

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOX FACTORY, INC.,
Petitioner,

v.

SRAM, LLC,
Patent Owner.

Cases

IPR2016-01876 (Patent 9,182,027 B2)

IPR2017-00118 (Patent 9,182,027 B2)

IPR2017-00472 (Patent 9,182,027 B2)¹

Before FRANCES L. IPPOLITO and KEVIN W. CHERRY,
Administrative Patent Judges.

CHERRY, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding

Petitioner's Request Regarding Observations on Cross Examination

37 C.F.R. § 42.5

¹ The Board is entering this Order in each proceeding. The parties are not authorized to use a caption identifying multiple proceedings.

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On December 6, 2017, Judges Cherry and Ippolito conducted a conference call with counsel for the parties.² The conference call was held to discuss Petitioner's request to include in its Response to Patent Owner's Observations on Cross-Examination observations responsive to the topics in Patent Owner's Sur-Reply. Patent Owner opposed the request. Patent Owner also noted that, if we granted the request, that it only cited the testimony of Dr. Neptune in its Sur-Reply and objected to any citations to testimony by other witnesses. We will grant Petitioner an exception to the ordinary practice of observations and allow Petitioner to include responsive observations related to Patent Owner's Sur-Reply. As we explained in detail on the call, we determine that the interests of a complete record weigh in favor of allowing Petitioner to provide citations to testimony by Dr. Neptune, and any other deposition testimony cited by Patent Owner in the Sur-Reply, that might clarify or give context to that witness's testimony that is cited in the Sur-Reply.

However, we will not allow Petitioner to provide responsive observations of testimony for other witnesses not cited in the Sur-Reply that it believes are related to the arguments raised in Patent Owner's Sur-Reply. We believe that allowing such an open-ended opportunity to introduce evidence and testimony by witnesses that were not cited by Patent Owner in its Sur-Reply would amount to an improper attempt at a Sur-Sur-Reply that would introduce new arguments and issues not raised in the Sur-Reply. Given that we are already granting Petitioner an exception from the normal

² A court reporter was present and transcribed the call. Petitioner filed a copy of the transcript as Exhibit 1076 in all of these cases.

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practice of observations, we determine that such an exception should be kept narrow out of fairness to Patent Owner. Thus, we denied that part of the request.

We cautioned Petitioner that the observations related to the Sur-Reply should be concise and consistent with our guidance contained in the scheduling orders for these cases. We warned Petitioner that if the observations were excessive and unreasonable we would consider authorizing a motion to strike.

We further note that, as we explained on the call, Petitioner will still have the opportunity at the oral hearing to direct the panel's attention to the other relevant testimony by the other witnesses that it wishes to cite.

We also informed the parties that if any party has any objections to demonstrative exhibits of the other party, the parties should contact the Board. The procedures regarding objections to demonstratives will be contained in our oral hearing order.

Accordingly, it is

ORDERED that Petitioner is permitted include observations responsive to Patent Owner's Sur-Reply in its Response to Patent Owner's Observations; and

FURTHER ORDERED that such observations responsive to Patent Owner's Sur-Reply will be limited to the testimony of the witness or witnesses cited by Patent Owner in its Sur-Reply.

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