

Trials@uspto.gov
571-272-7822

Paper 16
Entered: May 4, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIVISION BLIZZARD, INC.,
ELECTRONIC ARTS INC.,
TAKE-TWO INTERACTIVE SOFTWARE, INC.,
2K SPORTS, INC., and
ROCKSTAR GAMES, INC.,
Petitioner,

v.

ACCELERATION BAY, LLC,
Patent Owner.

Cases IPR2015-01951, IPR2015-01953 (Patent 6,714,966 B1)¹
Cases IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
Cases IPR2015-01970, IPR2015-01972 (Patent 6,701,344 B1)

Before LYNNE E. PETTIGREW and WILLIAM M. FINK, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be entered in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
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ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On April 27, 2015, a conference call was held for the following six proceedings: IPR2015-01951, IPR2015-01953, IPR2015-01964, IPR2015-01970, IPR2015-01972, and IPR2015-01996. The following individuals were present on the call: Mr. Baughman and Mr. Thomases, lead and backup counsel, respectively, for Activision Blizzard, Inc., Electronic Arts Inc., Take-Two Interactive Software, Ind., 2K Sports, Inc., and Rockstar Games, Inc. (collectively, “Petitioner”); Mr. Hannah, lead counsel for Acceleration Bay, LLC (“Patent Owner”); and Judges Medley, Pettigrew, and Fink.

The parties jointly requested a call to discuss proposed motions to be filed by the parties and a proposed change to DUE DATE 7, the date set for oral argument if requested by either party. Petitioner also requested a call to seek authorization to file a motion for supplemental information under 37 C.F.R. § 42.123(a)(1). We addressed all of these issues on the call.

A. Revised DUE DATES

The Scheduling Order in each of these proceedings set DUE DATE 7 (oral argument if requested) as December 14, 2016. Paper 12, 7 (DUE DATE APPENDIX).² Lead counsel for Petitioner stated he has a conflict

² For convenience, citations are to the record in IPR2015-01951 unless otherwise indicated.

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with that date due to oral arguments scheduled in other proceedings before the Board. Patent Owner consented to Petitioner's request that the oral argument in these proceedings be rescheduled to another date when the panel and counsel for both parties will be available.

DUE DATE 7 is reset to December 7, 2016 for each of the proceedings addressed by this order. The specific format and time allotted will depend on the number of issues, as briefed in the Patent Owner Response and Reply, and the extent to which there is overlap of issues among the cases.

A REVISED DUE DATE APPENDIX that applies to each of the six proceedings is attached to this order. DUE DATES 4 through 7 have been revised, and DUE DATE 1 has been revised for IPR2015-01951, IPR2015-01953, IPR2015-01970, and IPR2015-01972, to place all proceedings on the same schedule. We remind the parties they may stipulate to different dates in any of the proceedings for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of stipulation specifically identifying the changed due dates must be filed promptly. The parties may not stipulate to an extension of DUE DATES 6 and 7.

B. Motions to Seal

During the call and in a list of proposed motions (Paper 15), Patent Owner indicated it expects to file one or more motions to seal pursuant to 37 C.F.R. § 42.54. Specifically, Patent Owner expects to file a motion to seal confidential information in an Invention Disclosure form and possibly a

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motion to seal confidential information contained in evidence related to secondary considerations of non-obviousness.

We referred the parties to Section A.3 of the Scheduling Order (Paper 12) for the procedures for filing confidential information in these proceedings. Among other things, a protective order is not in place in a case until one is filed and approved by the Board. If a motion to seal is filed, a proposed protective order should be presented as an exhibit to the motion. The parties are urged to use the Board's default protective order. Procedures for deviating from the default protective order are provided in the Scheduling Order. Generally, information subject to a protective order will become public if identified in a final written decision.

Petitioner indicated on the call it would work with Patent Owner to agree to a proposed protective order.

C. Motion to Compel Deposition Dates and Locations

Patent Owner's list of proposed motions included a “[m]otion to compel deposition dates and location of declarants in United States.” Paper 15, 1. During the call, counsel for Patent Owner stated Patent Owner is not seeking authorization at this time to file such a motion, but included it as a proposed motion in the event Patent Owner finds it necessary to seek authorization in the future. The parties indicated they have been conferring in an attempt to arrange for Patent Owner's deposition of one of Petitioner's declarants who resides outside of the United States.

Cross-examination of the opposing party's declarants by deposition typically is provided under routine discovery. 37 C.F.R. §§ 42.51(b)(1)(ii),

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42.53(a). Our rules contemplate deposition testimony taken outside the United States only upon the agreement of the parties or as the Board specifically directs. 37 C.F.R. § 42.53(b)(3). We urge the parties to continue to work together to determine a mutually satisfactory procedure and location for the deposition of Petitioner’s declarant. Only if the parties are unable to reach an agreement should the parties contact the Board for additional guidance.

D. Antedating a Prior Art Reference

Patent Owner’s list of proposed motions also included a “[m]otion to swear behind prior art.” Paper 15, 1. During the call, we explained to the parties that if Patent Owner plans to attempt to antedate a prior art reference, the proper procedure is to incorporate any antedating efforts into its Patent Owner Response rather than to file a separate motion.

