

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SQUARE, INC.,  
Petitioner,

v.

PROTEGRITY CORPORATION,  
Patent Owner.

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Case CBM2014-00182  
Patent 8,402,281 B2

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Before KEVIN F. TURNER and MEREDITH C. PETRAVICK,  
*Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.207

INTRODUCTION

On January 28, 2015, a conference call was held between counsel for the parties and Judges Turner and Petravick. Petitioner requested the conference call to request that Exhibits 2012, 2014, 2018, 2021, 2023, 2024, and 2025 be

expunged from the record and that any corresponding argument in the Preliminary Response (Paper 8) be struck. According to Petitioner, the Exhibits and Preliminary Response includes new testimonial evidence in violation of 37 C.F.R. 42.207(c).

## DISCUSSION

37 C.F.R. § 42.207(a) states that a preliminary response “can include evidence except as provided in paragraph (c) of this section.” 37 C.F.R. § 42.207(c) state: “The preliminary response shall not present new testimony evidence beyond that already of record, except as authorized by the Board.” New testimony is testimony that was taken specifically for the purposes of the proceeding at issue. The Board may permit, in its discretion, new testimonial evidence in a preliminary response if the patent owner demonstrates that such evidence is in the interest of justice. Trial Practice Guide, 77 Fed. Reg. at 48764.

### *Exhibits 2012, 2014, 2021, and 2023–2025*

Exhibit 2012 is a transcript of a deposition of Dr. Michael I. Shamos taken on January 18, 2013; Exhibit 2014 is two pages from a document titled Report of Defendant Voltage Security, Inc.’s Expert Michael I. Shamos, Ph.D., J.D. Concerning Invalidity; and Exhibit 2023 is a document titled Supplemental Rebuttal Report of Ulf Mattsson dated October 17, 2012. These exhibits pre-date the August 29, 2014 filing of the Petition (Paper 3) and appear to have been prepared in connection with related case *Protegrity Corporation v. Voltage Security, Inc.*, Case No. 3:10-cv-755 (RNC) (D.Ct.).

Exhibit 2021 is a declaration of Ulf Mattson dated December 11, 2012; Exhibit 2024 is a document titled Protegrity Corporation’s Response to Ingrian Networks, Inc.’s First Set of Interrogatories dated April 13, 2009; and Exhibit 2025

is a document titled Rebuttal Report of Ulf Mattson dated October 17, 2012. These exhibits also pre-date the filing of the Petition and appear to have been prepared in connection with another related case *Protegrity Corporation v. Ingrian Networks, Inc.*, Case No. 3:08-cv-618 (RNC) (D.Ct.).

Given the above, and based upon the information presented during the call, we determine that Exhibits 2012, 2014, 2021, and 2023–2025 are not new testimonial evidence and are permitted to be included in the Preliminary Response. The testimony in these exhibits was prepared for the purposes of the related district court proceedings and not these proceedings. Exhibits 2012, 2014, 2021, and 2023–2025 will not be expunged.

#### *Exhibit 2018*

Exhibit 2018 is a declaration of Ulf Mattson signed on December 10, 2014, which is after the August 29, 2014 filing of the Petition, and includes a caption referencing this proceeding on the first page. Exhibit 2018 appears to have been prepared in connection with this proceeding.

Given the above and based upon the information presented during the call, we determine that Exhibit 2018 is new testimonial evidence that is not permitted to be included in the Preliminary Response pursuant to 37 C.F.R. 42.207(c). Exhibit 2018 will be expunged from the record, and we will not consider any reference or citation to Exhibit 2018 in the Preliminary Response.

Exhibit 2018 references Exhibits 2019–2036. As discussed above, Exhibits 2021 and 2023–2025 do not include any new impermissible testimonial evidence. We also determine that Exhibits 2019, 2020, 2022, and 2026–2036 do not include any impermissible new testimonial evidence. Exhibits 2019–2036 will not be expunged; however, we will consider these exhibits only if the exhibit, itself, is referenced or cited in the Preliminary Response, or other permitted filing.

ORDER

It is:

ORDERED that Exhibit 2018 be expunged from the record.

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