

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CBS INTERACTIVE INC., THE NEW YORK TIMES COMPANY,
G4 MEDIA LLC, and BRAVO MEDIA, LLC.
Petitioners,

v.

HELPERICH PATENT LICENSING, LLC, and WIRELESS SCIENCE, LLC,
Exclusive Licensee and Patent Owner.

Case IPR2013-00033 (JYC)
Patent 7,155,241

Before SCOTT R. BOALICK, KEVIN F. TURNER and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

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

On August 8, 2013, a telephone conference call was held between respective counsel for the parties and Judges Turner and Chang. A court reporter was present on the call.¹ The purpose of the call was to discuss five items concerning improper filings. The Board addressed each of the five items in turn.

1. Reply to Patent Owner Response

During the conference call, Helferich alleged that CBS's reply (Paper 74) to Helferich's patent owner response² (Paper 55) and related supporting exhibits (Ex. 1018-1041) were filed improperly. In regard to this issue, Helferich advanced three arguments.

Whether evidence filed in support of a reply is proper

Helferich first alleged that CBS's evidence submitted in the related exhibits was improper because, according to Helferich, CBS's evidence should have been submitted with the petition and such evidence should not be permitted.

As explained by the Board during the conference call, 37 C.F.R. § 42.23(b) provides that a "reply may only respond to arguments raised in the corresponding opposition or patent owner response." Further, pursuant to 37 C.F.R. § 42.23(b), evidence filed in support of a reply is permitted.

Whether a reply contains arguments or evidence that is outside of the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the

¹ A more complete record may be found in the transcript, which is to be filed by Helferich as an exhibit.

² This Order refers to the revised patent owner response (Paper 55), unless otherwise stated.

Board. More specifically, the Board will determine whether a reply contains improper arguments or evidence when the Board reviews all of the parties' briefs and prepares the final written decision. Should there be improper arguments or evidence presented with a reply, the Board, exercising its discretion, may exclude the reply and related evidence in their entirety, or alternatively, decline to consider the improper arguments and/or related evidence. Briefing from the parties as to whether an argument or evidence is submitted outside the scope of a proper reply rarely is authorized.

Upon inquiry from Helferich regarding patent owner's opportunity to submit evidence, the Board directed Helferich's attention to the scheduling order³ which set forth the due dates for filing briefs and supporting evidence. In particular, Helferich had the opportunity to submit supporting evidence with its patent owner response and motion to amend no later than Due Date 1.⁴ In this proceeding, both parties had opportunities to adjust their respective due dates (*see e.g.*, Papers 26, 29, and 44).

Allowing parties to file evidence or arguments later than their respective due dates would frustrate statutory considerations and the Board's rules. An *inter*

³ The original scheduling order (Paper 22) was revised (Paper 29). In an Order (Paper 26), the Board authorized the parties to file a joint motion to adjust Due Dates 1-6 of the original scheduling order (Paper 22). Pursuant to the Board's Order, the parties filed a joint motion (Paper 27) which provided new due dates agreed upon by both parties. The Board granted the motion and issued a revised scheduling order with the parties' new due dates (Papers 28 and 29).

⁴ Due date 1—for filing a patent owner response and motion to amend—set forth in the original scheduling order (Paper 22) was modified by the parties from May 28, 2013 to June 7, 2013 (*see* Paper 44).

partes review is a streamlined and focused proceeding, unlike *ex parte* prosecution or patent reexamination. A final determination must be made generally no later than one year after institution of the *inter partes* review. 35 U.S.C. § 316(a)(11). As a result, and pursuant to 35 U.S.C. § 316(b), rules for *inter partes* review proceedings were promulgated to take into account the “regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” The promulgated rules provide that they are to “be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

Whether “a statement identifying material facts in dispute” is required in a reply

Helferich also alleged that CBS’s reply is improper, as it lacks a “statement identifying material facts in dispute.” It was Helferich’s view that the Board’s rules require such a statement.

As explained by the Board during the conference call, 37 C.F.R. § 42.23(a) provides that “[o]ppositions and replies must comply with the content requirements for motions and must include a statement identifying material facts in dispute” and 37 C.F.R. § 42.24(c) provides that “[t]he following page limits for replies apply and include the required statement of facts in support of the reply.” Contrary to Helferich’s assertion, these rules do not require “a statement identifying material facts in dispute” in a reply to a patent owner response that does not contain a statement of facts.

In this proceeding, Helferich submitted a statement of facts in its original patent owner response (Paper 47). However, because the original patent owner response exceeded the 60-page limit, Helferich filed a revised patent owner

response (Paper 55) that removed the statement of facts, pursuant to the Board's Order (Paper 49).⁵ Accordingly, CBS's reply is not required to include a "statement identifying material facts in dispute."

