

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYCOM, INC.,
Petitioner

v.

DIRECTPACKET RESEARCH, INC.,
Patent Owner

IPR2019-01235
Patent 8,560,828 B2

Before BRYAN F. MOORE, SHEILA F. McSHANE, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

On September 4, 2020, after obtaining authorization (Paper 49), directPacket Research, Inc. (“Patent Owner”) filed a motion to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 50 (“Motion,” “Mot.”). In the Motion, Patent Owner seeks to submit into the record two documents which are SIP (Session Initiation Protocol) and H.323 standards, arguing that these documents are needed to respond to an incorrect statement made by Petitioner’s expert, Dr. Lavian, in the declaration he filed with Petitioner’s Reply Brief. Mot. 1 (citing Ex. 1042).

Specifically, Patent Owner argues that the standards documents at issue are needed to respond to Dr. Lavian’s statement that “[i]n SIP and H.323, RTP is used to transmit the multimedia data while SIP and H.323 provide signaling and control.” *Id.* at 2 (citing Ex. 1042 ¶ 7). Patent Owner argues that “Dr. Lavian’s characterization of H.323 is wrong as a matter of fact and its description of SIP is misleading at best, and that the standards documents governing these protocols bear this out.” *Id.* at 3. Nevertheless, Patent Owner does not explain why Dr. Lavian’s statement is incorrect or how the standards documents are inconsistent with it. *Id.* at 2–3. Patent Owner further argues that the standards documents could not reasonably have been obtained earlier in the proceeding because Petitioner did not raise the argument based on Dr. Lavian’s testimony until its Reply Brief, and because Patent Owner was unaware of Dr. Lavian’s reliance on the information until his deposition on August 25, 2020. *Id.* at 4.

In response, Petitioner argues that Patent Owner could have filed the H.323 and SIP standards earlier because Petitioner filed them in a related *inter parties* review proceeding (IPR2019-01233) in June 2019. Paper 55, 1. Additionally, Petitioner argues that the H.323 and SIP standards have been

relevant throughout this proceeding, because they are discussed in the '828 patent, the prior art, the Petition, and the Patent Owner Response. *Id.* at 1–2 (citing, *e.g.*, Paper 1, 1; Paper 27, 6–8; Ex. 1002 ¶¶ 18–20; Ex. 2001 ¶¶ 8–11; Ex. 2009 ¶¶ 73–77). Petitioner further argues that Dr. Lavian's statement in paragraph 7 of his declaration was not new or surprising, because Patent Owner's expert made comparable statements, and many of the exhibits in the record describe the technology consistently with Dr. Lavian's statement. *Id.* at 2 (citing Ex. 2009 ¶¶ 75–76; Ex. 1043, 27:20–22, 37:15–16; Ex. 1001, 2:63–67; Ex. 1005, 7–11; Ex. 1006, 16:56–17:9, Fig. 7; Ex. 1007, 4–5, Fig. 3). Finally, Petitioner argues that Patent Owner's late submission would be highly prejudicial because Petitioner has no ability to respond to Patent Owner's new evidence and arguments. *Id.* at 5.

Under 37 C.F.R. § 42.123(b), a “motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” The Board's Consolidated Trial Practice Guide further provides that a “sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 73 (November 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>.

We find that Patent Owner's motion does not meet the standard for submission of supplemental information set forth in § 42.123(b). First, Patent Owner fails to sufficiently show why the supplemental information reasonably could not have been obtained earlier. The record shows that Patent Owner has been aware of the existence of the SIP and H.323

standards for some time, as evidenced by their discussion in the '828 patent, the Petition, and the prior art at issue. Indeed, it appears that Patent Owner has been in possession of documents evidencing these standards as early as June 2019, when Petitioner filed them in the related IPR2019-01233 proceeding between the same parties. We are also not persuaded that granting the motion would be in the interests of justice. Patent Owner fails to establish a compelling need for the standards documents because it does not explain with sufficient specificity why Dr. Lavian's declaration testimony is incorrect or how the standards documents it seeks would demonstrate this alleged error. Moreover, Petitioner has persuaded us that it would be prejudiced by introduction of new evidence and arguments at this late stage of the proceeding because Petitioner would not have an opportunity to respond.

Accordingly, it is
ORDERED that
Patent Owner's motion to submit supplemental information under
37 C.F.R. § 42.123 is *denied*.

The due date for Patent Owner's Sur-reply shall be extended an
additional day to September 15, 2020.

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