

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2020-00200
Patent 10,084,991 B2

Before MICHAEL R. ZECHER, KEVIN C. TROCK, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

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

On February 26, 2021, we held a conference call with counsel for the parties to discuss: 1) Petitioner's objections to evidence filed on February 17, 2021 (Paper 23); and 2) Patent Owner's Sur-reply (Paper 22) and Exhibits 2023–2031, filed on February 10, 2021. Prior to the conference call, we advised counsel by email to be prepared to discuss the merits of Petitioner's objections as well as the propriety of Patent Owner's exhibits in

light of the admonition in the Consolidated Trial Practice Guide stating that “[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) 73, *available at* <https://www.uspto.gov/trialpracticeguideconsolidated>.

During the call, counsel for Patent Owner agreed that the filing of Exhibits 2023–2031 was contrary to the admonition in the Consolidated Trial Practice Guide, and agreed that these exhibits should be expunged from the record. Counsel for the parties also agreed to confer on which portions of the Sur-reply should be redacted for referencing or relying on Exhibits 2023–2031. Patent Owner’s Counsel agreed to file a redacted version of the Sur-reply with no other substantive changes by Friday, March 5, 2021.

Accordingly, it is

ORDERED that, pursuant to 37 C.F.R. § 42.7(a), Patent Owner’s Exhibits 2023–2031 shall be expunged from the record in this case;

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.7(a), Patent Owner Sur-reply, Paper 22, shall be expunged from the record in this case; and

FURTHER ORDERED that Patent Owner shall file a redacted version of its Sur-reply with no other substantive changes by Friday, March 5, 2021.

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For PETITIONER:

Jennifer Bailey
Adam Seitz
Paul Hart
ERISE IP, P.A.
jennifer.bailey@eriseip.com
adam.seitz@eriseip.com
paul.hart@eriseip.com

For PATENT OWNER:

Robert Pluta
Amanda Bonner
Luiz Miranda
James Fussell
Saqib Siddiqui
MAYER BROWN LLP
rpluta@mayerbrown.com
asbonner@mayerbrown.com
lmiranda@mayerbrown.com
jfussell@mayerbrown.com
ssiddiqui@mayerbrown.com