

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMKOR TECHNOLOGY, INC.
Petitioner

v.

TESSERA, INC.
Patent Owner

Case IPR2013-00242
Patent 6,046,076

Before KEVIN F. TURNER, JUSTIN T. ARBES, and
CARL M. DeFRANCO, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on March 24, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Turner and Arbes.¹ Patent Owner requested the call to seek authorization to file a motion to strike portions of Petitioner's reply (Paper 102) and exhibits submitted with the reply.

Patent Owner argued that Petitioner's reply contains improper new argument regarding one of the prior art references at issue in this proceeding, U.S. Patent No. 4,681,718 ("Oldham") (Ex. 1003). *See* 37 C.F.R. § 42.23(b) (a reply "may only respond to arguments raised in the corresponding . . . patent owner response"); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012) ("Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant's motion."). According to Patent Owner, Petitioner relied on one embodiment described in columns 1, 3, and 7-9 of Oldham in its petition, but relied on a different embodiment allegedly described in, for example, column 16 and claim 17 of Oldham in its reply. *See, e.g.*, Paper 1 at 45-50; Paper 102 at 1-2. Patent Owner argued that Petitioner admitted as much in the first paragraph of its reply by stating that Patent Owner's response ignored a "second, more relevant embodiment" allegedly teaching "encapsulating 'an electrical component' without filler." *See* Paper 102 at 1. Patent Owner argued that the newly cited portions of Oldham directed to the

¹ A court reporter, retained by Patent Owner, was present on the call. Patent Owner shall file the transcript of the call as an exhibit in this proceeding.

“second” embodiment were never addressed or relied on in the petition, and it would be prejudicial to Patent Owner to have to address the improper new arguments in depositions and at the oral hearing in this proceeding.

Petitioner responded that the different portions of Oldham cited in the petition and reply describe the same embodiment (allegedly claimed in claim 17 of Oldham). Petitioner stated that it only pointed out the additional portions in the reply in response to Patent Owner’s response argument that the originally cited excerpts were ambiguous. Patent Owner disputed Petitioner’s characterization of the various cited portions of Oldham as allegedly describing the same embodiment. The Board took the matter under advisement.

Upon further review of the petition, reply, and Oldham, we are persuaded that a motion to strike is appropriate under the particular factual circumstances of this case. Patent Owner has made a threshold showing that Petitioner in its reply is relying on a different embodiment of Oldham from that which was relied on in the petition. Briefing from the parties is warranted to determine whether the reply arguments properly respond to Patent Owner’s response. *See* 37 C.F.R. § 42.23(b). Patent Owner in its motion shall cite the specific portions of Petitioner’s reply and exhibits that Patent Owner believes should be stricken.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a motion to strike portions of Petitioner’s reply and exhibits submitted with the reply, limited to five pages, by March 31, 2014; and

FURTHER ORDERED that Petitioner is authorized to file an opposition, limited to five pages, by April 3, 2014.

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Patent 6,046,076

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