

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SILICON LABORATORIES, INC.,
Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,
Patent Owner.

Cases
IPR2015-00615 (Patent 7,075,585 B2)
IPR2015-00626 (Patent 7,265,792 B2)

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

Decision Denying Authorization for Motion to Strike
37 C.F.R. §§42.6(a)(3), 23(b)

On February 22, 2016, at Patent Owner's request, a conference call was conducted between respective counsel for the parties and Judges Kauffman, Anderson, and Boucher. A court reporter was present. Paper 25 ("Tr.").¹

Patent Owner contends that portions of Petitioner's Reply (Paper 21) are beyond the scope of Patent Owner's Response (Paper 17). Additionally, Patent Owner argues that portions of Petitioner's Reply improperly incorporate attorney arguments only found in the Holberg Reply Declaration (Ex. 1061) and the Holberg Supplemental Reply Declaration (Ex. 1063). *See* Tr. 4; 37 C.F.R. §§ 42.6(a)(3), 42.23(b). Patent Owner requests permission to file a motion to strike pages 1 through 4 of Petitioner's Reply and the pertinent portions of the Holberg Declarations. Tr. 9.

During the call we stated that in addition to a Motion to Strike, the Board has dealt with similar situations by permitting the Patent Owner to file a paper identifying those portions of the Petitioner's reply that are allegedly beyond the scope of Patent Owner's response ("the list approach"). We then asked Patent Owner if such a filing would adequately serve Patent Owner's interests. Tr. 9:17–12:1. Patent Owner responded that the Motion to Strike better protects Patent Owner's interests because if the identified portions remain in the record, Petitioner may argue regarding those portions on appeal. *Id.*

Patent Owner identified two Board cases as support for Patent Owner's request. Tr. 16–17 (citing IPR2015-00372, Paper 39 and

¹ Unless otherwise stated, we reference the papers and exhibits of IPR2015-00626. Similar papers are filed in IPR2015-00615.

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CBM2015-00037, Paper 21). Petitioner identified a Board case as support for Petitioner's position. Tr. 18 (CBM2014-00131, Paper 56).

In IPR2015-00372, Paper 39, the Board authorized a Motion to Strike and an opposition (but no reply). The Motion has not been decided, and it appears the Board will make the determination as part of the final decision. We emphasize this was only authorization for such a motion and was not a decision on that motion.

In CBM2015-00037, Paper 21, the Board authorized Patent Owner to file a two-page list "providing the location and a concise description of any portion of the Petitioner's Reply that Patent Owner wishes to draw to the Board's attention," and authorized Petitioner to file a response of similar length. Paper 21, 2–3. Contrary to Patent Owner's contention, this case supports the list approach (versus a Motion to Strike).

In CBM2014-00131, Paper 56, the Patent Owner sought authorization to file a Motion to Exclude portions of Petitioner's Reply. The Board denied the request, stating that the Board will determine the proper scope of Petitioner's Reply as part of the final written decision.

The primary distinction between a Motion to Strike approach and the list approach is that with the motion there is a potential to strike some portions of the record, while in the latter approach even portions that are not considered remain in the record. We prefer the list approach so that the record is complete. Then, should the Board incorrectly determine that portions of Petitioner's Reply are beyond the scope of Patent Owner's Response, those portions remain in the record for consideration on appeal.

We authorize Patent Owner to submit a paper in the form of a list providing the location and a concise description of any portion of the

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Petitioner's Reply that Patent Owner wishes to draw to the Board's attention with regard to exceeding scope or improper incorporation. *See* 37 C.F.R. §§ 42.6(a)(3), 42.23(b). This paper may not exceed five pages, may not contain argument, and is due no later than three business days from the entry of this order.

We authorize Petitioner to submit a response, itemized to correspond to Patent Owner's submittal, with what Petitioner regards as the material contained in the Patent Owner Response that triggered or caused the Petitioner to include in its Reply each item listed by Patent Owner and/or where each item listed by Patent Owner appears in the Petition. This paper may not exceed five pages, may not contain argument, and is due no later than three business days from the Patent Owner's submittal described above.

During the call we recognized Patent Owner's desire as the moving party to submit a reply to Petitioner's opposition. *See* Tr. 17–18. Having considered that request and the cases cited by Patent Owner we conclude that Patent Owner's interests are adequately served without such a reply.

The Board will consider the information submitted by each party in making the final written decision.

It is ORDERED that the parties are authorized to file the above-discussed papers consistent with the requirements and deadlines set forth in this Order.

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