

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

COMMUNICATION TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-01221
Patent 6,725,444 B2

Before DANIEL J. GALLIGAN, JOHN A. HUDALLA, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.7

I. Introduction

Our Scheduling Order required the filing of the Patent Owner Response (“POR”) by March 23, 2023. Paper 22, 11. The Scheduling Order allows the parties to stipulate to adjust the due date for the POR. *Id.* at 7. The parties filed a stipulation that the POR was to be filed on April 7, 2023. Paper 36, 1. Patent Owner filed an initial version of the POR on April 7. Paper 43. Patent Owner filed one exhibit on April 7, Exhibit 2034.

On April 12, 2023, without seeking our authorization, Patent Owner filed a “Corrected Patent Owner Response” (“CPOR”). Paper 45. At the same time, Patent Owner filed additional Exhibits 2035 to 2067, which are referenced in the CPOR. Patent Owner offered no explanation of what was “corrected” in the Patent Owner Response or why we should accept the late filing of the Corrected Patent Owner Response or Exhibits 2035 to 2067. This was the second instance where Patent Owner filed an untimely paper without seeking our authorization. *See* Paper 32, 3 n.2 (warning Patent Owner’s counsel against making future late unauthorized submissions). Consequently, on April 14, 2023, we ordered Patent Owner to show cause why we should not expunge the CPOR and Exhibits 2035 through 2067. Paper 47, 4.

On April 21, 2023, Patent Owner filed, under seal, its response to the order to show cause. Paper 52 (“Response” or “Resp.”). A redacted version of Paper 52 is publicly available in the record as Exhibit 2073. In accordance with our Order to Show Cause, Patent Owner also filed a redlined version of the CPOR that reflects the changes Patent Owner made to the POR. Ex. 2068.

Petitioner filed an authorized Reply to the Response. Paper 54 (“Reply”). Patent Owner filed an authorized Sur-reply. Paper 55 (“Sur-reply”).

II. Patent Owner’s Response to the Order to Show Cause

Patent Owner states that it filed the POR with “sufficient informalities that required remediation by Patent Owner.” Resp. 1. Patent Owner claims to have sent an email to Petitioner “immediately after filing the POR” stating: “Attached please find a copy of the Patent Owner’s Response. We intend to file a corrected version ASAP, with the TOC and TOA.” *Id.* Patent Owner did not file a copy of this email with the Response.

Patent Owner contends that “[i]t was believed by Patent Owner’s undersigned counsel that, given that the POR deadline was already extended, that it would have been inopportune to request a further extension of time especially where the POR was essentially complete but for formalities.” Resp. 1–2. Patent Owner then summarizes the changes made to the POR. *Id.* at 2. According to Patent Owner, “[n]one of the changes present in the CPOR . . . are believed to ‘alter the substance of the originally filed Patent Owner Response’, and, in fact, the large majority of the Exhibits were already properly referenced and incorporated.” *Id.*

Patent Owner further contends that “Exhibit 2035 was referred to in the POR; Exhibits 2036-2056 and 2065-2067 were clearly referenced in the Board by proper citation; Exhibit 2057 . . . is not understood to be contested; Exhibits 2058–2061 are fully redacted.” Resp. 2. According to Patent Owner, “[t]hese Exhibits are already in the possession of Petitioner.” *Id.* at 3. Patent Owner admits that “Exhibits 2062 and 2064 are new to the CPOR.” *Id.* Patent Owner provides these two exhibits to support its “contention that ‘the functionality [of the ’444 Patent claims] is required by

Google for Android certification.” Resp. 3 (bracketed material in original). According to Patent Owner “[t]hese exhibits are important to support Patent Owner’s arguments.” *Id.*

Patent Owner next contends that the corrected CPOR and Exhibits 2035–2067 should be accepted because “they represent[] a good faith effort by Patent Owner to comply with the Rules and policies of the Board” and “reduce[] the costs and burdens of the proceeding by eliminating the search cost for obtaining the referenced materials and otherwise serves the ends of justice.” Resp. 3–4. Patent Owner further contends that it “in good faith reached out to Petitioner regarding the filing of a corrected Paper” but “Petitioner did not specifically respond to the April 8, 2023 email.” *Id.* at 4. Patent Owner further claims that “it was not clear to Patent Owner that the CPOR was ‘not authorized under this part or in a Board order or that is filed contrary to a Board order.’” *Id.* (citing 37 C.F.R. § 42.7(a)). Patent Owner also claims that “[t]he CPOR was not understood by Patent Owner to represent a Motion subject to a requirement for advance authorization.” *Id.* (citing 37 C.F.R. § 42.20(b)).

