

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WIRELESS SEISMIC, INC.,
Petitioner,

v.

FAIRFIELD INDUSTRIES, INC.,
Patent Owner.

Case IPR2014-01113
Patent 7,124,028 B2

Before JAMESON LEE, JO-ANNE M. KOKOSKI, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

Introduction

A conference call was held on October 27, 2014. The participants were respective counsel for the parties and Judges Lee, Kokoski, and Kalan. Counsel for Petitioner used the conference call to request authorization to file supplemental information, prior to entry of any Board decision on whether to institute *inter partes* review. The status of the proceeding is that on October 21, 2014, Patent Owner filed a Preliminary Response. Paper 6. Specifically, the request is directed to the filing of deposition excerpts,¹ from related district court litigation, of one of Patent Owner's named inventors in U.S. Patent No. 7,124,028 B2 ("the '028 patent"). According to Petitioner, the deposition testimony relates to the meaning of "array" and "seismic" and is inconsistent with the claim construction position taken by Patent Owner in the Preliminary Response with regard to "seismic data," "seismic acquisition," and "array." We heard arguments from both parties. The request is *denied*.

Discussion

Because the proposed submission is intended to address the content of Patent Owner's Preliminary Response, Petitioner in effect is asking for authorization to file a reply to the Preliminary Response. The Board's procedures for *inter partes* review proceedings do not provide for such a reply. Nevertheless, the Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by the applicable rules. 37 C.F.R. § 42.5(a).

¹ The deposition was taken on October 7, 2014.

We are not persuaded, however, that Petitioner should be authorized to submit the deposition excerpts in a reply.

First, the issue of claim construction depends heavily on the understanding of one with ordinary skill in the art in light of the patent specification, and not so much, if at all, on what an inventor himself thinks of the meaning of a claim term. Petitioner also had the opportunity, in filing its Petition, to obtain the opinion, in that regard, of any expert witness it desired to retain.

Second, counsel for Petitioner informed the Board during the conference call that the inventor was discussing the meaning of “seismic,” not the specific terms “seismic data” and “seismic acquisition” that have been construed by Patent Owner. Third, in the Petition, Petitioner did not construe the claim terms “seismic data” and “seismic acquisition,” relying instead on the plain and ordinary meaning of those terms. It is difficult to see even how the inventor’s testimony has much to do with the plain and ordinary meaning of terms, as determined from an objective standard. In that regard, Petitioner’s alleged inconsistency is not substantively significant.

Fourth, Petitioner desires only to submit the deposition excerpts, without any explanation of the context. Such a submission, without context, categorically would not be helpful to the Board. Also, Petitioner does not explain in what manner Patent Owner would be allowed an opportunity to file a surreply in response to Petitioner’s submission. Fifth, during the conference call, counsel for Patent Owner stated that although Patent Owner opposes Petitioner’s request, Patent Owner affirmatively and unequivocally represents to the Board that nothing

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in the deposition excerpts is inconsistent with any position taken by Patent Owner in its Preliminary Response.

Conclusion

For all of the above-stated reasons, we are not persuaded that Petitioner should be authorized to file the deposition excerpts in a reply to the Preliminary Response.

It is

ORDERED that Petitioner's request to file, as supplemental information to its Petition, deposition excerpts of Patent Owner's named inventor in related district court litigation, prior to a Board decision on whether to institute *inter partes* review, is *denied*.

PETITIONER:

Dorothy Whelan
Steven Katz
FISH & RICHARDSON P.C.
Whelan@fr.com
IPR39148-0002IP1@fr.com

PATENT OWNER:

George Quillin
James De Vellis
FOLEY & LARDNER LLP
gquillin@foley.com
jdevellis@foley.com