

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-00504
Patent 7,382,771

Before MICHAEL W. KIM, PATRICK R. SCANLON, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*

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

On July 17, 2014, a conference call was held between counsel for the parties and Judges Kim, Scanlon, and Kalan. Counsel for Patent Owner requested the call to seek authorization to file a four-page Supplement to the Patent Owner Preliminary Response (“Supplement”) to address Petitioner’s Updated Mandatory Notices filed on June 25, 2014 (Paper 9). Counsel for Patent Owner indicated that a court reporter was on the call, and Petitioner did not oppose.

The Patent Owner presented the following timeline, which Petitioner did not dispute. On March 10, 2014, Petitioner filed a Petition for *inter partes* review in the instant proceeding. Paper 1; “Pet.” The Petition, under the section entitled “Real Party in Interest,” indicates that the real-party-in-interest is Motorola Mobility LLC, and further indicates that Google, Inc. has more than 10% ownership in Motorola Mobility LLC. Pet. 1. On June 18, 2014, Patent Owner filed a Preliminary Response. Paper 7; “Prelim. Resp.” In the Preliminary Response, Patent Owner asserts that the Petition’s indication that Google, Inc. has more than 10% ownership in Motorola Mobility LLC and does not meet the identification of real-party-in-interest requirement set forth in 35 U.S.C. § 312(a)(2), and that because this is an unambiguous statutory requirement that cannot be waived, the Board must deny the Petition. On June 25, 2014, Petitioner filed an Updated Mandatory Notice indicating that both Motorola Mobility and Google, Inc. are real-parties-in-interest. On July 1, 2014, counsel for Patent Owner contacted counsel for Petitioner concerning the Updated Mandatory Notice. Both parties agree that Google, Inc. acquired Motorola Mobility LLC more than 21 days prior to the filing of the Updated Mandatory Notice. A decision on whether or not to institute a trial in this proceeding is due on September 18, 2014.

During the call, counsel for Patent Owner advanced the following additional factors in support of its request for authorization: (1) the Updated Mandatory Notice is a relevant fact concerning Patent Owner’s case-dispositive arguments concerning real-party-in-interest, and given that the

Updated Mandatory Notice was filed after the filing of the Preliminary Response, it would be equitable to allow Patent Owner to respond; (2) the Preliminary Response was less than the 60 pages which Patent Owner was allowed, and thus Patent Owner should be permitted essentially to use some of those pages at this time; (3) that Patent Owner could file the Supplement within around one week; (4) that 37 C.F.R. § 42.8(a)(3) regarding the filing of Updated Mandatory Notices requires that a party file such updates within 21 days of any change in information, and that Petitioner violated the rule because Google, Inc. acquired Motorola Mobility more than 21 days prior to the filing of the Updated Mandatory Notice; (5) that the analysis in paper 13 of *ZOLL Lifecor Corp. v. Philips Electronics North America Corp.*, IPR2013-00606 (PTAB Mar. 20, 2014) supports Patent Owner's position that the Petition should be denied on the basis of Patent Owner's argument concerning real-party-in-interest; (6) that Patent Owner informed Petitioner that its Updated Mandatory Notice was not in compliance with the rules, and also informed Petitioner that the proper route to provide such information to the Board was to request authorization to file (a) an Updated Mandatory Notice or (b) a Corrected Petition, and that Petitioner did not take either action; (7) that counsel for Patent Owner requested the call shortly after the filing of the Updated Mandatory Notice and after conferring with counsel for Petitioner; and (8) that the Board would benefit from Patent Owner's application of the facts in this case to its analysis of the statutes, rules, and cases cited herein.

Counsel for Petitioner indicated that they did not oppose Patent Owner's request to supplement necessarily, but would request the opportunity to file a response if the Board granted Patent Owner's request. Counsel for Petitioner indicated further that it filed the Updated Mandatory Notice within 21 days of the filing of the Preliminary Response, and thus was in compliance with 37 C.F.R. § 42.8(a)(3). Counsel for Petitioner indicated additionally that it disagreed with Patent Owner concerning the applicability of *ZOLL Lifecor* to the facts in this proceeding, and that Patent Owner was not prejudiced by the filing of the Updated Mandatory Notice.

In response to Petitioner's request, counsel for Patent Owner indicated that if the Board granted Petitioner's request to file a response, it requested authorization to file a reply.

The Board indicated that it would take the above facts, statutes, rules, and case law into account when determining whether to institute trial in this proceeding, and asked counsel for Patent Owner whether that obviated the need for Patent Owner's request. Counsel for Patent Owner indicated that it appreciated the Board's consideration, but that it would still prefer to file a Supplement.

Counsel for Patent Owner requested additionally that it be permitted to file the transcript of this call as an exhibit in this proceeding. Counsel for Petitioner did not oppose.

There is no pre-authorization to file supplements in these proceedings. After considering the above, we are not persuaded that the Supplement is warranted, and thus exercise our discretion under 37 C.F.R. § 42.5 in

denying Patent Owner's request. The Board has been well-apprised of the applicable facts, statutes, rules, and case law, as well as the respective positions of the parties, both via the papers filed to date in this case, as well as the substance of this call. Under these circumstances, we determine that we are capable of applying the indicated facts to the indicated statutes, rules, and case law, and are not persuaded that the Board would benefit from additional briefing from either party. Finally, we grant Patent Owner's request to file the transcript of the call, ensuring that the Board will not fail to consider any fact, statute, rule, or case law cited by Patent Owner during the call.

ORDERED that Patent Owner's request for authorization to file a four-page Supplement to address Petitioner's Updated Mandatory Notices is DENIED; and

FURTHER ORDERED that Patent Owner's request to file the transcript of this call as an exhibit in this proceeding is GRANTED. Patent Owner shall submit the transcript with a one-page cover sheet indicating the exhibit number only. No other papers are permitted to be filed.

IPR2014-00504
U.S. Patent No. 7,382,771

For PETITIONER:

Theodore G. Brown, III
Christopher Schenck
Robert Curylo
John Alemanni
KILPATRICK TOWNSEND & STOCKTON LLP
tbrown@kilpatricktownsend.com
cschenck@kilpatricktownsend.com
rcurylo@kilpatricktownsend.com
jalemanni@kilpatricktownsend.com

For PATENT OWNER:

Brenton R. Babcock
Ted M. Cannon
KNOBBE, MARTENS, OLSON & BEAR, LLP
2brb@knobbe.com
2tmc@knobbe.com