

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 JONI Y. CHANG and JUSTIN T. ARBES, *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 May 19, 2014, among respective counsel for Petitioner and Patent Owner, and Judge Arbes.¹ Petitioner requested the call to address issues regarding Patent Owner's motion to exclude (Paper 36) filed on May 14, 2014.

Patent Owner argues in the motion that Petitioner's reply (Paper 31) and the reply declaration of Dr. Leo F. Casey submitted with Petitioner's reply (Exhibit 1026) should be excluded because (1) they are based on an incorrect claim interpretation, (2) Dr. Casey's testimony is "contradictory and unreliable," and (3) the reply and reply declaration make new arguments, not responsive to Patent Owner's response. Paper 36 at 1-10. As to the first two points, Petitioner argued during the call that they relate to the weight to be given to Dr. Casey's testimony, not its admissibility. As to the third point, Petitioner asserted that the issue of the proper scope of reply evidence is not appropriate for a motion to exclude. Petitioner cited the previous Order in this proceeding (Paper 34) where we refused to authorize a motion to strike the reply and declaration, as well as *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00017, Paper 42 (May 12, 2014), which involved a similar situation. Petitioner requested that the motion to exclude be dismissed. Patent Owner responded that the arguments made in its motion are proper, and referred to the objections it filed as Exhibit 2039. We took the matter under advisement.

Having reviewed the motion and considered the parties' positions, we are not persuaded that the first two portions of Patent Owner's motion to exclude should be dismissed at this time, but agree with Petitioner as to the

¹ A court reporter, retained by Petitioner, was present on the call. Petitioner filed the transcript of the call as Exhibit 1036.

third portion. Patent Owner's third argument appears to be the same argument it requested authorization to make in a motion to strike, which we denied. *See* Paper 34 at 2-4. Patent Owner contends that "Petitioner has attempted to inject multiple new grounds of unpatentability in its Reply, and has submitted Dr. Casey's reply declaration to support those new arguments." Paper 36 at 6. A motion to strike or exclude evidence normally is not the proper vehicle for resolution of a dispute regarding reply arguments and evidence exceeding the proper scope of a reply. A motion to exclude, for instance, must state why the evidence is inadmissible (e.g., based on relevance or hearsay), identify the corresponding objection in the record, and explain the objection. *See* 37 C.F.R. § 42.64(c); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

As stated in the previous Order, we will "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," and "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." Paper 34 at 3. Accordingly, the third portion of Patent Owner's motion to exclude (pages 6-10) addressing the alleged new arguments in Petitioner's reply and reply declaration is dismissed. Petitioner may file an opposition to the motion to exclude as to the remaining portions (pages 1-6) should it choose to do so.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's motion to exclude is *dismissed-in-part*, as explained herein, and the dismissed portion will not be considered on the merits.

Case IPR2013-00236
Patent 6,791,298 B2

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