

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.,
Patent Owner.

Case IPR2015-01227
Patent 7,907,714 B2

Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5 and 42.7(a)

I. DISCUSSION

In an Order dated August 25, 2016, we authorized Patent Owner, AT&T Intellectual Property I, L.P. (“AT&T”), to file a second sur-reply limited in scope to addressing an argument presented by Petitioner, Cox Communications, Incorporated (“Cox”), in its Reply (Paper 48, 3–23) that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under 35 U.S.C. § 102(e). Paper 61, 3. Although we did not state explicitly in the Order that AT&T was not permitted to introduce new, additional evidence or rebuttal testimony with its second sur-reply, we nonetheless do not authorize AT&T to file such evidence or testimony.

On September 2, 2016, AT&T filed its second sur-reply (Paper 62), along with a Supplemental Declaration of Dr. Robert Akl, D.Sc. (Ex. 2052) and the file history of U.S. Patent Application No. 08/878,966—otherwise known as the An reference (Ex. 2053). On September 6, 2016, we received an email correspondence from Cox seeking a conference call to discuss expunging Exhibits 2052 and 2053 because, according to Cox, these exhibits exceeded the permitted scope of the second sur-reply and were filed without our express authorization.

The general nature of a sur-reply is to respond to arguments and evidence that each party already had the opportunity to brief. A sur-reply is not an invitation to introduce or file new evidence and testimony. In this case, both parties already have had an opportunity to brief the issue as to whether Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e). Paper 9, 17, 42–52; Paper 40, 44–53; Paper 48, 3–23. As we stated in the Order dated August 25, 2016, we only afforded AT&T an opportunity

to file a second sur-reply because there was uncertainty surrounding AT&T's initial request for authorization to file a sur-reply, as well as the fact that the U.S. Court of Appeals for the Federal Circuit issued a decision in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Circ. 2015) after Cox filed its Revised Amended Petition. Paper 61, 3. Moreover, this proceeding has progressed to the point where the parties' discovery periods have closed, i.e., post-oral argument. As a result, it would be unfair to allow AT&T to introduce new, additional evidence or rebuttal testimony at such a late stage of the proceeding. Lastly, we note that the parties have stipulated to progressively later DUE DATES 1 through 5 multiple times. Papers 30–33, 39, 52. Based on extraordinary circumstances, we moved DUE DATES 6 and 7 to accommodate what was, at the time, an alleged conflict that arose in the course of real party in interest discovery initially pursued by AT&T. Paper 38, 2–3. By accommodating the parties in this manner—specifically, AT&T—we are left with roughly two and half months to issue a Final Written Decision within the one-year statutory time frame. 35 U.S.C. 316(a)(11) (“requiring that the final determination in an inter partes review be issued no later than 1 year after the date [of the Decision on Institution]”).

For all these reasons, we exercise our authority under 37 C.F.R. 42.7(a) to expunge Dr. Akl's Supplemental Declaration (Ex. 2052) and the file history of the An reference (Ex. 2053). We also exercise our authority under 37 C.F.R. 42.7(a) to expunge AT&T's second sur-reply (Paper 62) because this paper is bound inextricably to the new, additional evidence and rebuttal testimony that falls outside the authorized scope permitted by our Order entered August 25, 2016. Nonetheless, we will exercise our discretion under 37 C.F.R. § 42.20(d) to afford

AT&T one last time opportunity to file a second sur-reply limited in scope to addressing Cox's Reply argument (Paper 48, 3–23) that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e). To be clear, no new, additional evidence or rebuttal testimony of any kind is permitted to be introduced or filed with AT&T's second sur-reply. AT&T, however, is permitted to rely upon evidence and testimony already of record in this proceeding.

II. ORDER

Accordingly, it is:

ORDERED that, pursuant to 37 C.F.R. 42.7(a), AT&T's second sur-reply (Paper 62), Dr. Akl's Supplemental Declaration (Ex. 2052), and the file history of the An reference (Ex. 2053) are expunged from the record of this proceeding;

FURTHER ORDERED that, pursuant to under 37 C.F.R. § 42.20(d), AT&T is authorized to file a second sur-reply limited in scope to addressing Cox's Reply argument (Paper 48, 3–23) that Cox is entitled to rely on the filing date of the An provisional application to qualify the An reference as prior art under § 102(e); and

FURTHER ORDERED that AT&T's second sur-reply is limited to seven (7) pages and due no later than September 12, 2016;

FURTHER ORDERED that AT&T shall not file or introduce new, additional evidence or rebuttal testimony of any kind with its second sur-reply; and

FURTHER ORDERED that Cox is not authorized to file a responsive submission.

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