

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ULTRATEC, INC.  
Petitioner

v.

SORENSEN COMMUNICATIONS, INC.,  
CAPTIONCALL, L.L.C., and  
WILMINGTON TRUST, NATIONAL ASSOCIATION  
Patent Owners

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Case IPR2013-00288  
U.S. Patent No. 8,379,801 B2

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Before 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 May 21, 2014, a telephone conference call was held between respective counsel for the parties and Judges Turner and Chang. Patent Owners initiated the conference call to seek: (1) guidance on whether a motion to strike is a proper mechanism to argue that Petitioner's reply contains new arguments and to exclude Petitioner's expert declaration filed in support of its reply; and (2) leave to file a motion for observation.

*Motion to Strike*

On April 16, 2014, Petitioner filed a reply (Paper 34) to Patent Owner's response (Paper 24). In support of its reply, Petitioner proffered a declaration of James A. Steel Jr. (Ex. 1021).

Patent Owner alleged that because no expert declaration was filed in support of the petition, Petitioner's reply declaration (Ex. 1021) is improper. Patent Owner believed that Mr. Steel's declaration should have been presented with the petition.

As explained by the Board during the conference call, neither a motion to strike nor a motion to exclude is a proper mechanism to present argument that a reply contains new arguments. The issue of whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the Board. The Board will determine whether a reply and/or evidence are outside the scope of a proper reply and evidence when the Board reviews all of the parties' briefs and prepares the final written decision. If there are improper arguments and/or evidence presented with a reply, the Board, for example,

may exclude the reply and/or the related evidence. Accordingly, the Board will take under consideration any alleged violations in due course with respect to Petitioner's reply and Mr. Steel's declaration (Ex. 1021).

*Motion for Observation*

During the conference call, the Board authorized Patent Owner to file a motion for observation regarding cross-examination of a reply witness, and Petitioner to file a response to such observation. As noted in the Scheduling Order (Paper 15), a motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). Any response to observation must be equally concise and specific.

An observation (or response) is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit \_\_, on page \_\_, lines \_\_, the witness testified \_\_.  
This testimony is relevant to the \_\_ on page \_\_ of \_\_. The  
testimony is relevant because \_\_.

Each observation should not exceed one short paragraph. The Board may decline consideration or entry of excessively long or argumentative observations (or responses). A motion for observation is limited to 15 pages, and a response is also limited to 15 pages.

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Accordingly, it is

ORDERED that Patent Owner is authorized to file a motion for observation regarding cross-examination of reply witness by DUE DATE 4 consistent with this order; and

FURTHER ORDERED that Petitioner is authorized to file a response to Patent Owner's observation by DUE DATE 5 consistent with this order.

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