III. Petitioner’s Reply

Petitioner contends that it “strongly objects to [Patent Owner’s] late filings and all of [Patent Owner’s] improper actions.” Reply 2. According to Petitioner, Patent Owner incorrectly states that Samsung did not object to its late filings.” *Id.* at 1 (citing Ex. 2073, 1, 3). Petitioner contends that Patent Owner did not “provide Samsung a copy of its late filings prior to submission or inquire whether Samsung objected to them.” *Id.* Petitioner further contends that it provided Patent Owner

with proposed redactions (via email) to its papers and explicitly stated that “our proposed redactions should not be interpreted as an indication

that Petitioner acquiesces to the filing of the corrected POR. Petitioner reserves the right to object to the filing of the corrected POR should it be entered into the record.”

Id. Petitioner did not attach a copy of the email to its Reply. Based on this, Petitioner argues that Patent Owner “blatantly misrepresented that Samsung did not object to its late filings.” *Id.* at 1–2.

Petitioner further objects to Patent Owner’s “attempt to use Samsung’s discovery period to introduce its evidence.” Reply 2. Petitioner contends that Patent Owner failed to produce its evidence during Patent Owner’s discovery period but rather “stalled” and “allowed its discovery period to end, and, without authorization or explanation, filed most of its evidence in Samsung’s period for discovery.” *Id.* Petitioner contends Exhibits 2058–2061 are “most problematic” because Patent Owner “showed little regard for the district court’s protective order and advanced arguments based on protective order material while providing completely redacted versions of the evidence.” *Id.* Petitioner contends that it “bent over backwards” to allow Patent Owner to submit protective order material prior to institution. *Id.* According to Petitioner, Patent Owner “knew what was required, but took no action during its own discovery period” and it would be “unfair and prejudicial to require Samsung to use its discovery/reply period to develop [Patent Owner’s] evidence.” *Id.*

Petitioner contends that Patent Owner “has not provided good cause to justify its late filings.” Reply 2. According to Petitioner, Patent Owner “knew the process for extending a deadline and, in fact, took advantage of that process” and its belated attempt to comply with “PTAB rules or claiming that a further extension would be ‘inopportune’ are not good cause.” *Id.*

IV. Patent Owner's Sur-reply

Patent Owner, in turn, contends that it did not mischaracterize Petitioner's position. Sur-reply 1. According to Patent Owner, Petitioner's email of April 21, 2023¹ "is not an objection, it is a reservation to make an objection, and in fact, Samsung cancelled a scheduled meet and confer on April 14, 2023 to discuss the issues of filing the Corrected Patent Owner's Response without asserting any objection, indicating the issues to be discussed were moot." *Id.* Patent Owner next contends that Petitioner "has an obligation to disclose the same information in Exhibits 2058–2061 . . . and any additional information, pursuant to 37 C.F.R. § 42.51(b)(1)(iii), which provides that 'a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding.'" *Id.* at 2. Patent Owner contends that the testimony of Petitioner's expert Dr. Cole, requires Petitioner to disclose information in its possession under the cited rule. *Id.*

V. Analysis

For the following reasons, we find that it is in the interests of justice not to expunge the CPOR and Exhibits 2035 through 2067.

The POR and evidence filed on April 7, 2023 was incomplete. Paper 43.² Although Patent Owner claims that the POR was "essentially complete but for formalities" (Resp. 1–2), Patent Owner did not enter Exhibits 2035 to 2067 into evidence as required by 37 C.F.R. § 42.63(a). Further, Exhibits 2062 and 2064 are admittedly new in the CPOR and, in Patent Owner's words, "important" to its case. Resp. 3.

¹ As stated above, this email is not in the record.

² A redacted publicly available version of the POR is filed as Exhibit 2070.

