

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

PROMOS TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01418
Patent 6,559,044 B1

Before JAMESON LEE and JOHN A. HUDALLA,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

Introduction

On July 19, 2018, a conference call was held to discuss Patent Owner's Motion to Exclude Evidence. Paper 24. The participants were Judges Lee and Hudalla, and respective counsel for the parties.

Counsel for Petitioner asserts that a proper Motion to Exclude Evidence should only be directed to admissibility issues under the Federal Rules of Evidence. Thus, Petitioner contends Patent Owner's Motion to Exclude is improper because it asserts only that Petitioner's Reply exceeds the proper scope of a reply by including new arguments and by relying on new evidence in support of those new arguments. According to counsel for Petitioner, Patent Owner should have filed a Motion to Strike, not a Motion to Exclude Evidence.

Discussion

We agree with Petitioner that a Motion to Exclude Evidence should only be used to raise admissibility issues under the Federal Rules of Evidence. When a Patent Owner asserts that a Reply exceeds the proper scope of a reply, we ordinarily allow the Patent Owner to file a one page listing, item by item, of the alleged new arguments by page and line number in the Reply. We also allow the Petitioner to file a responsive listing, item by item, of the portions of the Patent Owner Response that triggered the alleged new argument and new evidence in support of the alleged new argument. Counsel for Patent Owner confirmed that the Motion to Exclude Evidence raises for consideration its assertion that the Reply exceeds the proper scope of a reply by including new arguments and by relying on new evidence in support of the alleged new arguments.

We proposed simply to treat Patent Owner's "Motion to Exclude Evidence" as a "Motion to Strike New Argument and Evidence in Support of New Argument," because the latter is what Patent Owner seeks and also what Petitioner believes Patent Owner should have filed in the first instance. Under this proposal, there would be no "Motion to Exclude Evidence" by Patent Owner, and the objections Patent Owner filed with respect to the evidence in support of the alleged new arguments are null and void. The proposal was accepted by both parties.

Counsel for Petitioner agreed to file an opposition by July 27, 2018, and to limit the opposition to no more than 10 pages. We also indicated that no reply to that opposition is authorized at this time.

Order

It is

ORDERED that Patent Owner's Motion to Exclude Evidence shall be treated as a "Motion to Strike New Argument and Evidence in Support of New Argument," and the parties shall not refer to it as a motion to exclude evidence;

FURTHER ORDERED that Petitioner is authorized to file an opposition, limited to no more than 10 pages, to Patent Owner's "Motion to Strike New Argument and Evidence in Support of New Argument," by July 27, 2018; and

FURTHER ORDERED that no reply by Patent Owner to Petitioner's opposition is authorized at this time, and that if Patent Owner desires to file a reply, it must arrange for a conference call with the Board to seek such authorization and explain why such a reply is necessary by August 3, 2018.

IPR2017-01418
Patent 6,559,044 B1

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