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Paper 23
Entered: January 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN L.L.C.,
Petitioner,

v.

CALABRESE STEMER LLC,
Patent Owner.

IPR2024-00367 (Patent 7,357,310 B2)
IPR2024-00368 (Patent 8,783,564 B2)[1]

Before SHARON FENICK and ANDREAS BALTATZIS, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge.*

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

[1] The Board is entering the same Order in all captioned proceedings. The parties are not authorized to use this combined caption.

On January 24, 2025, Patent Owner filed the following four papers in each of these proceedings:

#	**Document Name**	**Availability**
1	Patent Owner Sur-Reply to Pet. Reply[2]	Parties and Board
2	Proposed Protective Order[3]	Parties and Board
3	Patent Owner's Affidavit (Licensing)[4]	Filing Party and Board
4	Motion to Seal, Motion for PO[5]	Filing Party and Board

A conference call in these proceedings was conducted on January 30, 2025. Judges Fenick and Baltatzis were present, and the parties were represented by their respective counsel: Andrew W. Rinehart (Reg. No. 75,537) and Alton L. Absher (Reg. No. 60,687) for Petitioner and Werner Stemer (Reg. No. 34,956) for Patent Owner.

Patent Owner's "Affidavit" (#3) and Motion to Seal (#4)

Judge Fenick began the call by explaining that Patent Owner's "Affidavit"[6] (#3) and Motion to Seal (#4) ("Motion") listed above amount to

[2] IPR2024-00367 Paper 15; IPR2024-00368 Paper 19.
[3] IPR2024-00367 Paper 16; IPR2024-00368 Paper 20.
[4] IPR2024-00367 Paper 17; IPR2024-00368 Paper 21.
[5] IPR2024-00367 Paper 18; IPR2024-00368 Paper 22.
[6] According to our Rules, any statement under oath, i.e., affidavit, must include the proper seal of the officer before whom the oath or affirmation is made. 37 C.F.R. § 1.66. Our Rules also provide that a declaration may be submitted in lieu of an affidavit. *Id.* at §§ 1.68, 42.2. Such a declaration must acknowledge that willful false statements and the like are punishable by fine or imprisonment or both as set forth in 18 U.S.C. § 1001. *Id.* at § 1.68. We note that the "Affidavit" does not include an official seal, but does contain acknowledgement that any willful false statement is punishable under 18 U.S.C. § 1001. Additionally, Patent Owner is reminded that affidavits and declarations must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) ("Evidence consists of affidavits, transcripts of depositions,

ex parte communications with the Board because Patent Owner filed those papers as only available to "Filing Party and Board" and Petitioner is unable to see those documents. Judge Fenick pointed to 37 C.F.R. § 42.5(d) which provides:

> ***Ex parte communications***. Communication regarding a specific proceeding with a Board member defined in 35 U.S.C. 6(a) is not permitted unless both parties have an opportunity to be involved in the communication.

Judge Fenick also cited the Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG"), at 9 (Nov. 2019),[7] which provides:

> 2. Prohibition on *Ex Parte* Communications: All substantive communications with the Board regarding a proceeding must include all parties to the proceeding, except as otherwise authorized. 37 C.F.R. § 42.5(d). The prohibition on ex parte communications does not extend to: (1) ministerial communications with support staff (for instance, to arrange a conference call); (2) conference calls or hearings in which opposing counsel declines to participate; (3) informing the Board in one proceeding of the existence or status of a related Board proceeding; or (4) reference to a pending case in support of a general proposition (for instance, citing a published opinion from a pending case or referring to a pending case to illustrate a systemic problem).

Judge Fenick noted that none of the above exceptions in the CTPG appear to apply to Patent Owner's Affidavit (#3) and Motion (#4). Judge Fenick explained that, given that Petitioner is unable to view the Affidavit or Motion to Seal, it is unclear how those filings can satisfy the Constitutional

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documents, and things. All evidence must be filed in the form of an exhibit.").

[7] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated

due process requirements before an administrative tribunal. Judge Fenick then asked Patent Owner to explain how the filings are appropriate.

Patent Owner indicated that the content of the Affidavit is highly confidential and that Patent Owner objects to any disclosure to the public, Petitioner, or Petitioner's in-house counsel, except under a protective order, and that the parties had been unable to agree to a protective order. Patent Owner stated that it is bound by agreements with licensees that allow disclosure of the license terms only in limited circumstances.

Petitioner argued that it is unable to respond meaningfully to the Motion because it is unable to view the Motion. Petitioner also indicated that it would oppose the entry of any protective order as untimely, and argued that any evidence of secondary considerations should have been raised in the Patent Owner Response. Petitioner also indicated that, in the event a protective order is entered, Petitioner intends to request authorization to move to strike the Affidavit and any portions of Patent Owner's Sur-reply that relate to secondary considerations because such evidence was not timely submitted.

Judge Fenick asked Patent Owner if there was any reason that the Motion was filed as available only to "Filing Party and Board" along with the Affidavit. Patent Owner indicated that it would attempt to modify the availability of the Motion to "Parties and Board." We note that the availability of the Motion has since been modified to "Parties and Board."

Patent Owner Sur-Reply to Pet. Reply (#1) and Proposed Protective Order (#2)

Judge Fenick noted that Patent Owner's Sur-Reply (#1) and Proposed Protective Order (#2) were entered as available only to "Parties and Board," yet no corresponding motion to seal had been filed for those papers. Judge

Fenick asked Patent Owner if there is any reason that those papers were not filed as available to the public.

Patent Owner responded that it stringently opposes making the evidence of secondary considerations available to in-house counsel of Petitioner or Petitioner's employees.

Judge Fenick explained that our rules do not permit filing additional documentary evidence with Patent Owner's Sur-reply (or Petitioner's Sur-sur-reply), absent express authorization from the Board.[8] Judge Fenick further explained that: (A) Patent Owner should consider whether the Patent Owner's Sur-reply could be filed as public, and modify the availability if so, but that, if Patent Owner determines it correctly filed the Sur-reply as "Parties and Board" only, a motion to seal with respect to the Patent Owner's Sur-reply should be filed;[9] and (B) the Parties are ordered to meet and confer for the purpose of agreeing upon a proposed protective order for these proceedings, and said protective order must not restrict any functions of USPTO staff (including court reporters). We note that the availability of the Sur-reply has since been modified to "Public," while the Proposed Protective Order remains as available only to "Parties and Board."

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[8] *See* CTPG at 73–74: "The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony."

[9] *See* CTPG at 19: "The record of a proceeding, including documents and things, shall be made available to the public, except as otherwise ordered." (citing 37 C.F.R. § 42.14).

ORDER

It is

ORDERED that the Parties shall meet and confer for the purpose of agreeing upon a proposed protective order for these proceedings as set forth above; and

FURTHER ORDERED that Petitioner shall change the availability of the Proposed Protective Order in each proceeding to "Public" or file a motion to seal this document in each proceeding.

PETITIONER:

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