

IPR2018-01557  
Patent 6,760,590

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HTC Corporation and HTC America, Inc.,  
Petitioners

v.

INVT SPE LLC,  
Patent Owner

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Case IPR2018-01557  
U.S. Patent No. 6,760,590

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**PATENT OWNER'S SUR-REPLY**

Petitioners bear the burden of establishing—in the Petition—that the purported *Gils* reference was publicly available. 37 C.F.R. § 42.104(b)(5) (“The petition must set forth: . . . The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.”). By only stating that “Gils was published January 1, 1998,” and by not making any further substantive argument or citing *in the Petition* any further evidence, Petitioners’ failed to meet this burden. *NVIDIA Corp. v. Samsung Elecs. Co., LTD.*, Case No IPR2015-01316, Paper 10 at 7 (P.T.A.B. Dec. 9, 2015) (denying institution for failure to establish public availability where Petitioner only alleged that an alleged reference was “published on” a given date).

To that end, the Board authorized Petitioners to file a reply directed to “Patent Owner’s contention that *the Petition as filed* fails to establish” the asserted *Gils* reference as prior art. Paper 8 at 2 (emphasis in original). In response, Petitioners do not contend that any argument made or evidence actually cited *in the Petition as filed* establishes the public availability of *Gils*. Paper 10 (Petitioners’ Reply). Rather, Petitioners’ entire reply is premised on the fact that the exhibits at issue were “cited *in the Exhibit List*.” (emphasis added)).

Indeed, Petitioners’ argument in reply, which relies on the Board’s *VigLink* decision, appears to be a carefully worded red herring. In *VigLink*, the Patent

Owner submitted a Patent Owner's Response that failed to cite an expert Declaration filed as an exhibit thereto. *VigLink, Inc. v. Skimlinks, Inc.*, Nos. CBM2014-00184, CMB2014-00185, Paper 28 at 2 (PTAB Aug. 21, 2015). The Petitioner objected to the Declaration, after which both the Petitioner and the Patent Owner moved the Board to expunge the original as-filed Declaration. *Id.* at 2-3. The Patent Owner sought to expunge the original Declaration in favor of a new Declaration, and also sought to file a Corrected Response that cited the new Declaration. *Id.* at 2, 4. Petitioner sought to expunge the original Declaration as "improper supplemental witness testimony, filed without justification." *Id.* at 3.

The Board denied Petitioner's motion to expunge because, pursuant to 37 C.F.R. § 42.6(c), the Declaration was "filed with the first document in which it [was] cited," and as such was "not an unauthorized or inadmissible filing and we shall not expunge it as such." *Id.* The Board also denied both Patent Owner's motion to expunge and Patent Owner's motion to file a Corrected Response citing the Declaration. *Id.* at 3-4.

As such, *VigLink* stands for the unremarkable position that an exhibit cited in an exhibit list, but not cited in the actual document, may not be expunged as an improper filing. *Id.* at 3. *VigLink* does not, however, stand for the proposition advanced by Petitioners here—that simply because an exhibit is cited in an exhibit list, the exhibit can be considered as substantive evidence. Such a conclusion

would render superfluous the requirements of 37 C.F.R. § 42.104(b)(5) that a party must set forth in “the petition” the evidence the party relies on. Patent Owner is not moving to expunge the exhibits at issue, rendering *VigLink* inapplicable.

Petitioners’ second argument, that evidence can be added post-institution, again represents an end-run around the Board’s directive that Petitioners’ reply be limited to whether “*the petition as filed*” establishes *Gils* as prior art. Paper 8 at 2 (emphasis in original). Even more, Petitioners’ cited decision from *Apple Inc. v. Virnetx Inc.* relates to “supplemental” exhibits filed after institution, where the Petition included cited evidence already addressing public availability. IPR2015-00810, Paper 21 at 2-6 (PTAB Nov. 2, 2015). Here, Petitioners cited no such evidence in the Petition. Paper 1 at 20.

Finally, Petitioners contend that allowing the filed, but not cited, exhibits to be considered as substantive evidence would not result in exceeding the word limit because “a mere string cite in the body of the Petition” would have sufficed. Paper 10 at 4. A string cite of the proposed evidence would clearly be improper incorporation by reference. And the Board’s role is not “to play archeologist with the record,” rather, it is Petitioners’ burden to make its entire argument and cite its evidence *in the Petition*. *DirectTV, LLC v. Qurio Holdings, Inc.*, Case No. IPR2015-02007, Paper 6 at 15 (PTAB Apr. 4, 2016).

For all of these reasons, the Petition as filed should be denied.

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Dated: December 28, 2018

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on December 28, 2018, a copy of PATENT OWNER'S SUR-REPLY was served in its entirety by electronic mail on Petitioners' counsel at the following address indicated in their Mandatory Notices:

LegalTm-HTC-INVT-IPRs@sheppardmullin.com

Dated: December 28, 2018

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