We have reviewed the redlined version of the CPOR (Exhibit 2068). Based on our review, it is clear that Patent Owner added/corrected more than the Table of Contents, Table of Authorities, and other such formalities. In particular, there are substantive changes appearing on at least pages 6, 7, 8, 18, 19, 20, 21, 28, and 61 of the redlined version of the CPOR.

Our rules provide that “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(b)(3). We have reviewed the entirety of the Response and find that Patent Owner has not established good cause for excusing the late filing of the CPOR and the accompanying exhibits. Rather, the record reflects that counsel knew the POR was incomplete when it was filed and then proceeded to file the CPOR with substantive changes, without seeking our authorization. Patent Owner admits to adding two new substantive exhibits, Exhibits 2062 and 2064. Further, given our previous warning to Patent Owner about late or unauthorized filings (Paper 32, 3 n.2), Patent Owner’s argument that it was not clear to Patent Owner if the late filing of the CPOR and exhibits was authorized or did not require a motion is disingenuous at best.

The USPTO Rules of Professional Conduct require counsel to “provide competent representation to a client” and to “act with reasonable diligence and promptness in representing a client.” 37 C.F.R. §§ 11.101, 11.103. Patent Owner, Communication Technologies, Inc., should reasonably expect counsel’s compliance with these rules and have its case adjudicated on the merits. We, therefore, determine, in this instance, that it is not in the interests of justice to punish Patent Owner for the loose practices of counsel. Thus, we excuse Patent Owner’s late and unauthorized filing of the CPOR and Exhibits 2035–2067. *See* 37 C.F.R. § 42.5(b)(3).

Patent Owner and its counsel are cautioned, however, that any further disregard for our orders and rules may result in the imposition of sanctions pursuant to 37 C.F.R. § 42.12(b)(2), (b)(3), (b)(5).

As mentioned above, each of Exhibits 2058–2061 presently amount to a placeholder with an indication that the intended exhibit is “REDACTED IN ITS ENTIRETY.” The parties are directed to meet and confer on the content of Exhibits 2058 to 2061 that will be submitted to the Board. Within 10 days of the entry of this order, the parties shall send an email to trials@uspto.gov explaining the steps the parties shall take to enable Patent Owner to file the exhibits.

In its Response to the Order to Show Cause, Patent Owner also argues that its counsel should be allowed to offer testimony as an expert witness. Resp. 4–5. Patent Owner further contends that “[d]isqualifying counsel would operate as a substantial hardship on Patent Owner.” *Id.* at 5. Although we addressed this issue in our Show-Cause Order (*see* Paper 47, 3–4), we did not authorize briefing from Patent Owner on this issue. As stated in our prior Order, we do not consider papers signed by Mr. Hoffberg to constitute testimony. *See id.* (citing 37 C.F.R. § 11.307). We also note that Patent Owner has not offered an affidavit from any witness, let alone from Mr. Hoffberg, under 37 C.F.R. § 42.53(a). Consequently, the issue of Mr. Hoffberg appearing as a witness is moot. Further, we have not entered an order disqualifying Patent Owner’s counsel.

Patent Owner filed Exhibits 2035 to 2067 without identification of the party name or providing an exhibit label with the exhibit number as required by 37 C.F.R. § 42.63(d). Within 7 days of the entry of this order, Patent Owner shall file substitute exhibits for Exhibits 2035 to 2067 including the exhibit labels and party identification. Patent Owner should contact

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trials@uspto.gov by email for instructions on how to file the substitute exhibits.

It is hereby

ORDERED that Patent Owner's late and unauthorized filing of Paper 45 and Exhibits 2035 to 2067 is excused;

FURTHER ORDERED that Paper 45 shall constitute the Patent Owner Response in this matter;

FURTHER ORDERED that within 7 days of the entry of this order Patent Owner shall file substitute Exhibits 2035 to 2067 with exhibit labels and party identification;

FURTHER ORDERED that the parties are directed to meet and confer concerning Exhibits 2058 to 2061, and within 10 days of the entry of this Order, to send an email to trials@uspto.gov explaining the steps the parties shall take to enable Patent Owner to file Exhibits 2058 to 2061; and

FURTHER ORDERED that Patent Owner is authorized to file a motion to seal Exhibits 2058 to 2061 concurrent with the filing of the exhibits.

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