

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO HOLDING COMPANY, INC., LENOVO (UNITED STATES)
INC., AND MOTOROLA MOBILITY LLC,
Petitioner,

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner.

IPR2019-01278 (Patent 8,020,083 B1)
IPR2019-01279 (Patent 8,510,407 B1)¹

Before JAMES A. WORTH, AMBER L. HAGY, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

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

In each of the two captioned proceedings, Lenovo Holding Company, Inc., Lenovo (United States) Inc., and Motorola Mobility LLC (“Petitioner”) challenges a patent owned by DoDots Licensing Solutions LLC (“Patent

¹ This Order applies to each of the listed cases. The parties are not authorized to use this caption for subsequent papers.

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Owner”). IPR2019-01278, Paper 2; IPR2019-01279, Paper 2. On January 9, 2020, we instituted trial in IPR2019-1279, and on January 24, 2020, we instituted trial in IPR2019-1278. IPR2019-01279, Paper 7; IPR2019-01278, Paper 8 (“Institution Decision”).

Patent Owner timely filed its Response in each proceeding. IPR2019-01278, Paper 20 (“Patent Owner’s Response,” filed May 6, 2020); IPR2019-01279, Paper 18 (filed April 27, 2020). On August 5, 2020, Petitioner timely filed its Reply in each proceeding. IPR2019-01278, Paper 22; IPR2019-01279, Paper 21.

In each proceeding, on September 2, 2020, after receiving an Order authorizing the filing of a motion from the Board, Patent Owner filed a Motion to Strike. IPR2019-01278, Paper 24 (“Mot.”); IPR2019-01279, Paper 23; *see* IPR2019-01278, Paper 23 (“Order Authorizing Mot.”); IPR2019, Paper 22. On September 4, 2020, in each proceeding, Petitioner filed its opposition to the Motion to Strike. IPR2019-01278, Paper 25 (“Opp.”); IPR2019-01279, Paper 24.

For the reasons below, we grant Patent Owner’s Motion to Strike.

*The Parties’ Positions*²

In the Motion, Patent Owner requests that the Board strike the evidence and argument submitted with Petitioners’ Reply relating to the

² In the balance of our discussion, while the facts and analysis are common to both proceedings, we refer to the papers and exhibits filed in Case IPR2019-01278 for convenience.

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status of Berg³ as prior art⁴. Mot. 1. According to Patent Owner, the argument and evidence relating to this issue is improper as not responsive to prior briefing, and “[u]nless the evidence and argument are stricken, Patent Owner will be put to the task of submitting rebuttal evidence and argument in its sur-reply and also will need to address the issue in its demonstrative exhibits and at trial.” *Id.* at 2. Patent Owner argues that it would therefore incur “needless expense” and also be “a waste of the Board’s time given that the new evidence and argument is so clearly improper.” *Id.*

Petitioner argues that Patent Owner has “repeatedly challenged the printed publication status of Berg during communications with the Board and in related proceedings.” Opp. 1. Petitioner bases this argument on its contention that Patent Owner has raised the issue during two telephone conferences with the Board, and also in another related proceeding. *Id.* at 1–2. Petitioner argues that during a first telephone conference, in July 2020, Patent Owner “indicated that it planned to depose” a declarant (Catherine Vassilkova) whose declaration related to the public accessibility of Berg. *Id.* at 2. Petitioner additionally argues that during an August 31, 2020, telephone conference regarding the Patent Owner’s request for authorization to file the Motion to Strike, Patent Owner “again argued that Petitioner had

³ Berg is an article by Clifford Berg titled “How Do I Create a Signed Castanet Channel?”. IPR2019-01278, Ex. 1007; *see* IPR2019-01278, Ex. 1005.

⁴ The law governing *inter partes* review provides that such reviews must be based on “a ground that could be raised under section 102 [anticipation] or 103 [obviousness] and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b).

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not established *Berg* as a printed publication.” *Id.*⁵ Petitioner also argues that Patent Owner has challenged the publication status of *Berg* in another *inter partes* review (IPR2019-00988). *Id.*

Petitioner additionally argues that its submission was properly responsive to our Institution Decision, in which we made a preliminary finding that *Berg* qualifies as a printed publication. *Id.* (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“Consolidated TPG”), 73); Institution Decision 9.

Lastly, Petitioner argues that this situation does not merit the “exceptional remedy” of striking a portion of the brief, casting any prejudice to the Patent Owner as minimal. *Id.* at 3 (quoting Consolidated TPG, 80).

Analysis

Under the Board’s rules, a petitioner’s reply “may only respond to arguments raised in the corresponding . . . patent owner response.” 37 CFR § 42.23(b) (2017); *see also Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (describing that under our rules, in *inter partes* review proceedings, a petitioner’s reply is “limited to a true rebuttal role” (citing 37 CFR §§ 42.104(b)(5), 42.23(b))). A petitioner’s reply is not an opportunity to “raise[] a new issue or belatedly present[] evidence,” but rather can “help crystalize issues for decision.” Consolidated TPG, 74.

