

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2015-00089
Case IPR2015-00092¹
Patent 6,546,002 B2

Before, GREGG I. ANDERSON, JON B. TORNQUIST, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this caption.

INTRODUCTION

At 2:30 PM on January 13, 2016, a conference call was held. The participants of record included counsel for International Business Machines Corporation (“Petitioner”), Joel Merkin, counsel for Intellectual Ventures II LLC (“Patent Owner”), Byron Pickard, a corporate representative of Patent Owner, Donald Coulman, and Judges Anderson, Tornquist, and Weinschenk. Oral argument is set for January 15, 2016, commencing at 1:30 PM Eastern time.

In an email from Petitioner dated January 12, 2016, the parties requested a call to discuss unresolved objections to Patent Owner’s demonstratives. Per the order granting the parties’ request for oral argument (“Order,” Paper 35 in both cases), the parties represent they have met and conferred, and were unable to resolve the objections identified below. *See* Order, 3.

DISCUSSION

The unresolved objections of Petitioner relate to Patent Owner’s slides 15, 35, 48, 65, and 67. In the email, Petitioner alleged “the slides depict and cite to paragraphs of IV’s expert’s declaration (Ex. 2005) that IV did not cite in its Patent Owner Response or any other paper.” The slides are pertinent to both IPR2015-00089 and IPR2015-00092.

Based on the argument presented by Patent Owner, the slides include the following content:

1. Slide 15 is a copy of paragraphs 40 and 41 of the Williams Declaration.
2. Slide 35 is a copy of paragraph 71 of the Williams Declaration.
3. Slide 48 is a copy of paragraph 81 of the Williams Declaration.
4. Slide 65 is a copy of paragraph 102 of the Williams Declaration.
5. Slide 67 is a copy of paragraph 104 of the Williams Declaration.

Patent Owner acknowledges that there is no pin cite to any of the above identified paragraphs of the Williams Declaration in Patent Owner's Response (Paper 19 in both cases). Patent Owner contends that the paragraphs are conclusions which are argued in the Response, and that the Response includes citations to other underlying support from the Williams Declaration.

Relying on *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 118 (Oct. 23, 2013) (“*CBS*”) and similar rulings of the Board, Petitioner argues the lack of prior citation to the referenced paragraphs precludes their use as demonstratives. Petitioner acknowledges that “similar arguments” to what is proposed in the slides were previously made in the Response.

In the Order, the parties were directed to *CBS* regarding the appropriate content of demonstrative exhibits. Order, 3. Oral argument is an opportunity to summarize the evidence and arguments but “nothing new can be presented, no new evidence, no new arguments.” *See CBS* at 2.

CBS further explained that the burden of showing the slide “does not present new argument or new evidence is on the party presenting the slide.” *CBS* at 4. As to whether testimony not cited in any of the papers may be included in a demonstrative exhibit, *CBS* further explained:

The Board explained that with regard to a party's own declaration witness, the party's own case should be developed within the paper which presented and relied on the declaration. Absent extraordinary circumstances, there is no provision in the rules for a party to “expand” the development of that testimony, if there is no more responsive paper to be filed under applicable rules.

CBS at 5.

To the extent slides 14, 35, 48, 65, and 67 include citations to the

Williams Declaration not included in the Response, Patent Owner is precluded from using them. Patent Owner may revise the slides to repeat similar arguments made in the Response, either by reproducing argument from the Response or by a fair and accurate summary of the argument.

Should Patent Owner revise the slides, the parties will meet and confer to insure there is no other objection to the revised slides. In the unlikely event the parties have additional issues regarding the use of the revised slides, they are to set up an additional conference call.

ORDER

It is

ORDERED that the Patent Owner may not, at the oral hearing, use the current slides 15, 35, 48, 65, and 67; and

FURTHER ORDERED that Patent Owner may revise the slides to fairly and accurately present similar arguments made in the Response.

IPR2015-00089
IPR2015-00092
Patent 6,546,002 B2

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