

Trials@uspto.gov
571.272.7822

Paper No. 11, IPR2016-01750
Paper No. 11, IPR2016-01751
Paper No. 11, IPR2016-01753
Paper No. 11, IPR2016-01754
Paper No. 11, IPR2016-01755
Entered: January 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROBERT BOSCH TOOL CORPORATION,
Petitioner,

v.

SD3, LLC,
Patent Owner.

Case IPR2016-01750 (Patent 7,225,712 B2);
Case IPR2016-01751 (Patent 7,600,455 B2);
Case IPR2016-01753 (Patent 7,895,927 B2);
Case IPR2016-01754 (Patent 8,011,279 B2);
Case IPR2016-01755 (Patent 8,191,450 B2)¹

Before SCOTT A. DANIELS, NEIL T. POWELL, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authorizing Reply to Patent Owner Preliminary Response
37 C.F.R. § 42.5

¹ This Order addresses issues that apply to the six cases. We, therefore, exercise our discretion to issue one Order to be filed in each of the cases. The parties are not authorized to use this heading style in their papers.

Case IPR2016-01750; Case IPR2016-01751; Case IPR2016-01753;
Case IPR2016-01754; Case IPR2016-01755

Petitioner (Robert Bosch Tool Corporation) filed petitions for *inter partes* review in each of the above captioned proceedings on September 14, 2016. *See* Paper 1 of IPR2016-01750, IPR2016-01751, IPR2016-01754 and IPR2016-01755 and Paper 2 of IPR2016-01753. In each of these proceedings, Patent Owner (SD3, LLC) filed a Preliminary Response, arguing that institution of an *inter partes* review is time barred by 35 U.S.C. § 315(b) because each proceeding was filed more than one year after the date on which Petitioner was served with a complaint in the United States International Trade Commission (“ITC”) alleging infringement of each respective patent. *See* Paper 9 in each IPR.

Because only a few prior Board decisions have discussed this § 315(b) issue raised in each Patent Owner Preliminary Response, we have determined that a reply from Petitioner on this issue would be beneficial. Petitioner is authorized to file a Reply to Patent Owner’s Preliminary Response limited to whether the time bar of 35 U.S.C. § 315(b) applies to a complaint filed with the ITC. Petitioner’s Reply shall be filed separately in each proceeding by January 27, 2017, and the Reply shall be no more than five pages. Patent Owner is not currently authorized to file a sur-reply.

ORDER

Accordingly, it is

ORDERED that Petitioner’s is authorized to file a Reply to Patent Owner’s Preliminary Response in each of the proceedings on or before January 27, 2017, and the Reply shall be limited to five pages;

Case IPR2016-01750; Case IPR2016-01751; Case IPR2016-01753;
Case IPR2016-01754; Case IPR2016-01755

FURTHER ORDERED that Petitioner's Reply is limited to responding to Patent Owner's arguments regarding the issue of whether the time bar of 35 U.S.C. § 315(b) applies to a complaint filed with the ITC.

Case IPR2016-01750; Case IPR2016-01751; Case IPR2016-01753;
Case IPR2016-01754; Case IPR2016-01755

For PETITIONER:

Patrick R. Colsher
SHEARMAN & STERLING LLP
patrick.colsher@shearman.com

For PATENT OWNER:

Jared W. Newton
QUINN EMANUEL URQUHART & SULLIVAN LLP
jarednewton@quinnemanuel.com