We do not agree that Patent Owner’s statements in two telephone conferences or contentions in another *inter partes* review provide Petitioner an opportunity to belatedly present new argument or evidence regarding the public accessibility of *Berg*. The proper scope of reply to Patent Owner’s

⁵ A court reporter transcribed this telephone conference, however the transcript has not yet been entered as an exhibit in the proceedings.

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Response was not broadened by the indication in the July 2020 telephone conference, which occurred after that Patent Owner's Response had been filed, that Patent Owner would seek to depose Ms. Vassilkova if her affidavit was filed by Petitioner. Nor could it have been broadened retroactively, by Patent Owner's discussion of its position in a telephone conference, after the Petitioner's Reply was filed.

Patent Owner's position on this issue in a related *inter partes* review also does not raise the issue in these proceedings. We recognize that in certain situations evidence and positions in other proceedings may be considered in an *inter partes* proceeding. *See, e.g.*, 37 CFR § 42.51(b)(1)(iii) (requiring a party to serve relevant information inconsistent with a position advanced by that party); Consolidated TPG 48 (describing consideration of statements regarding claim construction made in other proceedings). However, Petitioner has not argued, and we do not apprehend, any reason why Patent Owner's argument in the related *inter partes* review should be considered in these proceedings.

Petitioner quotes a portion of the Consolidated TPG's provision that, "in response to issues arising from the Supreme Court's decision in *SAS* (138 S. Ct. at 1358), the Board will permit the petitioner, in its reply brief, to address issues discussed in the institution decision." Consolidated TPG, 73 (quoted in part at Opp. 2). However, after one intermediating sentence, the Consolidated TPG provides: "Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability." *Id.* We recognize that this is an unusual situation, in that Petitioner does not seek to raise a new issue, but rather to buttress a portion of its *prima facie* case, even though Patent Owner

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has not attacked that portion of Petitioner's case for unpatentability.

Nonetheless, Petitioner has not shown or attempted to show that this argument and the associated evidence could not have been presented earlier in support of its case of unpatentability, and it is obviously not submitted in rebuttal, as Patent Owner did not address the issue. We therefore agree with Patent Owner that Petitioner's arguments regarding the prior art status of Berg were improperly included in the Reply (Section III.B).

With respect to the proper remedy in such cases, the Consolidated TPG notes that "[t]he Board is not required to attempt to sort proper from improper portions of the reply or sur-reply" and that a reply that raises a new issue might not be considered. Consolidated TPG 74. As we acknowledged in our Order authorizing the motion to strike, "striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." *Id.* at 80 (quoted at Order Authorizing Mot. 3). However, in this case, Petitioner's characterization of Patent Owner's time and effort in addressing an untimely argument in its Sur-Reply as "minimal" and limited to the cost of deposing Ms. Vassilkova does not convince us that this is not that rare case. Opp. 3. Rather, depending on whether Patent Owner decides to address the prior art status of Berg in sur-reply, the burden might also involve filing additional evidence and related argument; this burden would be borne mostly by Patent Owner, unnecessarily in this situation in which the Patent Owner waived argument on the issue Petitioner seeks to buttress. *See* Mot. 1, Opp. 3. Therefore, we determine that this is a case in which an untimely argument and related evidence should be stricken from the brief.

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The affidavit of Ms. Vassilkova and the exhibit titled “Internet Archive Page Showing Library of Congress Catalog as of January 20, 1998” are referred to in the Reply only in the section of the Reply relating to the prior art status of Berg. Reply, 11–13. While a portion of the deposition of Patent Owner’s expert additionally is used in this section, Patent Owner does not argue, and we do not determine, that this portion of the deposition relates only to the prior art status of Berg and should be stricken.

Going forward, the panel will not consider, and the parties should not present arguments (including in Patent Owner’s Sur-reply and at the oral hearing, if requested) relating to (1) the untimely discussion in section III.B of the Reply; (2) the affidavit of Ms. Vassilkova; and (3) the exhibit titled “Internet Archive Page Showing Library of Congress Catalog as of January 20, 1998.”

Accordingly, it is:

ORDERED that Patent Owner’s Motion to Strike in each proceeding is granted as discussed above; and

FURTHER ORDERED that, in each proceeding, the panel will not consider, and the parties should not present arguments (including in Patent Owner’s Sur-reply and at the oral hearing, if requested) relating to (1) the untimely discussion in section III.B of the Reply in each proceeding; (2) the affidavit of Ms. Vassilkova (IPR2019-01278, Exhibit 1017; IPR2019-01279, Exhibit 1017); and (3) the exhibit titled “Internet Archive Page Showing Library of Congress Catalog as of January 20, 1998” (IPR2019-01278, Exhibit 1018; IPR2019-01279, Exhibit 1018).

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