

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC. and T-MOBILE US, INC.,
Petitioner,

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner.

Cases IPR2015-00015 (Patent 5,915,210)
IPR2015-00017 (Patent 5,590,403)
IPR2015-00018 (Patent 5,659,891)¹

Before JONI Y. CHANG, SCOTT A. DANIELS, and JASON J. CHUNG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

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

¹ This Order addresses issues that are identical in all three above-identified proceedings. Therefore, we exercise our discretion to issue one Order to be filed in each of the proceedings. The parties, however, may not use this style heading in any subsequent papers without prior authorization.

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On October 31, 2014, a conference call was held between respective counsel for the parties and Judges Chang, Daniels, and Chung. Petitioner, T-Mobile USA, Inc. and T-Mobile US, Inc. (collectively “T-Mobile”), requested the conference call to seek clarification on 37 C.F.R. § 42.6(a)(3), concerning incorporation by reference, and to request leave to file a corrected declaration in each of the above-identified proceedings. Patent Owner, Mobile Telecommunications Technologies, LLC (“M-Telecom”), opposed. We considered both parties’ arguments and the specific facts before us. In light of the circumstances, T-Mobile’s request is *granted*.

Improper Incorporation by Reference and Combination of Documents

On October 3, 2014, T-Mobile filed each of its Petitions with, *inter alia*, two Exhibits: (1) a Declaration of Dr. Behnaam Aazhang (Ex. 1017²); and (2) a copy of the Declaration of Dr. Apostoloski Kakaes that was filed by Apple Inc. (“Apple”) in *Apple Inc. v. Mobile Telecommunications Technologies, LLC*, Case IPR2014-01032 (PTAB June 27, 2014) (Ex. 1003).

Each of the T-Mobile Petitions cites to both Declarations for support. For instance, the Petition filed in IPR2015-00017 provides:

Additional explanation and support for each ground is set forth in Dr. Behnaam Aazhang’s declaration, Ex. TMO1017, which adopts and incorporates by reference the relevant parts of the declaration of Dr. Kakaes, Ex. TMO1003 (“Kakaes”), from the Apple IPR.

Paper 1, 4.

² For the purpose of clarity and expediency, we treat IPR2015-00017 as representative, and all citations are to IPR2015-00017 unless otherwise noted.

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For example, as described by Dr. Kakaes and adopted by Dr. Behnaam Aazhang—both of whom are authorities in the field of wireless communication—Linguist describes a communications system that includes antenna towers for transmission of information in a simulcast manner. Linguist, Ex. TMO1004 at 3:51-60, 4:2-8; *see also* Kakaes at ¶ 27.

Id. at 14–15.

The Declaration of T-Mobile’s expert witness, Dr. Aazhang, incorporates by reference a large portion of the Declaration of Apple’s expert witness, Dr. Kakaes. Specifically, Dr. Aazhang testifies:

I note that Dr. Kakaes’ Declaration performs essentially the same analysis and comes to the same conclusions that I come to myself. Therefore rather than preparing paragraphs of my own declaration that would contain essentially the same analysis as in Dr. Kakaes’ Declaration, *I hereby adopt certain portions of the Dr. Kakaes’ Declaration as if they were my own, and incorporate them by reference into my declaration; specifically, ¶¶ 17-65 of Dr. Kakaes’ Declaration*, which include a brief overview of the ’403 patent and an analysis of certain subject matter in the three references.

Ex. 1017 ¶ 20 (emphasis added).

During the conference call, T-Mobile argued that the provisions of 37 C.F.R. § 42.6(a)(3) do not apply to Dr. Aazhang’s Declaration, as the rule only prohibits incorporating *arguments* by reference, and Dr. Aazhang’s Declaration contains *testimonial evidence* and not arguments. We disagreed with T-Mobile’s narrow interpretation of the rule.

As we explained during the conference call, 37 C.F.R. § 42.6(a)(3) in its entirety provides:

Incorporation by reference; combined documents. Arguments must not be incorporated by reference from one document into

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another document. Combined motions, oppositions, replies, or other combined documents are not permitted.

T-Mobile's argument narrowly focused only the first word of the first sentence of the rule, and failed to consider the rule as a whole. Notably, the second sentence provides "[c]ombined motions, oppositions, replies, or other combined documents are not permitted." Here, the present record shows that T-Mobile essentially combined Dr. Aazhang's Declaration with the Declaration of Apple's expert witness. Such a combination of documents clearly is not permitted under 37 C.F.R. § 42.6(a)(3).

Early Correction Would Provide for Clarity

During the conference call, T-Mobile also requested leave to file a corrected Declaration of Dr. Aazhang. M-Telecom opposed, alleging that T-Mobile should have conducted its own legal research earlier and made the correction before filing of the Petitions. M-Telecom further argued that granting T-Mobile the authorization to correct Dr. Aazhang's Declaration would prejudice M-Telecom because such correction is substantive.

We are not persuaded, however, that correcting Dr. Aazhang's Declaration to expressly include the materials that have been incorporated by reference would introduce substantive changes. As T-Mobile pointed out during the conference call, each Petition was filed with both Declarations, and it clearly cites to both Declarations for support. *See, e.g.*, Paper 1, 4, 14–15 (reproduced previously); Exs. 1003, 1017. More importantly, each Petition provides direct citations to the Declaration of Apple's expert witness and to the prior art references. *Id.*

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At this early stage of the proceedings, we also are not persuaded that correcting Dr. Aazhang's Declaration, without introducing any substantive change, would prejudice M-Telecom. M-Telecom was served on October 3, 2014, with a copy of each Petition and supporting evidence, including both Declarations. Paper 1. The Patent Owner Preliminary Response is due on January 15, 2015, in IPR2015-00018, and the Patent Owner Preliminary Responses are due on January 20, 2015, in IPR2015-00015 and IPR2015-00017. M-Telecom has adequate time to prepare its Patent Owner Preliminary Responses. M-Telecom did not articulate, nor can we discern, a sufficient reason as to why correcting the format of Dr. Aazhang's Declaration would impact M-Telecom's ability to timely file its Patent Owner Preliminary Responses. In fact, the corrected Declaration, most likely, would clarify the record and simplify discovery.

Conclusion

In consideration of the foregoing, it is hereby:

ORDERED that T-Mobile is authorized to file in each of the above-identified proceedings, within five business days from the entry of this Order: (1) a corrected Declaration of Dr. Aazhang to expressly include the materials that have been incorporated by reference, without introducing any substantive change, and (2) a corrected Petition to change the citations correspondingly; and

FURTHER ORDERED that, should T-Mobile file a corrected Declaration of Dr. Aazhang and a corrected Petition in accordance with this Order, T-Mobile must file redline versions, as exhibits, to show the changes:

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(1) between Dr. Aazhang's initial Declaration and corrected Declaration;
and (2) between the initial Petition and the corrected Petition.

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