Trial@uspto.gov
571.272.7822

Paper No. 69
Filed: October 13, 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.,
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.*

DECISION
Denying Patent Owner's Renewed Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner, AT&T Intellectual Property I, Limited Partnership ("AT&T"), filed a Renewed Request for Rehearing under 37 C.F.R. § 42.71(d) concerning an Order entered on September 7, 2016 (Paper 63). Paper 68 ("Req. Reh'g"). As background, we authorized AT&T to file a Second Sur-reply following the oral argument in this proceeding. Paper 61. In the Order at issue, we expunged AT&T's first attempt to file a Second Sur-reply, along with a Supplement Declaration of Dr. Robert Akl, D.Sc., and the file history of the An reference, for a number of reasons, one of which being that "a sur-reply is not an invitation to introduce or file new evidence and testimony." Paper 63, 2–3. We afforded AT&T another opportunity to file a Second Sur-reply—which AT&T indeed filed (Paper 64)—but we did not permit AT&T to introduce or file any new, additional evidence or rebuttal testimony of any kind with this Second Sur-reply. Paper 63, 4.

AT&T seeks reconsideration of our expungement of its first attempt to file a Second Sur-reply, as well as the new evidence and testimony introduced and filed therewith. Req. Reh'g 1. According to AT&T, our expungement of these documents was improper for the following two reasons: (1) we misapprehended or overlooked the facts and circumstances surrounding AT&T's submission of new evidence and testimony with its first attempt to file a Second Sur-reply; and (2) we denied AT&T its rights

under due process and the Administrative Procedure Act ("APA"). *Id.* at 1–11.[1]

As we explain below, we have considered the arguments presented by AT&T in its Renewed Request for Rehearing, but we discern no reason to modify the Order at issue. As a consequence, we *deny* AT&T's Renewed Request for Rehearing.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id*. With this in mind, we address the arguments presented by AT&T in turn.

[1] In its Request for Rehearing, AT&T invites us to introduce email exchanges between both parties and the Board into the record that we previously expunged from the record in an Order entered on September 22, 2016 (Paper 67). Req. Reh'g 2. We decline AT&T's invitation for two reasons. First, apart from AT&T's attempt to introduce these emails into the record by preferentially summarizing them in its Renewed Request for Rehearing, they are not part of the written record. *See* 37 C.F.R. § 1.2 (stating that "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office"). Second, these emails, at best, include mere attorney arguments. It is well settled that attorney arguments that are unsupported by factual evidence are of little probative value. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

III. ANALYSIS

A. AT&T's Second Sur-reply

As an initial matter, there is no statutory or regulatory provision that provides AT&T the right to file a sur-reply. *Accord Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (confirming there is "no rule [that] provides patent owners the right to file [sur-replies] to a petitioner's Reply"). Given the absence of any statutory or regulatory provision governing a sur-reply, it follows that there also is no statutory or regulatory provision governing what, if anything, we must allow AT&T to file or introduce when we exercised our discretion under 37 C.F.R. § 42.20(d) to allow AT&T to file its Second Sur-reply.

To the extent that AT&T argues that 35 U.S.C. § 316(a)(8) governs what we must allow AT&T to introduce and file with its Second Sur-reply, we do not agree. *See* Req. Reh'g. 4. This statute "provid[es] for the filing by the patent owner of *a response to the petition* under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response." 35 U.S.C. § 316(a)(8) (emphasis added). A plain reading of this statute indicates that it applies to a patent owner response to a petition—not a discretionary sur-reply.

In further support of its argument that we must allow AT&T to introduce and file new evidence and testimony with its Second Sur-reply, AT&T directs us to a previous Board decision in *Apple Inc. v. SightSound Techs., LLC*, Case CBM2013-00020, slip op. at 2 (PTAB May 15, 2014) (Paper 100). *See* Req. Reh'g 7–8, 10. This previous Board decision is not

precedential and not binding on this panel. In any event, our review of this previous Board decision reveals that it is distinguishable from the circumstances presented here because it did not implicate the U.S. Court of Appeals for the Federal Circuit's decision in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015)—specifically, whether the petitioner had met its burden of demonstrating that "[a] reference patent [was] entitled to claim the benefit of the filing date of its provisional application." *Id.* at 1381.

