Trials@uspto.gov
571-272-7822

Paper 31
Entered: January 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORP.,
Patent Owner.

Case IPR2018-00386
Patent No. 9,490,411 B2

Case IPR2018-00437
Patent No. 9,537,071 B2

Before SALLY C. MEDLEY, WILLIAM V. SAINDON, and NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

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

The Board entered Scheduling Orders in these proceedings setting the same schedule for both proceedings. Paper 16.[1] Consistent with the Scheduling Orders, in each proceeding, Patent Owner filed its Response on September 18, 2018 (Paper 22), and Petitioner filed its Reply to Patent Owner's Response on December 11, 2018 (Paper 31).

On January 17, 2019, a telephone conference call was held to discuss requests from each party for authorization to file certain papers in addition to those identified in the Scheduling Order. A transcript of the telephone conference has been entered into the record. IPR2018-00386, Ex. 2020.[2]

The Parties' Requests for Sur-Replies and Sur-Sur-Replies re: the Petition

Patent Owner requests authorization to file a sur-reply in response to Petitioner's Reply to Patent Owner's Response in each of the proceedings by January 29, 2019, the date provided in the Scheduling Order for observations regarding cross-examination of reply witnesses, among other things. Paper 22 at 9. Petitioner does not oppose Patent Owner's request for sur-replies "on the condition that the board also authorizes sur-sur-replies." IPR2018-00386, Ex. 2020 at 4:16–19. To that end, Petitioner also requests authorization to file a sur-sur-reply to any sur-reply filed by Patent Owner,

---

[1] Unless otherwise noted, paper numbers and exhibit numbers in this Order refer to IPR2018-00437.

[2] In IPR2018-00437, the document uploaded as Exhibit 2037 is Patent Owner's Exhibit List (also uploaded as Paper 38), instead of a copy of the hearing transcript. The Board will expunge the incorrectly filed document, and the parties should upload a copy of the hearing transcript as an exhibit in IPR2018-00437.

arguing it would be unfair to allow Patent Owner to file a sur-reply in place of the observations regarding cross-examination while not also allowing Petitioner to file a sur-sur-reply. *Id.* at 4:11–6:1. Specifically, Petitioner notes that the Scheduling Order provides a February 12, 2019 date for a response to observations, and Petitioner contends that it would be deprived of an opportunity for briefing if Patent Owner files a sur-reply instead of observations on cross examination, as Petitioner would no longer have the opportunity to file a paper on February 12, 2019 without authorization to file a sur-sur-reply. *Id.*

As discussed in the telephone conference, the Office issued an update to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012), in August 2018 to reflect that sur-replies to principal briefs will normally be authorized as part of the Board's standard practices. *See* 83 Fed. Reg. 39,989 (Aug. 13, 2018) (explaining that the revised sections of the Trial Practice Guide are available at *https://go.usa.gov/xU7GP*). The Trial Practice Guide does not address sur-sur-replies.

Consistent with the Trial Practice Guide as updated, we grant Patent Owner's request for authorization to file, in each of the proceedings, a five-page sur-reply in response to Petitioner's Reply to Patent Owner's Response by January 29, 2019. We deny as premature Petitioner's request to file a sur-sur-reply. Contrary to Petitioner's arguments, the Scheduling Order's February 12, 2019 deadline for a response to observations did not represent an opportunity for substantive briefing, as the Scheduling Order limited observations on cross-examination and any responses to "concise statements" not to exceed a single, short paragraph. Paper 22 at 6. If, after Patent Owner files sur-replies, Petitioner can establish that the content of the

sur-replies creates adequate cause for a sur-sur-reply, Petitioner can again request authorization to file a sur-sur-reply.

Patent Owner's Request for a Motion to Strike

In IPR2018-00437, Patent Owner filed a Contingent Motion to Amend Claims on September 18, 2018. Paper 24. Petitioner filed an Opposition to Patent Owner's Contingent Motion to Amend Claims on December 11, 2018 (Paper 32), and Patent Owner filed a Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend Claims on January 8, 2019 (Paper 34).

In addition to its Reply to Petitioner's Opposition (Paper 34), Patent Owner requests authorization to file a motion to strike portions of Petitioner's Opposition (Paper 32). During the telephone conference, Patent Owner stated, among other things, that Petitioner's Opposition improperly incorporates by reference more than 200 pages of argument and includes a 277-page declaration in an alleged effort to circumvent the 25-page limit allowed for Petitioner's Opposition. IPR2018-00386, Ex. 2020 at 10:13–13:22.

Petitioner opposes Patent Owner's request and disagrees with Patent Owner's characterization of Petitioner's Opposition. Petitioner stated that its arguments and evidence are presented in Petitioner's Opposition itself, with its declaration providing underlying facts and data supporting the Petitioner's expert's opinion. *Id.* at 14:1–1412, 15:4–15:17. Among other things, Petitioner stated that Patent Owner's proposed substitute claims made it necessary to cite additional prior art and combinations of prior art to

present Petitioner's obviousness arguments, in addition to Petitioner's other arguments such as written description. *Id.* at 14:13–18, 15:18–20.

In *inter partes* review proceedings, "[a]rguments must not be incorporated by reference from one document into another" and "combined documents are not permitted." 37 C.F.R. § 42.6(a)(3). Although there is no bright line for determining what constitutes an incorporation by reference, the practice of citing a declaration "to support conclusory statements that are not otherwise supported in [a document] amounts to incorporation by reference." *Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014–00454, slip op. at 10 (PTAB Aug. 29, 2014) (Paper 12) (informative).

Although at this stage in the proceeding we have not evaluated the substance or adequacy of Petitioner's obviousness arguments, we are not persuaded that a motion to strike would be appropriate in this case. Rather than expending the parties' and the Board's resources on a motion to strike, the Board will consider whether particular arguments and citations amount to incorporation by reference as it weighs arguments and evidence as part of a final written decision. We deny Patent Owner's request for authorization to file a motion to strike.

Petitioner's Request for a Sur-Reply Re: Patent Owner's Motion to Amend

Petitioner requests authorization to file a sur-reply in response to the Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend Claims (Paper 34). Patent Owner does not oppose this request. Similar to the discussion above and consistent with the Trial Practice Guide, we grant Petitioner's request for authorization to file a sur-reply to Patent

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.