

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

Cases IPR2017-00742 and IPR2017-00744
Patent 8,621,512 B2

Before BARBARA A. BENOIT and TERRENCE W. McMILLIN,
Administrative Patent Judges.

McMILLIN, *Administrative Patent Judge.*

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

On March 26, 2018, the Board received an email from Patent Owner's counsel, Mark D. Rowland, which said:

In connection with the two proceedings identified above, Patent Owner respectfully requests permission to file an identification of Petitioner's evidence exceeding the proper scope of a reply, under Rule 42.23(b). Patent Owner further requests a conference call with the Board to discuss this submission.

Patent Owner seeks permission to file an itemized list in each proceeding that identifies new expert testimony that Petitioner submitted with its Replies, constituting new opinions that should have been included with the Petitions. Petitioner opposes this request.

Generally, 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.

After consideration and review of the parties' papers, we grant Patent Owner's request. Patent Owner may file a numbered list of citations to Petitioner's Reply, with *brief* explanations (akin to a motion for observation), to those portions of Petitioner's Reply citing new expert testimony submitted with Petitioner's Reply that Patent Owner believes exceed the proper scope of a reply under 37 C.F.R. § 42.23(b). If Patent Owner chooses to file such a list, Patent Owner must do so no later than April 11, 2018.

We also authorize Petitioner to file a list in response explaining *briefly* (akin to a motion for observation) why the passages identified by the Patent

IPR2017-00742; IPR2017-00744
Patent 8,621,512 B2

Owner are within the proposer scope of a reply under 37 C.F.R.

§ 42.23(b). If Petitioner chooses to file such a list in response, Petitioner must do so no later than April 18, 2018.

Neither party is permitted to submit additional evidence or additional arguments regarding patentability of the challenged claims.

The parties may address the issue further during oral argument.

Accordingly, it is

ORDERED that the parties shall proceed in accordance with this Order.

IPR2017-00742; IPR2017-00744
Patent 8,621,512 B2

PETITIONER:

Frederic M. Meeker
Bradley C. Wright
Charles W. Shifley
Timothy C. Meece
Christopher J. Galfano
Scott M. Kelly
BANNER AND WITCOFF, LTD
fmeeker@bannerwitcoff.com
bwright@bannerwitcoff.com
cshifley@bannerwitcoff.com
tmeece@bannerwitcoff.com
cgalfano@bannerwitcoff.com
skelly@bannerwitcoff.com

PATENT OWNER:

Mark D. Rowland
Gabrielle E. Higgins
ROPES & GRAY LLP
Mark.Rowland@ropesgray.com
Gabrielle.Higgins@ropesgray.com