

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLIR Systems, Inc.,
Petitioner,

v.

Leak Surveys, Inc.,
Patent Owner.

Case IPR2015-00065 (Patent 8,426,813 B2)

Before JAMES T. MOORE, *Administrative Patent Judge*.

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

I. Background

At the request of the Patent Owner, a conference call was held on 25 March 2015 at approximately 9:30 a.m. (EST). Counsel for Patent Owner and Petitioner were present. Judges Moore and McKelvey were present for the Board.

The conference call was transcribed and a transcript will be made of record in due course.

The conference call was initiated by an email transmitted to the Board on 23 March 2015, reproduced on the next two pages:

IPR 2015-00065
Patents 8,426,813 B2

From: Kumar Vinnakota
Sent: Monday, March 23, 2015 10:20 AM
To: Trials
Cc: Richard Black; Joel Ard; Donald Puckett; Scott Born; DeMille, Rickard; Hetz, Joe; Emerson, Russ; rgabric@brinksgilson.com
Subject: FLIR Systems v. Leak Surveys: IPR2014-00411; IPR2014-00434; IPR2015-00065

Dear PTAB Staff:

Patent Owner Leak Surveys requests a timely conference call with the Board to discuss a recent development in the above consolidated IPR trials.

On Friday, March 20, 2015 Petitioner served on Patent Owner three new fact-witness declarations with accompanying exhibits. The declarations alone (without exhibits) consist of approximately 25 pages of new declaration testimony, and two of the declarations are from witnesses who previously had not provided declarations in any of these IPR trials. The declarations primarily (but not exclusively) address the authenticity of the Merlin documents, an issue that previously has been before the Board. See IPR2014-00411, Paper 45.

In its transmittal email, Petitioner purported to be serving the new declarations under 37 C.F.R §42.64(b)(2), which permits supplemental evidence in response to timely evidentiary objections served under §42.64(b)(1). But Petitioner's stated basis for the new evidence is its interpretation of the Patent Owner Response itself, which Petitioner reads to imply evidentiary objections (and which Patent Owner did file less than 10 days after institution of trial in the '065 IPR).

Patent Owner, on the other hand, contends that the Patent Owner response merely addressed the weight of certain evidence, and was not itself an evidentiary objection under §42.64(b)(1). This was the approach the Board suggested Patent Owner take. See IPR2014-00411,

Paper 45 at p. 6 (“In that merits response . . . Patent Owner, if it be so advised, may discuss the weight to be given Petitioner’s evidence related to the authenticity of the Brochure and User Guide.”)

Petitioner’s service of new and additional declarations on the authenticity of the Merlin documents seems to be inconsistent with the Board’s reasoning in its order denying Petitioner’s previous attempt to supplement with new declarations on this very issue. See *id.* (“One can immediately appreciate that there could be no end to relying on supplemental information followed by cross-examination.”)

The ‘065 case presents an unusual procedural posture, wherein Patent Owner timely objected in the 411 and 434 cases to certain evidence but was asked to take discovery on the same evidence in all three cases under the assumption that the ‘065 case would be instituted, and wherein Patent Owner was asked to file a full Patent Owner response less than 10 days after institution in the ‘065 case. Because of this unusual procedural posture, Patent Owner seeks timely guidance from the Board on the issues outlined above.

Thank you for attention to this matter.

Respectfully submitted,

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In a nutshell, Patent Owner objects to Petitioner's service of supplemental evidence pursuant to 37 CFR § 42.64(b)(2). According to the Patent Owner, it made no objections to the evidence, and as a consequence, no supplemental evidence should be permitted to be served or considered.

Petitioner points out that Patent Owner's response (Paper 51, filed in the '411 proceeding) was filed within 10 days of the decision on institution. Petitioner also points out that page 17 of Paper 51 observes that the Petitioner's reference, the "Merlin" reference, is said to lack authentication, and that the Patent Owner plans to file a motion to exclude. Petitioner urges that this is an objection to evidence, to which it may properly respond.

Petitioner requested permission to file a motion to file supplemental information pursuant to 37 CFR § 123(a).

Patent Owner requested permission to file the conference call transcripts, and for the Board to issue an order consolidating the '065 proceeding into the '411 and '434 proceedings.

We took the matters under advisement at the conclusion of the conference call.

II. Analysis

A. Was there an adequate objection to the evidence?

Patent Owner's Paper 51, which was filed March 6, 2015 in the '411 proceeding, states the following:

[Petitioner] FLIR's other witnesses (Richards, Malmberg and Graff) fared no better. These witnesses – all FLIR employees - provided testimony merely for the purpose of authenticating the Merlin References. Yet, after multiple declarations, supplemental declarations, and attorney-coached redirect examination – *FLIR has still been unable to prove the authenticity of its own documents as*

prior art. See Section VII. Indeed, as previously raised with the Board, the cross-examination of these witnesses raised substantial questions regarding their own personal knowledge of the documents and the genuineness of their declaration testimony. See Section VII. *Patent Owner will file a motion to exclude the Merlin References in light of this testimony*. But for present purposes, it should be noted that the cross-examination of these witnesses casts doubt not only on their credibility, but also raises questions regarding the process by which FLIR and its lawyers drafted their witness declarations in this case. *See id.*

Paper 51, page 17 (emphasis added).

Objections to evidence other than deposition evidence are provided for in 37 CFR § 42.64(b)(1), which recites:

(1) Objection. Any objection to evidence submitted during a preliminary proceeding must be served within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be served within five business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.

As the trial was instituted February 27, 2015 (Paper 25) and the Patent Owner response was served on March 6, 2015, the Patent Owner response is within the 10-day window for evidentiary objections. The response raises questions about the authenticity of the documents, and indicates that a Motion to Exclude will be filed.

Motions to Exclude are provided for in 37 C.F.R. § 42.64(c), which recites:

(c) Motion to exclude. A motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the

record in order and must explain the objections. The motion may be filed without prior authorization from the Board

In our view, the present record can reasonably be taken to demonstrate that Patent Owner has raised an objection to the evidence in the Petition. Patent Owner has indicated that the objection is on the basis of authentication, and specifically notes the grounds for it. More tellingly, Patent Owner indicates it intends to file a motion to exclude based upon those grounds, which is required to preserve the objection.

As Patent Owner has raised an objection, we determine that the Petitioner would be permitted in these circumstances under 37 C.F.R. § 42.64(b)(2) to serve supplemental evidence to cure the objection, so long as it was done within 10 days.

B. Other Matters

As the Petitioner may serve the supplemental evidence under 37 C.F.R. § 42.64(b)(2), we dismiss the Petitioner's request to file supplemental evidence under 37 CFR § 123(a).

We confirm our oral permission authorizing the Petitioner to file the served supplemental evidence in response to the objection with the Board.

We authorize the filing of the transcripts of the conference calls in this proceeding.

An order handling the consolidation of the proceedings will issue in due course.

IPR 2015-00065
Patents 8,426,813 B2

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