

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2015-00636 (Patent 8,917,822 B2)
Case IPR2015-00637 (Patent 8,908,838 B2)

Before WILLIAM V. SAINDON, BARBARA A. BENOIT, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

Benoit, *Administrative Patent Judge*.

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

On January 5, 2016, a conference call took place between Judges Saindon, Benoit, and Pettigrew and respective counsel for Petitioner, CaptionCall, L.L.C., and Patent Owner, Ultratec, Inc. The subject of the call was Patent Owner's request for authorization to file a motion to submit two supplemental declarations, one from Ms. Katie Kretschman and another

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from Mr. Paul Ludwick. A court reporter was on the conference call, and the transcript will be entered in the record.

Regarding Ms. Kretschman's supplemental declaration, Patent Owner explained that the proposed supplementation was in response to objections filed and served by Petitioner challenging Ms. Kretschman's qualifications and bases for her opinions presented in her declaration (Ex. 2016), which was filed in support of Patent Owner's Response (Paper 15).¹ See Paper 17, 2 (Petitioner's evidentiary objections to Ms. Kretschman's declaration). Patent Owner represented that, on December 15, 2015, it timely served Ms. Kretschman's supplemental declaration in accordance with 37 C.F.R. § 42.64(b)(2), which requires supplemental evidence be served within ten business days of service of Petitioner's objection. Patent Owner explained that its present request to file this supplemental evidence is intended to render unnecessary the filing of a Motion to Exclude Ms. Kretschman's declaration (Ex. 2016).

In response, Petitioner argued that filing Ms. Kretschman's supplemental declaration is unnecessary at this time because § 42.64 addresses this situation.

We agree with Petitioner. Patent Owner's request to file Ms. Kretschman's supplemental declaration is premature. Patent Owner has responded to Petitioner's evidentiary objection by serving Ms. Kretschman's supplemental declaration in accordance with 37 C.F.R. § 42.64(b)(2). If Petitioner is not satisfied that its objection has been overcome by Ms. Kretschman's supplemental declaration, Petitioner may preserve its

¹ Exhibit and Paper numbers refer to filings in IPR2015-00636 for illustrative purposes.

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objection by filing a Motion to Exclude. 37 C.F.R. § 42.64(c). At that time, in response to Petitioner's Motion to Exclude, Patent Owner may file the supplemental evidence with its Opposition to Petitioner's Motion to Exclude. Therefore, we will not grant authorization at this time for Patent Owner to file a motion to submit a supplemental declaration of Ms. Kretschman.

Also during the call, Patent Owner explained that it sought to supplement Mr. Ludwick's declaration (Ex. 2014) filed in support of its Response (Paper 15), which was filed on November 23, 2015. Patent Owner explained that it seeks to supplement the declaration of Mr. Ludwick to include a limited explanation to certain specific background facts and experiences on which Mr. Ludwick based his opinions. Patent Owner further explained that its proposed supplementation was responsive to the Final Written Decision in *CaptionCall, L.L.C. v. Ultratec, Inc.*, Case IPR2014-00780 (PTAB Dec. 1, 2015) (Paper 36).

As a preliminary matter, and in contrast to Ms. Kretschman's supplemental declaration discussed previously, Patent Owner's request to submit a supplemental declaration by Mr. Ludwick is not made in response to an objection by Petitioner and, thus, Mr. Ludwick's supplemental declaration would not be supplemental evidence. Rather, Mr. Ludwick's supplemental declaration is supplemental information that Patent Owner seeks to file more than one month after the date the trial was instituted (September 8, 2015). *See* 37 C.F.R. §42.123(b); Paper 8 (Decision to Institute). The late submission of supplemental information requires Patent Owner to make two showings—"[i] why the supplemental information reasonably could not have been obtained earlier, and [ii] that the

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consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. §42.123(b).

Petitioner objected to Patent Owner’s request, arguing that it did not meet the requirements for the late submission of supplemental information under 37 C.F.R. §42.123. Petitioner indicated that the supplemental information Patent Owner seeks to submit was available and so Patent Owner cannot meet the requirement of 37 C.F.R. §42.123 that the information could not reasonably have been obtained earlier.

We agree with Petitioner. We are not persuaded that the information from Mr. Ludwick that Patent Owner now seeks to submit was not available at the time of Patent Owner’s Response (November 23, 2015) when Mr. Ludwick’s declaration (Ex. 2014) was submitted. Furthermore, we agree with Petitioner that Patent Owner fails to explain adequately the three-week delay between issuance of the Final Written Decision in IPR2014-00780 (December 1, 2015), which Patent Owner asserts is the impetus for seeking to submit this information, and Patent Owner’s request for authorization to supplement Mr. Ludwick’s declaration (December 23, 2015).

Patent Owner’s argument that the Board can excuse, under 37 C.F.R. §42.5(c)(3), the untimely submission of Mr. Ludwick’s supplemental declaration similarly is unpersuasive. Patent Owner does not provide a sufficient reason that allowing Mr. Ludwick to supplement his declaration at this late stage of the proceeding is in the interest of justice.

Therefore, we will not grant authorization for Patent Owner to file a motion to submit a supplemental declaration of Mr. Ludwick.

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ORDER

Accordingly, it is:

ORDERED that Patent Owner is not authorized to file a motion to submit supplemental declarations in IPR2015-00636 or IPR2015-00637, and

FURTHER ORDERED that Patent Owner shall file the transcript of the conference call in PRPS as an exhibit in each of IPR2015-00636 and IPR2015-00637.

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