Whether the margins of CBS's reply are less than 1 inch

Helferich alleged that the margins of CBS's reply are less than 1 inch as required by 37 C.F.R. § 42.6(a)(2)(iv). CBS did not disagree that, as a result of inadvertent clerical error, its reply has improper margins.

If proper margins were used, the reply would have exceeded the 15-page limit. More specifically, as CBS noted, the text on lines 7-21 on page 15 of the reply (Paper 74) would have been on page 16. Upon consideration of the parties' arguments, the Board determined to treat CBS's reply as though it has proper margins, but the Board will not consider the text on lines 7-21 on page 15 of the reply on the merit.

2. *Opposition to Motion to Amend*

Helferich alleged that the margins of CBS's opposition (Paper 78) to Helferich's motion to amend (Paper 48) are less than 1 inch as required by 37 C.F.R. § 42.6(a)(2)(iv) and CBS's opposition includes a single spaced block quotation on page 10 in violation of 37 C.F.R. § 42.6(a)(2)(iii). CBS also did not disagree that, as a result of inadvertent clerical error, its opposition has improper

⁵ While the Board's Order also authorized Helferich to submit the information contained in the statement of material facts in an expert declaration, the Order stated that the expert declaration would not be considered as a statement of material facts to be admitted or denied. (Paper 49 at p. 3.)

margins and a single spaced block quotation.

If proper margins and spacing were used, the opposition would have exceeded the 15-page limit. More precisely, as CBS noted, the text on lines 10-21 on page 15 of the opposition (Paper 78) would have been on page 16. Upon consideration of the parties' arguments, the Board determined to treat CBS's opposition as though it has proper format, but the Board will not consider the text on lines 10-21 on page 15 of the opposition on the merit.

3. *Second Declaration of Dr. Mitchell*

Helferich contended that the second declaration of Dr. Mitchell (Ex. 1019) uses 1.5 spacing in violation of 37 C.F.R. § 42.6(a)(2)(iii). CBS noted that even if double spacing were used, no page limit was violated. CBS offered to resubmit the declaration in double spacing. To minimize cost and delay, the Board determined that resubmission is not necessary.

4. *Request for Leave to File an Opposition*

CBS requested leave to file an opposition to Helferich's request for rehearing (Paper 78) to address a new matter presented for the first time in violation of 37 C.F.R. § 42.71(d), and mischaracterization of its conduct before the Office in the co-pending reexamination proceedings. Upon consideration of CBS's arguments, the Board determined that additional briefing concerning Helferich's request for rehearing is not necessary as it would increase cost and delay in the proceeding and the Board has sufficient information to decide the request for rehearing.

5. *Motion to Amend*

CBS contended that Helferich's motion to amend (Paper 48) exceeds the 15-page limit in violation of 37 C.F.R. § 42.24(a)(v) and includes single-spaced footnotes in violation of 37 C.F.R. § 42.6(a)(2)(iii).

Helferich did not disagree. Rather, Helferich urged the Board to treat its motion to amend similar to the Board's treatment of CBS's reply and opposition. Upon consideration of Helferich's arguments, the Board agreed and determined to treat Helferich's motion to amend as though it has proper format, but the Board will not consider the text on page 16 (which is labeled as page 17) of the motion to amend (Paper 48) and in the footnotes on the merit.

Improper Filings in General

Improper filings cause burden on the Board and parties, as well as cause unnecessary delays and costs, which frustrate the statutory and regulatory goals, and the Board's ability to complete this proceeding timely. The Board, exercising its discretion, determines the treatment of each improper filing on a case-by-case basis depending on the facts of each situation. *See e.g.*, 37 C.F.R. §§ 42.7 and 42.12. The Board urges respective counsel of the parties to observe the statutory and regulatory requirements carefully to avoid improper filings.

Order

Accordingly, it is

ORDERED that CBS's reply (Paper 74) to Helferich's patent owner response is treated as though it has proper margin, but the text on lines 7-21 on

page 15 of the reply will not be considered on the merit;

FURTHER ORDERED that CBS's opposition (Paper 75) to Helferich's motion to amend is treated as though it has proper format, but the text on lines 10-21 on page 15 of the opposition will not be considered on the merit;

FURTHER ORDERED that CBS's request for leave to file an opposition to Helferich's request for rehearing (Paper 78) is *denied*; and

FURTHER ORDERED that Helferich's motion to amend (Paper 48) is treated as though it has proper format, but the text on page 16 (which is labeled as page 17) and in the footnotes will not be considered on the merit.

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