

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VEEAM SOFTWARE CORPORATION
Petitioner

v.

SYMANTEC CORPORATION
Patent Owner

Case IPR2013-00141 (Patent 6,931,558)
Case IPR2013-00142 (Patent 6,931,558)
Case IPR2013-00143 (Patent 7,191,299)
Case IPR2013-00150 (Patent 7,093,086)¹

Before FRANCISCO C. PRATS, MEREDITH C. PETRAVICK, THOMAS L. GIANNETTI, and TRENTON A. WARD, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

¹ This paper addresses issues that are identical in the listed cases. The parties are not authorized to use this heading style for any subsequent papers.

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At the request of counsel for Petitioner, via emails dated March 21 and April 1, 2014, the Board held a telephone conference in these cases on April 1, 2014. The participants were counsel for the parties, including attorneys Gordon and Richetti, and Administrative Patent Judges Petravick, Prats, Giannetti, and Ward.

1. Joint Request to Waive Rules 37 C.F.R. § 42.53(d)(2) and (d)(4)

Prior to the conference, the Board informed the parties that it has granted a joint request to waive the time limits set forth in the above rules relating to notices and scheduling for the depositions of Drs. Levy and Green.

2. Request to Extend Date for Filing Observations on Cross-examination.

Prior to the conference, the Board informed the parties that the due date for Petitioner to file motions for observations on cross-examination of Drs. Levy and Green is extended to Due Date 5 in the Scheduling Order. Furthermore, Patent Owner is authorized to file a response to such observations on or before Due Date 6.

3. Motion to Compel

In IPR2013-00150, Petitioner requested authorization to file a motion to compel production of certain documents (a deposition transcript and expert report) that Petitioner believes contain inconsistent relevant information on claim construction. *See* 37 C.F.R. § 42.51(b)(1)(iii). The documents sought by

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Petitioner are subject to a protective order in a parallel district court litigation involving Patent Owner and a third party, Acronis. Patent Owner does not object to producing the documents, but states that Acronis has refused to grant permission. After discussing the matter, Petitioner agreed to limit its production request to the portion of the transcript (expected to be a few pages) discussing the construction of the term “capturing.” The Board observed that this approach should eliminate any confidentiality concerns on the part of Acronis and facilitate production of the requested information. The parties agreed to meet and confer on this issue to set a time for production.

4. Motions to Strike

Petitioner seeks authorization to file various motions to strike.

A. Petitioner contends that Patent Owner’s replies on its motions to amend and the accompanying declarations of Drs. Green and Levy go beyond the proper scope permitted for replies under the Board’s rules and should be stricken. After further discussion, the Board took the matter under advisement. Having reviewed the materials objected to by Petitioner, the Board agrees with Petitioner as to the reply in IPR2013-00141, IPR2013-00142, and IPR2013-00150 for the following reasons:

The scope of a reply is limited. A reply may only respond to arguments raised in a corresponding opposition. 37 C.F.R. § 42.23(b). A reply is not an opportunity to raise new issues or provide additional evidence that could reasonably have been provided in the motion. A reply that raises a new issue or

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belatedly presents evidence will not be considered and may be returned. *Office Trial Practice Guide*, 77 Fed Reg. 48756, 48767 (August 14, 2012). The Board will not attempt to sort proper from improper portions of the reply. *Id.*

In three of the four proceedings, Patent Owner has filed replies that go beyond the permissible scope. For IPR2013-00150, the Green Declaration in Support of Patent Owner’s Reply (IPR2013-00150 – Ex. 2019, “Green Reply Declaration”) is in effect a 50-page supplemental declaration. Appendix B of the Green Reply Declaration is a 39-page single-spaced claim chart purporting to provide 35 U.S.C. § 112 support for the claim amendments. The contents of Appendix B are in addition to the § 112 support information provided at pages 4-6 in the Motion to Amend. Appendix C lists 191 references or documents that Dr. Green testifies he reviewed, and concludes that he did not discover “any art that anticipates or renders obvious Claims 32-34.” Green Reply Decl. at ¶ 65. The majority of the references included in Appendix C were not previously addressed by either party. The Levy Reply Declarations filed in IPR2013-00141 (Ex. 2014) and IPR2013-00142 (Ex. 2014) are similar in nature to the above Green Reply Declaration. These declarations are not limited to responding to arguments raised by Petitioner’s opposition. Instead, they raise new issues and provide additional evidence that could have been provided in the original motion to amend. Therefore, they do not meet the standard set forth above.

This is not true, however, of the Levy Reply Declaration (Ex. 2011) in IPR2013-00143. That declaration appears to be more directed to arguments raised

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in the opposition and does not include lengthy appendices raising new issues and presenting new evidence.

We therefore conclude that the Green and Levy Reply Declarations in IPR2013-00141, IPR2013-00142, and IPR2013-00150 are not proper replies and should be expunged. Patent Owner will be given an opportunity to revise these replies and resubmit them within five business days.

B. Petitioner contends that Patent Owner's four motions to exclude evidence (one filed in each of the four proceedings) should be stricken for various reasons, including the fact that the motions are improper argument, and further that filing of the motions was not authorized by the Board. After further discussion, the Board took the request under advisement. Having reviewed the submissions, the Board denies the motions to exclude in the following respects:

1. All four Patent Owner motions to exclude allege that Petitioner has "mischaracterized" expert testimony in the opposition to Patent Owner's motions to amend. *See, e.g.*, IPR2013-00141, Paper 33, 8-14. Patent Owner relies on Rule 403 of the Federal Rules of Evidence. *Id.* at 9. We are not convinced by Patent Owner's arguments that this testimony should be excluded. At best, Patent Owner's arguments go to the weight of that evidence, which the Board can determine from the transcripts provided. The reliance on Rule 403 is misplaced. The Board is capable of making this determination without being confused, misled, or prejudiced by this testimony. Accordingly, we deny each motion to strike this testimony.

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2. In the motion to exclude filed IPR2013-00050, Patent Owner makes the additional argument that the Petitioner “improperly relies on hypotheticals.” Paper 39, 1-6. For the above reasons, we are not convinced that this is a sufficient basis to exclude the testimony.

For the foregoing reasons, it is

ORDERED that counsel for Petitioner and Patent Owner shall meet and confer promptly (within five business days) to set a date for production of the deposition transcript pages requested by Petitioner;

FURTHER ORDERED that Patent Owner’s replies on its motions to amend in IPR2013-00141, 142, and 150, and the accompanying declarations of Drs. Levy and Green, are stricken and expunged from the record of these proceedings, without prejudice to Patent Owner filing, within five business days of entry of this order, substitutes that comply with the guidelines set forth above, namely, that the replies are limited to addressing points specifically raised by Patent Owner in its oppositions that were not previously addressed and not foreseeable to Patent Owner when it filed its motions to amend;

FURTHER ORDERED that Patent Owner’s motions to exclude evidence are each denied with prejudice to the extent they are directed to supposedly “mischaracterized” expert testimony and allegedly improper reliance on hypotheticals. In responding to these motions, Petitioner need not address these arguments.

FURTHER ORDERED that Petitioner’s outstanding requests for authorization to file motions to strike are dismissed as moot.

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