

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIAN NEWLAND COMPUTER CO., LTD.
Petitioner

v.

HAND HELD PRODUCTS, INC.
Patent Owner

Case IPR2013-00595
Patent 7,568,628

Before KEVIN F. TURNER, BRYAN F. MOORE, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

A conference call was held on June 11, 2014 between counsel for the parties and Judges Turner, Moore, and Boucher in response to Petitioner's request for authorization to file a motion to strike the declaration of Rob Hussey (Exhibit 2048). Counsel for Patent Owner indicated that the call was being transcribed. Patent Owner is requested to file the transcript as an exhibit as soon as it is available.

Petitioner contends that Patent Owner's response (Paper 26) includes only minimal argument for the nexus requirement for commercial success in demonstrating nonobviousness of the claims for which we instituted *inter partes* review. Petitioner further contends that portions of Mr. Hussey's declaration are argumentative and that reference in Patent Owner's argument to Mr. Hussey's declaration is designed to circumvent the page limit for Patent Owner responses. Patent Owner responds that Mr. Hussey's declaration includes statements of fact relevant to a final decision whether the claims are unpatentable. Patent Owner further responds that the argument presented in its response is sufficient to support its assertions, which are based on facts established by Mr. Hussey's declaration.

The Board may not consider arguments contained only in a declaration and not presented specifically within the response itself. Although we agree with Petitioner that, in the abstract, use of a pointer or citation to declaration testimony, without sufficient arguments and explanation in the response itself, improperly circumvents the page limit, we decline to authorize a motion to strike Mr. Hussey's declaration at this time. During the conference call, Petitioner acknowledged that portions of Mr. Hussey's declaration are directed to facts that may have probative value. It is inefficient, at this point in the proceeding, for the Board to familiarize itself sufficiently with the character of the statements made in Patent Owner's response and in Mr. Hussey's testimony to determine the degree to which Patent

Owner's commercial-success argument is entitled to weight. Petitioner has the opportunity to argue in its reply to Patent Owner's response that no weight should be afforded to Patent Owner's argument.¹

We take this opportunity to observe that the alternative of filing a motion to exclude Mr. Hussey's testimony under 37 C.F.R. § 42.64(c) would be inappropriate under the facts as they have been presented to us.

It is

ORDERED that authorization to file a motion to strike the declaration of Mr. Hussey (Exhibit 2048) is *denied*.

¹ We are mindful of Petitioner's concern that a perceived need to address the purportedly argumentative portions of Mr. Hussey's testimony within the fifteen-page limit for Petitioner replies, 37 C.F.R. § 42.24(c)(1), potentially impacts its ability to address other portions of Patent Owner's full argument. We do not find Petitioner's reasoning sufficiently compelling. Each party necessarily makes decisions how to present its position most effectively within the constraints of this proceeding.

IPR2013-00595
Patent 7,568,628

PETITIONER

Henry Petri

Margaux Aviguetero

James Murphy

NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP

henry.petri@novakdruce.com

margaux.aviguetero@novakdruce.com

james.murphy@novakdruce.com

PATENT OWNER

Bruce Rose

Christopher Douglas

ALSTON & BIRD LLP

bruce.rose@alston.com

christopher.douglas@alston.com