

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FLIR Systems, Inc.,  
Petitioner,

v.

Leak Surveys, Inc.,  
Patent Owner.

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Case IPR2014-00411 (Patent 8,426,813 B2)  
Case IPR2014-00434 (Patent 8,193,496 B2)

Before FRED E. McKELVEY, JAMES T. MOORE, and  
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

POST CONFERENCE CALL ORDER  
Conduct of Proceedings  
*37 C.F.R. § 42.5*

I. Background

On October 2, 2014, the PTAB received the following email:

Dear PTAB Staff,

I represent Petitioner, FLIR in the above referenced IPR proceedings. The proceeding is assigned to Judge James T. Moore for management. Counsel for the Patent Owner, Leak Surveys, is copied above.

Petitioner hereby requests a conference call to seek the Board's authorization to file a Motion to Submit Supplemental Information within 1 month from the September 5, 2014 institution date pursuant to 37 CFR 42.123(a). Based on the upcoming due date, Petitioner respectfully requests a teleconference today or tomorrow, October 3<sup>rd</sup>.

Petitioner has conferred with counsel for Patent Owner; Patent Owner has not taken a position at this time whether it would oppose or consent to our Motion, if authorized.

Regards,

Rick DeMille  
[counsel for Petitioner]

A conference call was held at approximately 1:00 p.m. (Eastern Time) on October 3, 2014.

Participants included Judges McKelvey, Moore, and Jefferson, as well as lead counsel for the parties.

The purpose of the conference call was for Petitioner to request authorization to file a motion to submit supplemental information.

37 C.F.R. § 42.123(a).

Exhibit 1007 and Exhibit 1011 were submitted with the Petition.

<b>Exhibit</b>	<b>Name</b>	<b>Identification</b>	<b>Date</b>
Ex. 1007	Merlin Brochure	Indigo Systems Corporation: The Ultimate Combination of Flexibility and Value in High-Performance Infrared Cameras (Rev. A 1/02)	©2002

<b>Exhibit</b>	<b>Name</b>	<b>Identification</b>	<b>Date</b>
Ex. 1011	Merlin User's Guide	Indigo Systems Corporation, MERLIN-MID, INSB MWIR CAMERA, USER'S GUIDE, Version 1.10, 414-0001-10	No date

In our Decision to Institute, we determined preliminarily that Exhibit 1007 was prior art as of 2002 based on a 2002 copyright notice.

We also determined preliminarily that Exhibit 1011 was prior art based on testimony.

The events, described below, came to our attention during the conference call.

After institution, and consolidation, of IPR2014-00411 and IPR2014-00434, Patent Owner timely objected to the admissibility of Exhibit 1007 and Exhibit 1011. 37 C.F.R. § 42.64 (b)(1).

In response to the Patent Owner's objection, on October 3, 2014, Petitioner timely served supplemental evidence on counsel for the Patent Owner. 37 C.F.R. § 42.64(b)(2).

We understand that the supplemental evidence consists of three declarations and additional documentary evidence.

According to Petitioner, the supplemental evidence overcomes Petitioner's objection to admissibility.

Further, according to Petitioner, the supplemental evidence is related to confirming a 35 U.S.C. § 102(b) (as opposed to a 35 U.S.C. § 102(a)) prior art date of both exhibits.

In addition to serving supplemental evidence, Petitioner sought authorization to file a motion to submit the same evidence as supplemental information.

During the conference call, Petitioner explained why it was seeking to submit the supplemental information.

Also during the conference call, the Patent Owner opposed stating five grounds in support of its opposition.

Petitioner had an opportunity to respond to the Patent Owner's position.

## II. Analysis

After an *inter partes* review is instituted, the Patent Owner may file a Patent Owner's Response. 37 C.F.R. § 42.120.

Prior to filing the response, the Patent Owner may (but does not have to) object to the admissibility of any evidence relied upon by the Petitioner in support of the Petition. 37 C.F.R. § 42.64(b)(1).

As noted above, in this case Patent Owner timely objected.

Within the time specified in the rules, the Petitioner served supplemental evidence which it believes overcome the objection to admissibility of Exhibit 1007 and Exhibit 1011.

The Patent Owner may elect (but does not have) to cross-examine the individuals testifying via the three declarations.

In any event, the Patent Owner may then address the *sufficiency* of Petitioner's evidence (Ex. 1007, Ex. 1011, and the supplemental evidence) in its Patent Owner's Response.

In addition, if the Patent Owner believes that evidence is inadmissible, the Patent Owner may preserve its objection by filing a motion to exclude within the time set for filing motions to exclude. 37 C.F.R. § 42.64(c).

Petitioner followed 37 C.F.R. § 42.64(b)(2) after the Patent Owner's objection by serving supplemental evidence.

Whether (1) the admissible evidence, as a whole, is sufficient on the merits based on the petition, response, and reply, and (2) independently whether any evidence should be excluded (37 C.F.R. § 42.64(c)), may be considered and resolved at the time we hear oral argument and render a Final Written Decision.

We understand that the declarations and documents said to make up the supplemental evidence are the same as the supplemental information sought to be submitted if a motion is authorized to submit supplemental information.

We see no need to authorize or consider a motion to submit supplemental information when the evidence in question (1) is known to the Patent Owner, (2) can be addressed on its merits by the Patent Owner in its Patent Owner's Response, and (3) potentially can be excluded from evidence with a successful motion to exclude (any motion to exclude should be limited to admissibility and should not serve as a basis for further arguing the merits).

We believe that the most efficient way to proceed in this particular instance is to have the declarations and documents come before us through the supplemental evidence rule (§ 42.64) as

opposed to the supplemental information rule (§ 42.123). *See* 37 C.F.R. § 42.1(b) (“This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”).

For the reasons given, we see no reason to authorize filing of a motion to submit supplemental information.

Petitioner is not prejudiced by our determination because the supplemental evidence will be before us.

Patent Owner is not prejudiced because it will have an early opportunity to cross-examine and address the merits in its Patent Owner’s Response and admissibility in a motion to exclude.

### III. Order

Upon consideration of the email and the discussion during the conference call, it is

ORDERED that Petitioner’s request for authorization to file a motion to submit supplemental information is *denied*.

FURTHER ORDERED that on or before **October 14, 2014**, Petitioner shall file as exhibits in this proceeding the supplemental evidence served on Petitioner on October 3, 2014.

IPR2014-00411, -00434  
Patents 8,426,813 B2 and 8,193,496 B2

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