E. Other Proposed Motions

Patent Owner also indicated it may file a motion for additional discovery pursuant to 37 C.F.R. § 42.51 and a motion to file supplemental information pursuant to 37 C.F.R. § 42.123, *see* Paper 15, 1, but indicated on the call that it is not seeking authorization for any such motions at this time. We remind the parties that, except as otherwise provided in our rules, Board authorization is required before filing a motion. A party seeking authorization to file a motion should send an email to the board to request a conference call to obtain authorization to file a motion.

Patent Owner also indicated it may file a motion to amend. Although the filing of a motion to amend is authorized under our rules, Patent Owner

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must schedule a conference to confer with the Board regarding a potential motion to amend at least ten days before DUE DATE 1. We also direct the parties attention to the Board’s decisions in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26), which describes the basic guidelines for a motion to amend, and *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42), which clarifies the scope of “prior art known to Patent Owner.”

F. Motion to Submit Supplemental Information

Petitioner requests authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Specifically, Petitioner seeks to submit as supplemental information documents that it served on Patent Owner as supplemental evidence under 37 C.F.R. § 42.64(b)(2) in response to objections served and filed by Patent Owner under 37 C.F.R. § 42.64(b)(1). *See* Paper 13 (Patent Owner’s Objections to Evidence). Petitioner’s counsel sent an e-mail to the Board requesting authorization to file such a motion within one month after the date trial was instituted in each of these proceedings, and we therefore consider Petitioner’s request timely under 37 C.F.R. § 42.123(a)(1).

In these proceedings, Patent Owner served and filed objections within ten days after institution of trial in accordance with 37 C.F.R. § 42.64(b)(1). *See* Paper 13. Patent Owner objected to the admissibility of certain of Petitioner’s evidence, e.g., on authentication and hearsay grounds. *Id.* at 1 (“Acceleration Bay objects to the admissibility of DirectPlay for at least the

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following reasons,” including failure to authenticate and hearsay under the Federal Rules of Evidence). According to the parties, Petitioner then served supplemental evidence in response to Patent Owner’s objections in accordance with 37 C.F.R. § 42.64(b)(2).

We are not persuaded there is a need to authorize or consider a motion by Petitioner to submit as supplemental information under 37 C.F.R.

§ 42.123(a) any of Petitioner’s supplemental evidence that was responsive to Patent Owner’s evidentiary objections. If Patent Owner preserves its objections by filing a motion to exclude under 37 C.F.R. § 42.64(c) during the period of time provided in the Scheduling Order for filing motions to exclude, Petitioner may submit that supplemental evidence along with an opposition to the motion to exclude to explain how the supplemental evidence cures the objections to admissibility. *See, e.g., Handi-Quilter, Inc. v. Bernina Int’l AG*, Case IPR2013-00364, slip op. at 2 (PTAB June 12, 2014) (Paper 30).

To the extent Patent Owner challenges the sufficiency, rather than admissibility, of the evidence supporting Petitioner’s unpatentability contentions, those arguments should be made in a substantive paper, i.e., the Patent Owner Response. Substantive arguments directed to the sufficiency of evidence are not proper subjects for objections to evidence or a motion to exclude. Similarly, to the extent Petitioner wishes to respond to Patent Owner’s substantive arguments, Petitioner will have the opportunity to do so in a Reply, which may be supported by additional evidence, so long as Petitioner’s arguments and evidence are properly responsive to substantive arguments in the Patent Owner Response.

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ORDER

It is:

ORDERED that DUE DATE 7, the date for oral hearing, is reset to December 7, 2016;

FURTHER ORDERED that the Scheduling Order is revised as indicated in the REVISED DUE DATE APPENDIX attached to this order;

FURTHER ORDERED that Patent Owner at this time is not authorized to file any motions that require Board authorization; and

FURTHER ORDERED that Petitioner is not authorized to file a motion for supplemental information under 37 C.F.R. § 42.123(a).

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REVISED DUE DATE APPENDIX

INITIAL CONFERENCE CALL UPON REQUEST

DUE DATE 1 June 24, 2016

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 September 19, 2016

Petitioner's reply to patent owner's response to petition

Petitioner's opposition to motion to amend

DUE DATE 3 October 19, 2016

Patent owner's reply to petitioner's opposition to motion to amend

DUE DATE 4 November 7, 2016

Motion for observation regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 November 17, 2016

Response to observation

Opposition to motion to exclude

DUE DATE 6 November 23, 2016

Reply to opposition to motion to exclude

DUE DATE 7 December 7, 2016

Oral argument (if requested)

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FOR PETITIONER:

J. Steven Baughman
Andrew N. Thomases
ROPES & GRAY LLP
steven.baughman@ropesgray.com
andrew.thomases@ropesgray.com

FOR PATENT OWNER:

James Hannah
Michael Lee
Shannon Hedvat
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
mhlee@kramerlevin.com
shedvat@kramerlevin.com