Trials@uspto.gov
571-272-7822

Paper 34
Entered: May 1, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

UNIFI SCIENTIFIC BATTERIES, LLC
Patent Owner

Case IPR2013-00236
Patent 6,791,298 B2

Before MICHAEL R. ZECHER, JUSTIN T. ARBES, and MATTHEW R. CLEMENTS, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

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

A conference call in the above proceeding was held on April 24, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Zecher, Arbes, and Clements. Patent Owner requested the call to seek authorization to file a motion to strike Petitioner's reply (Paper 31) and the reply declaration of Dr. Leo F. Casey submitted with the reply (Exhibit 1026). The following issues were discussed.

Scheduling Order

Patent Owner requested clarification regarding the Scheduling Order (Paper 11) and, specifically, the filing of motions for observation on cross-examination. As discussed during the call, Patent Owner is authorized to file a motion for observation regarding the cross-examination testimony of Petitioner's reply witness, Dr. Casey, by DUE DATE 4 (May 14, 2014), and Petitioner is authorized to file a response by DUE DATE 5 (May 28, 2014). Each paper is limited to 15 pages. *See* 37 C.F.R. §§ 42.24(a)(1)(v), 42.24(b)(3).

Motion to Strike

During the call, Patent Owner raised five issues with respect to Petitioner's reply and accompanying declaration. A complete record of Patent Owner's arguments, and Petitioner's responses, may be found in the transcript of the conference call, which Patent Owner filed as Paper 33 in the instant proceeding.[1] Patent Owner argued that Petitioner's reply and Dr. Casey's declaration improperly assert a new claim interpretation, allege

[1] In the future, such transcripts should be filed as exhibits, rather than papers. *See* 37 C.F.R. § 42.63(a).

new grounds of unpatentability, and make new arguments based on different portions of the asserted prior art references than those relied on in the Petition. *See* 37 C.F.R. § 42.23(b) (a reply "may only respond to arguments raised in the corresponding . . . patent owner response"); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012) ("Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant's motion."). Petitioner disagreed that the reply and declaration are improper. After hearing from both parties, we took the matter under advisement.

Upon further review of Patent Owner's response, Petitioner's reply, and Dr. Casey's declaration, we are not persuaded that a motion to strike is warranted under the circumstances. A motion to strike is not, ordinarily, a proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope permitted under the rules. In the absence of special circumstance, we determine whether a reply and supporting evidence contain material exceeding the proper scope when we review all of the pertinent papers and prepare the final written decision. We may exclude all or portions of Petitioner's reply and newly submitted evidence, or decline to consider any improper argument and related evidence, at that time. We are not persuaded that the issue of the propriety of the reply and declaration should be resolved at this time via a motion to strike, rather than after all substantive briefing in the proceeding is completed. We will decide the matter at the time of the final written decision.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is not authorized to file a motion to strike Petitioner's reply and accompanying declaration.

PETITIONER:

Neil P. Sirota
Eliot D. Williams
BAKER BOTTS L.L.P
neil.sirota@bakerbotts.com
eliot.williams@bakerbotts.com

PATENT OWNER:

Patrick A. Doody
Bryan P. Collins
PILLSBURY WINTHROP SHAW PITTMAN LLP
patrick.doody@pillsburylaw.com
bryan.collins@pillsburylaw.com