Putting aside the lack of binding authority governing a sur-reply, there are at least two additional considerations that guided our decision not to allow introduction or filing of new evidence and testimony with the Second Sur-reply following the oral argument. First, AT&T already was on notice that "a sur-reply is not an invitation to introduce or file new evidence and testimony" because we did not permit AT&T to introduce or file such evidence or testimony when we exercised our discretion to allow AT&T to file its First Sur-reply prior to the oral argument. Paper 50, 3 (stating that "[AT&T] may not introduce new, additional evidence or rebuttal testimony with [its First Sur-reply]"). Second, it is undisputed that Petitioner, Cox Communications, Incorporated ("Cox")—and not AT&T—carries the burden of demonstrating that An (Ex. 1005) qualifies as prior art to U.S. Patent No. 7,907,714 B2 (Ex. 1001, "the '714 patent") under 35 U.S.C. § 102(e)(2) based on the An provisional application (Ex. 1006) filed on October 23, 1996. Even though Cox has the burden with respect to this particular issue, we nonetheless exercised our discretion to afford AT&T the last opportunity to be heard. We maintain that introducing or filing new evidence and testimony at such a late stage in trial, especially after the party

with the burden, i.e., Cox, already presented argument and evidence on this issue in the Petition, Reply, and during oral argument, would be unfair. *See* Paper 63, 3.

B. Due Process

The Federal Circuit explained in *Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360 (Fed. Cir. 2016) that "as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible under the APA." *Id.* at 1366. The Federal Circuit further explained that "[t]he critical question . . . is whether [a party] received 'adequate notice of the issues that would be considered, and ultimately resolved, at that hearing.'" *Id.* at 1366–67 (internal citation omitted). In addition, the Federal Circuit has recognized that we have discretion to consider a patent owner's position regarding purported new arguments or evidence in a motion for observation, during oral argument, or in a sur-reply. *Belden*, 805 F.3d at 1081–82.

In this case, Cox put AT&T on notice in its Petition that it intended to rely upon An as prior art to the '714 patent under § 102(e)(2). *See* Paper 9, 4, 17, 42–52; Ex. 1014 (Declaration of Professor Nader Mir, Ph.D.) ¶ 101. AT&T had the opportunity to respond to the prior art status of An in its Preliminary Response (*see generally* Paper 12) and in its Request for Rehearing on the Decision on Institution (*see generally* Paper 15), yet AT&T chose not to raise this issue until after the institution of trial. Cox first became aware that the prior art status of An was in dispute only after AT&T introduced argument and evidence in its Patent Owner Response that (1) the challenged claims of the '714 patent were entitled to claim the benefit of U.S. Provisional Application No. 60/042,680, filed on April 3, 1997; and

(2) the An provisional application does not provide sufficient written description support for the claims of An, in accordance with the Federal Circuit's decision in *Dynamic Drinkware*. *See* Paper 40, 46–53.

In response, Cox presented a claim chart in its Reply mapping the written description of the An provisional application onto the claims of An. Paper 48, 8–23 (citing Ex. 1027 (Reply Declaration of Dr. Mir) ¶ 26). After Cox introduced this An claim mapping in its Reply, AT&T was afforded an opportunity to cross-examine Dr. Mir regarding his reply testimony on this particular issue (Ex. 2051), file its Motion for Observation (Paper 56, 2–5), argue the issue during the oral argument (*see* Paper 65, 74:3–76:19), and file a Second Sur-reply—albeit post-oral argument—that was limited to addressing the An claim mapping. Contrary to AT&T's assertions, the record clearly demonstrates that AT&T was given sufficient notice of Cox's argument that An qualified as prior art to the '714 patent under § 102(e)(2), and it was given an adequate opportunity to respond to Cox's mapping of the written description of the An provisional application onto the claims of An.

IV. CONCLUSION

For the foregoing reasons, AT&T has not persuaded us that we misapprehended or overlooked the facts and circumstances surrounding AT&T's submission of new, unauthorized evidence and testimony with its first attempt to file a Second Sur-reply, nor has AT&T persuaded us that our expungement of these documents denied its rights under due process and the APA.

V. ORDER

Accordingly, it is ORDERED that AT&T's Renewed Request for Rehearing is *denied*.

For PETITIONER:

Steven M. Bauer
Joseph A. Capraro, Jr.
Gerald Worth
John M. Kitchura, Jr.
Scott Bertulli
Proskauer Rose LLP
PTABMattersBoston@proskauer.com
jcapraro@proskauer.com
gworth@proskauer.com
jkitchura@proskauer.com
sbertulli@proskauer.com

For PATENT OWNER:

David W. O'Brien
Raghav Bajaj
Jamie McDole
John Russell Emerson
Haynes and Boone, LLP
david.obrien.ipr@haynesboone.com
raghav.bajaj.ipr@haynesboone.com
Jamie.mcdole@haynesboone.com
Russell.emerson.ipr@haynesboone.com

Arnold Turk
Neil F. Greenblum
Michael J. Fink
Greenblum & Berstein, P.L.C.
aturk@gbpatent.com
ngreenblum@gbpatent.com
mfink@gbpatent.com