

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2017-00276
Patent 6,633,945

Before JEFFREY S. SMITH, JENNIFER S. BISK, and BEVERLY M. BUNTING,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

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

On February 6, 2018, Patent Owner contacted the Board by e-mail requesting authorization to file a motion to strike Petitioner's Reply. Patent Owner asserted that Petitioner's reply included new evidence and a new ground of unpatentability, in violation of 37 C.F.R. § 42.23(b).

Our Rules explain that “[a] reply may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23(b). Indeed, “a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). For example, our Trial Practice Guide explains that “[e]xamples 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.” *Id.*

We decline at this time to exclude the reply submissions or to authorize Patent Owner to file sur-replies. Instead, on these facts, we determine that the following procedure serves the just, speedy, and inexpensive resolution of this issue. First, Patent Owner may file a paper titled “Patent Owner’s List of Improper Reply Arguments,” which shall include a numbered list of citations to those passages of the reply that Patent Owner believes exceed the scope of a proper reply.¹ This list must include page and line numbers, and may include a brief

¹ For purposes of this Order, an improper argument is an argument made by Petitioner in its Reply where (1) it is beyond the scope of a reply under 37 C.F.R. § 42.23(b) or (2) if we were to rely on it in finding the challenged claims unpatentable, Patent Owner would not have had sufficient notice and opportunity to respond (*see, e.g., Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015)). Because arguments are supported by evidence, and evidence not argued is not considered, we purposely omit a separate class of “improper evidence.”

explanation (akin to that in a motion for observation, *see* Paper 15, 4).

Then, Petitioner may file a paper titled “Petitioner’s Response to Patent Owner’s List of Improper Reply Arguments,” responding to each item in Patent Owner’s list and citing to where the reply argument is supported by a theory of unpatentability expressed in the Petition and/or is responsive to an argument raised in the Patent Owner Response. Again, this response must include page and line numbers, and may include a brief explanation (again, akin to that in a motion for observation).

The propriety or impropriety of the identified portions of the reply will be addressed, to the extent necessary, in our Final Written Decision. To the extent the panel determines that any item identified by Patent Owner warrants additional briefing, an additional Order will be issued, providing such instruction to the parties.

Furthermore, although at this time we do not deem it necessary to resolve this issue prior to the Final Written Decision or via formal briefing, should either party request a hearing, the parties may address this issue during oral argument.

In view of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a List of Improper Reply Arguments, and Petitioner is authorized to file, in each captioned proceeding, a Response, as outlined above;

FURTHER ORDERED that Patent Owner’s List is to be filed no later than February 13, 2018, and that Petitioner’s Response is to be filed no later than February 20, 2018; and

FURTHER ORDERED that neither paper is to be more than two pages, excluding the cover page, signature block, and certificate of service.

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