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Paper 50
Entered: July 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner,
v.
AT&T INTELLECTUAL PROPERTY I, L.P. and
AT&T INTELLECTUAL PROPERTY II, L.P.,
Patent Owners.[1]

Case IPR2015-01227 (Patent 7,907,714 B2)[2]
Case IPR2015-01536 (Patent 8,855,147 B2)

Before MICHAEL R. ZECHER and SHEILA F. McSHANE,
Administrative Patent Judges.

PER CURIAM.

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

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[1] AT&T Intellectual Proper I, L.P., is the Patent Owner in Case IPR2015-01227, whereas AT&T Intellectual Property II, L.P. is the Patent Owner in Case IPR2015-01536.

[2] This Order addresses similar issues in all the referenced cases, therefore, we issue a single Order to be filed in each case. The parties are not authorized to use this style of caption in any other filings.

I. DISCUSSION

On July 5, 2016, an email communication was received from Patent Owner renewing its request for authorization to file a sur-reply in each of the cases identified above. Patent Owner's request stated that it was seeking leave to file sur-replies limited in scope to the following issues: (1) the issue relating to antedating the An provisional application presented in the Patent Owner Response filed in Case IPR2015-01227; and (2) the issue relating to antedating the Amit non-provisional application[3] presented in the Patent Owner Response filed in Case IPR2015-01536. Patent Owner argued that it bears the burden of production as to these antedating issues, and in previous cases before the Board, under similar circumstances, leave was granted to permit a sur-reply.

By email of July 8, 2016, Petitioner stated that it did not oppose Patent Owner's request to file short sur-replies limited to the antedating issues raised in the Patent Owner Responses identified above, albeit subject to certain conditions. Petitioner requested that each sur-reply be limited to five (5) pages and Patent Owner not be permitted to introduce new, additional evidence or rebuttal testimony with each sur-reply.

The Board has authorized patent owners to file sur-replies in order to allow responses to petitioner's reply arguments relating to antedating prior art references, recognizing patent owner's burden under these circumstances. *See, e.g., HTC Corp. v. NFC Tech., LLC.*, Case IPR2014-01198, Paper 45, slip op. at 3–5 (PTAB Nov. 19, 2015) (recognizing that patent owner bears

[3] In its July 5, 2016 email, Patent Owner erroneously referred to the Amit "provisional" application, and later clarified that it sought to limit any sur-reply to issues associated with the Amit "non-provisional" application.

the burden of production regarding actual reduction to practice for purposes of antedating a prior art reference and granting patent owner's request to file a sur-reply limited to the antedating issue). Under similar circumstances presented here, we determine that good cause has been provided to warrant the grant of leave to file limited sur-replies in the respective cases.

Therefore, we authorize the filing of a sur-reply in each case, limited to five (5) pages, and limited in scope to providing responses to the arguments presented in the Patent Owner's Responses relating to antedating the An provisional application in Case IPR2015-01227 and relating to antedating the Amit non-provisional application in Case IPR2015-01536. No new, additional evidence or rebuttal testimony is permitted.

II. ORDER

Accordingly, it is

ORDERED that Patent Owner's sur-replies are limited to five (5) pages and due no later than July 18, 2016; and

FURTHER ORDERED that Patent Owner may not introduce new, additional evidence or rebuttal testimony with each sur-reply.

IPR2015-01227 (Patent 7,907,714 B2)
IPR2015-01536 (Patent 8,855,147 B2)

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