

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE, INC.,  
Petitioner,

v.

VISUAL REAL ESTATE, INC.,  
Patent Owner.

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Cases<sup>1</sup>

IPR2014-01338 (Patent 7,389,181 B2)

IPR2014-01339 (Patent 7,389,181 B2)

IPR2014-01340 (Patent 7,929,800 B2)

IPR2014-01341 (Patent 8,078,396 B2)

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Before MICHAEL R. ZECHER, BEVERLY M. BUNTING, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

ORDER

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

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<sup>1</sup> This Order addresses issues that are identical in all four cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2014-01338 (Patent 7,389,181 B2)  
IPR2014-01339 (Patent 7,389,181 B2)  
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IPR2014-01341 (Patent 8,078,396 B2)

## I. DISCUSSION

A conference call in the above proceedings was held on September 9, 2015, amongst respective counsel for Petitioner, Google Inc., and Patent Owner, Visual Real Estate, Inc., and Administrative Patent Judges Zecher, Bunting, and Cherry. No court reporter was present on the call.

Patent Owner requested the call seeking authorization to file a motion to strike or expunge Exhibit 1010 from the record or, in the alternative, authorization to file a Patent Owner Sur-reply.<sup>2</sup> In particular, Exhibit 1010 is the Rebuttal Declaration of Dr. John R. Grindon filed by Petitioner as support for arguments made in its Reply (Paper 23, “Reply”) to contravene arguments made by Patent Owner in its Patent Owner Response (Paper 22, “PO Response”). Patent Owner alleges that the Rebuttal Declaration of Dr. Grindon is untimely and unfair because Patent Owner has been discussing the potential cross-examination of Dr. Grindon with Petitioner since the institution of trial in this proceeding and Patent Owner filed its Patent Owner Response on June 4, 2015. Patent Owner also argued that Dr. Grindon’s Rebuttal Declaration raised new arguments and contentions not found in the Petition or Patent Owner Response.

Petitioner countered that Patent Owner did not request additional discovery regarding Dr. Grindon or ask the Board to compel such discovery. Petitioner also argued that Patent Owner injected Dr. Grindon into this proceeding by submitting his prior testimony from unrelated cases to support Patent Owner’s arguments in these proceedings. Petitioner submits that, due

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<sup>2</sup> For purposes of convenience, we refer only to papers filed in Case IPR2014-01338.

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to Patent Owner's own actions, Dr. Grindon's testimony is proper rebuttal. Petitioner also argued Dr. Grindon's testimony does not contain new arguments and merely seeks to rebut arguments that Patent Owner raises in its Patent Owner Response.

We note that Patent Owner, in both its Patent Owner Preliminary Response and Patent Owner Response, relies on Exhibit 2002 as support for its arguments. *See, e.g.*, PO Resp. 11 (citing Ex. 2002 ¶¶ 28, 39 (internal citations omitted)). Exhibit 2002 is a Declaration of Dr. Grindon filed by Petitioner in an unrelated proceeding<sup>3</sup> involving U.S. Patent Nos. 7,239,760; 7,577,316; 7,805,025; and 7,813,596, which are distinct from the challenged patents in these proceeding. Ex. 2002. In the unrelated proceeding, Dr. Grindon "testified about a patent in the same family as Di Bernardo (Ex. 1005) from the perspective of a person of ordinary skill in the art in 2000 (the priority date of that particular DiBernardo patent)." Reply 1.

Thus, Petitioner was allowed to respond to these characterizations of Dr. Grindon's prior testimony by presenting arguments in its Reply, along with this new Rebuttal Declaration of Dr. Grindon, Exhibit 1010, explaining that testimony. As for Patent Owner's contention that Dr. Grindon's testimony also raises new arguments and claim constructions, those arguments and claim constructions appear to be in response to arguments raised first by Patent Owner in both its Patent Owner Preliminary Response and Patent Owner Response. Moreover, the record reflects that Petitioner is making Dr. Grindon available for cross-examination by Patent Owner on

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<sup>3</sup> *See Vederi, LLC v. Google, Inc.*, No. 2:10-cv-07747 (C.D. Cal.), D.I. 50-1.

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September 15, 2015. Paper 25. As such, Patent Owner will have adequate opportunity to inform us regarding the sufficiency of the cross-examination testimony of Dr. Grindon in a potential Motion for Observation, as well as at the oral hearing scheduled for October 28, 2015. Petitioner noted correctly during the conference call that we are capable of weighing the credibility of the evidence. We are well-positioned to review the evidence and arguments of record, and will assign Exhibit 1010 the appropriate weight in making a final determination as to the patentability of the challenged claims. Further, we are capable of evaluating whether any argument by Petitioner in its Reply is newly made or merely responsive to an argument raised by Patent Owner. Thus, Patent Owner's arguments do not establish a basis for striking Exhibit 1010 or allowing Patent Owner to file a Sur-reply.

## II. ORDER

Upon consideration of the parties' contentions, it is:

ORDERED that Patent Owner's request for authorization to file a motion to strike or expunge Exhibit 1010 from the record is *denied* because that Exhibit 1010 is responsive to arguments and evidence first presented by Patent Owner; and

FURTHER ORDERED that Patent Owner's request for authorization to file a Patent Owner Sur-reply is *denied* for the reasons articulated above.

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