response (Paper 24) and the Transcript of the Deposition of Dr. Neuman (Ex. 2006).

In the Patent Owner Response, IV did not renew its challenge to the public accessibility of the Neuman reference. Paper 24, *passim*. As we noted in the Scheduling Order, “[t]he patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.” Paper 10, 3. Thus, we deem Patent Owner’s challenge to the public accessibility of the Neuman reference waived.

In addition, IV filed Objections to Petitioner’s Evidence (Paper 12, 3–4), including to the Neuman reference (Ex. 1005). Petitioner explained in its Motion to Submit Supplemental Information that “[a]ll supplemental information Petitioner seeks to submit has previously been served on [IV] in response to their evidentiary objections (Paper 12) on July 18, 2017.” Paper 15, 1. IV did not file a timely Motion to Exclude. Thus, we also deem Patent Owner’s evidentiary objections to the Neuman reference waived. *See* Office Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012) (“A party wishing to challenge the admissibility of evidence

IPR2017-00338  
Patent 9,098,685 B2

must object timely to the evidence at the point it is offered and then preserve the objection by filing a motion to exclude the evidence.”).

Because Patent Owner’s challenges to the public accessibility of the Neuman reference and Patent Owner’s evidentiary objections to the Neuman reference are deemed waived, we determine that Petitioner’s Motion to Submit Supplemental Information is *moot*.

## II. ORDER

Accordingly, it is

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *denied*; and

FURTHER ORDERED that Exhibits 1032–34 are expunged.

IPR2017-00338  
Patent 9,098,685 B2

PETITIONER:

Peter M. Diciara  
Arthur Shum  
Elaine Zhong  
Thomas Brown  
WILMER CUTLER PICKERING HALE and DORR LLP  
[peter.dichiara@wilmerhale.com](mailto:peter.dichiara@wilmerhale.com)  
[arthur.shum@wilmerhale.com](mailto:arthur.shum@wilmerhale.com)  
[elaine.zhong@wilmerhale.com](mailto:elaine.zhong@wilmerhale.com)  
[tom.brown@emc.com](mailto:tom.brown@emc.com)

PATENT OWNER:

Intellectual Ventures I LLC:

Lori A. Gordon  
Byron L. Pickard  
Lestin L. Kenton  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
[lgordon-PTAB@skgf.com](mailto:lgordon-PTAB@skgf.com)  
[bpickard-PTAB@skgf.com](mailto:bpickard-PTAB@skgf.com)  
[lkenton-PTAB@skgf.com](mailto:lkenton-PTAB@skgf.com)

James R. Hietala  
Tim R. Seeley  
INTELLECTUAL VENTURES  
[jhietala@intven.com](mailto:jhietala@intven.com)  
[tim@intven.com](mailto:tim@intven.com)