

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Cases IPR2017-00073 and IPR2017-00214
Patent 7,196,611 B2¹

Before JONI Y. CHANG, JUSTIN T. ARBES, and JOHN F. HORVATH,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

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

¹ This Order addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. Other than as expressly authorized herein, the parties are not authorized to use this style heading for any subsequent papers.

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IPR2017-00214 (Patent 7,196,611 B2)

A conference call in the above proceedings was held on December 7, 2017, among respective counsel for Petitioner and Patent Owner, and Judges Chang, Arbes, and Horvath. The purpose of the call was to discuss Patent Owner’s request for authorization to file a motion to strike Petitioner’s Reply and accompanying declaration in each proceeding² or, if such a motion is not authorized, to file a list of allegedly improper new arguments presented in each Reply, consistent with the practice outlined in *Silicon Labs., Inc. v. Cresta Tech. Corp.*, Case IPR2015-00615 (PTAB Feb. 29, 2016) (Paper 26).

“A reply may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763–48,767 (Aug. 14, 2012) (“The petition lays out the petitioner’s grounds for review and supporting evidence, on a claim-by-claim basis, for instituting the requested proceeding. . . . While replies can help crystalize issues for decision, a reply that . . . belatedly presents evidence will not be considered and may be returned. . . . Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.”).

Patent Owner argued during the call that Petitioner’s Replies contain numerous improper new arguments. For example, Patent Owner asserted that Petitioner’s arguments in both cases regarding “interrupts” constitute a new theory of unpatentability, as Petitioner never mentioned “interrupts” in

² *See* IPR2017-00073, Paper 17 (“-73 Reply”), Ex. 1014; IPR2017-00214, Paper 17 (“-214 Reply”), Ex. 1011.

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its Petitions. *See* -73 Reply 18–19; -214 Reply 25–26. Petitioner responded that its arguments are proper because they show that Patent Owner’s contentions regarding the operation of the cited assembly source code are factually incorrect. *See, e.g.*, -73 Reply 18 (citing IPR2017-00073, Paper 13, 13, 15). Likewise, Patent Owner asserted that Petitioner’s arguments regarding “[a]dditional [m]echanisms” identified in the Schindler reference constitute a new theory as to how the claim limitations allegedly are taught by the prior art. *See* -214 Reply 26–27. Petitioner stated that its arguments are proper because they respond to Patent Owner’s contention that Petitioner “failed to identify” sufficient disclosure in Schindler for certain limitations. *See, e.g.*, IPR2017-00214, Paper 13, 6–7. We took the matter under advisement.

After further consideration and review of the parties’ papers, we are not persuaded that a motion to strike each Reply and accompanying declaration would be appropriate under the circumstances. A motion to strike is not, ordinarily, a proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope permitted under the rules. In the absence of special circumstance, we determine whether a reply and supporting evidence contain material exceeding the proper scope when we review all of the pertinent papers and prepare the final written decision. We may exclude all or portions of Petitioner’s Replies and declarations, or decline to consider any improper argument and related evidence, at that time.

To assist with that determination, however, we will authorize the parties to provide certain information in writing. Specifically, Patent Owner is authorized to file, in each proceeding, a paper in the form of a list

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providing the location and a concise description of any portion of Petitioner's Reply that Patent Owner believes constitutes improper new argument. The paper may not exceed three pages and may not contain substantive argument. Petitioner is authorized to file, in each proceeding, a response, itemized to correspond to Patent Owner's paper, identifying where the challenged argument was made in the Petition and/or what material contained in Patent Owner's Response triggered or caused Petitioner to include in its Reply each item listed by Patent Owner. Petitioner's response may not exceed three pages and may not contain substantive argument. Finally, should either party request a hearing, the parties may address the issue of the propriety of Petitioner's Reply arguments and evidence during oral argument.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is not authorized to file a motion to strike Petitioner's Reply and declaration in each of the instant proceedings;

FURTHER ORDERED that Patent Owner is authorized to file, in each of the instant proceedings, a list of arguments as explained herein, limited to three pages, by December 15, 2017; and

FURTHER ORDERED that Petitioner is authorized to file, in each of the instant proceedings, a response to Patent Owner's submission as explained herein, limited to three pages, by December 22, 2017.

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