

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTERNATIONAL BUSINESS MACHINES CORPORATION  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC  
Patent Owner.

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Case IPR2014-00180  
Patent 7,634,666

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Before DAVID C. McKONE, JAMES A. TARTAL, and MIRIAM L. QUINN,  
Administrative Patent Judges.

QUINN, Administrative Patent Judge.

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

An initial conference call in the above proceeding was held on May 15, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Quinn, Tartal, and McKone. The purpose of the call was to discuss any proposed motions the parties intend to file. Both Patent Owner and Petitioner filed a list of motions prior to the call. *See* Papers 13 (Petitioner’s Notice of Proposed Motions (“Petitioner’s List”)), 14 (Patent Owner’s List of Proposed Motions). A court reporter was present, and Petitioner’s counsel indicated that the transcript of the call will be filed as an exhibit. The following is a brief summary of the call.

A. MOTIONS SPECIFIED IN THE SCHEDULING ORDER

*Motion to Amend*

Patent Owner stated that it will file a contingent motion to amend. As discussed during the call, Patent Owner shall arrange a conference call no later than two weeks before the deadline to file the motion to amend to discuss the proposed motion to amend. *See* 37 C.F.R. § 42.121(a). The parties are further directed to the guidance provided in Case IPR2012-00027, Paper 26, dated June 11, 2013 (“Idle Free”), and Case IPR2013-00423, Paper 27, dated March 7, 2014 (“Toyota Motor Corporation”).

*Motions to Exclude*

Petitioner indicated that it may file a Motion to Exclude in due course. The parties are reminded that a motion to exclude is available to a party wishing to challenge the admissibility of evidence and to preserve an objection made previously. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012). A party following these guidelines may file a motion to exclude without prior authorization from the Board. The rule specifies as much and explains that a motion to exclude must identify the objections in the record and

must explain the objections. 37 C.F.R. § 42.64(c). Therefore, no authorization at this time is required.

*Motions for Observation*

Petitioner indicated that it may file Motions for Observations in due course. The parties are permitted to cross-examine reply declarants, and if necessary, a motion for observation regarding cross-examination of a reply witness may be filed by DUE DATE 4. As noted, in the Scheduling Order (Paper 11), 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). An observation 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 \_\_\_\_\_. That testimony is relevant to the \_\_\_\_\_ [stated or argued] on page \_\_\_\_, lines \_\_\_\_ of \_\_\_\_\_. The testimony is relevant because \_\_\_\_\_.

Each observation should not exceed one short paragraph. The Board may decline consideration or entry of argumentative observations. A motion for observation is limited to 15 pages.

*Request for Oral Argument*

Petitioner indicated that it may file a motion to request oral argument in this case. Per the Scheduling Order (Paper 11), the parties' request for oral argument must be filed by DUE DATE 4. A motion is not necessary.

**B. PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY**

Patent Owner sought authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) to seek discovery of alleged real parties-in-interest

not disclosed by Petitioner. Patent Owner argued that Petitioner's counsel represents defendants in the on-going district court cases and that Petitioner's communication with those defendants and agreements between Petitioner and those defendants are relevant to determining whether the defendants are real parties-in-interest. Petitioner argued that the discovery sought was not in the interests of justice because it constituted a fishing expedition unlikely to yield relevant information. The panel gave guidance during the call that, at this time, Patent Owner's request for authorization to file a motion for additional discovery based on the arguments presented was denied without prejudice. The fact that the same counsel represents Petitioner and other defendants in the pending district court cases is not, by itself, sufficient to show more than mere speculation of "control" of this proceeding by those defendants. *See Zoll Lifecor Corporation v. Philips Electronics North America Corp.*, IPR2013-00606, Paper 13 (March 20, 2014) (providing that the inquiry into whether a non-party is a real party-in-interest in the proceeding is not based on isolated facts, but rather must consider the totality of the circumstances).

#### C. PETITIONER'S VARIOUS MOTIONS

Petitioner identified numerous other "motions" in its Notice of Proposed Motions. In particular, the panel discussed with the parties the motions Petitioner labeled "contingent" (Petitioner's List, motions 6-16), all of which were denied as premature. The panel also discussed with the parties Petitioner's request to file discovery motions (Petitioner's List, motions 1-2) and determined that those motions were also premature in light of the fact that no depositions have been noticed or scheduled. We denied Petitioner's request to file the discovery motions discussed during the call.

Finally, the panel heard the parties' discussion regarding a request for guidance as to the extent and detail of legal support for objections during a deposition. In this regard, Petitioner requested authorization to file a motion to clarify the guidelines for objecting in a deposition (Petitioner's List, motions 3-5). Absent a specific discovery dispute regarding the propriety of any given objection, the parties were directed to the Trial Practice Guide, Appendix D, Testimony Guidelines, 77 FED. REG. at 48772, as the source of information regarding proper objections. Petitioner's request to file motions seeking clarification of objections was, therefore, denied.

D. SETTLEMENT

There was no report of settlement.

*Order*

It is

ORDERED that no motions are authorized at this time.

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