

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

Case IPR2018-00559
Patent 7,995,091 B2

Before JAMESON LEE, KRISTEN L. DROESCH, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

A conference call was held on July 18, 2018 between counsel for the parties and Judges Lee, Droesch, and Boucher.¹ Counsel for Patent Owner requested the conference call to seek authorization to file an amended preliminary response, and amended supporting declaration. Prior to the conference call, and without authorization, Patent Owner filed on June 22, 2018, papers entitled “PATENT OWNER’S AMENDED PRELIMINARY RESPONSE” and “Amended Declaration of Regis J. ‘Bud’ Bates in Support of Patent Owner.” We expunged both of Patent Owner’s unauthorized papers. *See* Papers 8, 10.

During the call, counsel for Patent Owner indicated that Patent Owner was making its request to correct for miscommunication issues that led to inconsistencies between positions in its originally filed Preliminary Response and litigation positions of the Patent Owner in related district court proceedings. Counsel for Patent Owner asserted that its amended preliminary response would narrow the grounds on which Patent Owner opposes institution. When asked for clarification about whether the amended preliminary response would include changes to the arguments or just delete certain arguments, counsel for Patent Owner indicated that the amended preliminary response would include both changes to pre-existing arguments and deletion of some arguments. In this regard, Patent Owner indicated a willingness to submit a redline version of the document with its filing to highlight the changes and deletions.

¹ A court reporter was present on the call, retained by Patent Owner, who agreed to file the transcript as an exhibit in this proceeding.

Counsel for Petitioner indicated that Petitioner opposes Patent Owner's request. Counsel for Petitioner asserted that Patent Owner's unauthorized amended preliminary response filed on June 22, 2018, and later expunged, included a significant number of additional words and changes when compared to the already-filed Preliminary Response, and, therefore, amounts to a significant re-writing of the Preliminary Response. Counsel for Petitioner also provided several examples of these changes. Counsel for Petitioner requested to file a reply, if Patent Owner is authorized to file an amended preliminary response and amended supporting declaration.

Based on the representations made during the conference call, we do not authorize Patent Owner to file an amended preliminary response and an amended supporting declaration. The statutory deadline to render a decision to institute review pursuant to 35 U.S.C. § 314(b) is less than one month from the date of this conference call. At this late stage of the preliminary proceedings, the filing of an amended preliminary response and amended supporting declaration that include substantive changes will introduce delay affecting the panel's ability to render a decision to institute review within the statutory deadline.

Counsel for Patent Owner acknowledges that substantive arguments in the Preliminary Response have been changed. We see no reason to grant Patent Owner, in effect, an extension of time, *nunc pro tunc*, to prepare its preliminary response. If Patent Owner is solely concerned with maintaining consistency between its Preliminary Response and its litigation positions, it simply can withdraw certain arguments in the Preliminary Response or even withdraw the Preliminary Response in its entirety.

We also are not persuaded, as counsel for Patent Owner argued in the conference call, that the matter only just arose after filing of the Preliminary Response. Patent Owner is expected to be aware of the litigation positions it has taken in different forums as soon as those positions have been taken. Finally, we note that Patent Owner attempted an unauthorized filing, on June 22, 2018, more than 5 weeks after the filing of the original Preliminary Response on May 15, 2018, to effect a self-help correction without seeking approval from the Board. That action was belated and counsel for Patent Owner gave no reason why it chose to make an unauthorized amendment of the substantive papers instead of raising the matter with the Board in a conference call. For all of these reasons, Patent Owner has shown no good cause why the requested relief should be granted.

ORDER

Accordingly, it is

ORDERED that Patent Owner's request to file an amended preliminary response and amended supporting declaration is *denied*.

IPR2018-00559
Patent 7,995,091 B2

PETITIONER:

W. Karl Renner
Jeremy Monaldo
Hyun Jin In
FISH & RICHARDSON P.C.
Axf-ptab@fr.com
jjm@fr.com
in@fr.com

PATENT OWNER:

Timothy Devlin
James Lennon
DEVLIN LAW FIRM LLC
tdevlin@devlinlawfirm.com
jlennon@devlinlawfirm.com