

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZETEC, INC.  
Petitioner

v.

WESTINGHOUSE ELECTRIC CO.  
Patent Owner

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Cases IPR2014-00384  
Patent 6,823,269

Before HOWARD B. BLANKENSHIP, KEVIN F. TURNER, and  
NEIL T. POWELL, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

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Patent Owner, Westinghouse Electric Co., requested a conference call to request authorization to include a declaration regarding the public availability of one of the documents cited by Petitioner, Zetec, Inc., in its petition. Respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Turner, and Powell, were present on the conference call, which occurred on May 1, 2014.

Prior to the conference call, in email correspondence with the parties, we indicated that 37 CFR § 42.107(c) provides that a patent owner preliminary response "shall not present new testimony evidence beyond that already of record, except as authorized by the Board." We also indicated that any such new testimony evidence would have to be in the interests of justice to the overall proceeding for the Board to authorize it. Patent Owner indicated that the new declaration that it wanted to submit would meet the "interests of justice" standard for new testimonial evidence. Petitioner indicated its opposition to any submission of new testimony evidence with the preliminary response.

Because of the short period before Patent Owner would need to submit its preliminary response, May 5, 2014, we indicated that we would provide a decision on whether to authorize the declaration submission with the preliminary response during the conference call. This order memorializes the discussion and decisions reached therein.

Patent Owner argued that the Begley document, which is asserted in many of the grounds of unpatentability proffered in the petition, was not sufficiently accessible to the public interested in the art. Patent Owner alleged

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that the Begley document includes additional pages, not included with the copy of the document filed as an Exhibit (Ex. 1018), that discussed confidentiality restrictions associated with the document. Patent Owner indicated that a declaration to be submitted would address the public availability of the Begley document and would demonstrate that Begley was not publicly assessable so as to be considered prior art applicable in an *inter partes* review. Petitioner indicated that the version of Begley submitted was the same version it had obtained without the additional pages.

Patent Owner argued that it would be within the interests of justice because the Board could arrive at an incorrect decision in considering the Begley document which should not be considered a printed publication. We do not agree. Under 37 CFR § 42.107(c), a patent owner preliminary response "shall not present new testimony evidence beyond that already of record, except as authorized by the Board." Patent Owner will have the opportunity to include new testimonial evidence with the patent owner response, if trial is instituted, countering the availability of any document. Additionally, Patent Owner will have the ability to object to the evidence. As such, we were persuaded that Patent Owner had additional avenues under the Rules, such that authorizing new testimony evidence, beyond that already of record, would not be in the interests of justice.

In response to a query from Patent Owner, we indicated that the alleged additional pages of Begley, and arguments thereto, could accompany the preliminary response. Under 37 CFR § 42.107(a), "[t]he response can include evidence except as provided in paragraph (c) of this section." Petitioner

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objected to the inclusion of the additional pages, asserting that it would prejudice the view of the Begley document and Petitioner would not have any opportunity to counter that evidence prior to a possible institution. We were not persuaded that the Rules require non-new testimonial evidence to be excluded from a preliminary response. Patent Owner is certainly allowed to question the teachings and/or availability of a document cited in a petition. Although it may not have been necessary, we specifically authorized the alleged additional pages of the Begley document as evidence with the preliminary response.

#### Order

It is

ORDERED that authorization to file new testimony evidence beyond that already of record with the preliminary response is *denied*;

FUTHER ORDERED that Patent Owner is authorized to file the alleged additional pages of the Begley document as evidence.

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