

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARCTIC CAT, INC.,
Petitioner,

v.

POLARIS INDUSTRIES INC.,
Patent Owner.

Case IPR2017-00433
Patent 9,217,501 B2

Before KARL D. EASTHOM, PHILLIP J. KAUFFMAN, and
MICHAEL W. KIM *Administrative Patent Judges.*

KAUFFMAN, *Administrative Patent Judge.*

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

At Patent Owner's request, Judges Kauffman and Easthom held a call with the parties. Although not present on that call, Judge Kim now joins this Order.

Schedule

The parties disagree on the remaining schedule. After some discussion, the parties agreed to make another attempt to modify the remaining due dates by mutual agreement. We permit the parties to address Due Date 6, provided it does not impact Due Date 7.

Request for Authorization for a Sur-reply

Patent Owner requests a seven page sur-reply based on two alleged reasons: one, because Patent Owner bears the burden of proof on secondary considerations, and two, because portions of Petitioner's Reply exceed the proper scope of a reply. We address these reasons in turn.

Burden of Proof

With its Patent Owner Response, Patent Owner submitted Exhibits 2021–2109, the vast majority of which, in our preliminary and cursory review, are directed to secondary considerations. Petitioner contends, and we agree, that while Patent Owner has the burden of production for secondary considerations, Petitioner still bears the burden of proof, and accordingly, Patent Owner's request should be denied. *See generally Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); *see also* 35 U.S.C. § 316(e) (“[T]he petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”). Consequently, on this record, we are unpersuaded that the

fact that Patent Owner bears the burden of production for secondary considerations provides a sufficient basis for authorizing a sur-reply.

Scope of Reply

Patent Owner contends that they have not had adequate time to review Petitioner's Reply, but on first look, it appears to exceed the permissible scope of a reply. Accordingly, Patent Owner requested an opportunity to bring the relevant portions of the Reply to the Board's attention, for example, in the form of a list. We informed the parties that the Board determines whether a reply and the accompanying evidence are outside the scope of a proper reply, and a list from the parties is generally not needed. Knowing this, if after review, Patent Owner still wishes to request authorization to file a list, Patent Owner must first identify and discuss the strongest example with Petitioner. Following this, should the desire to file a list remain, Patent Owner should jointly request a conference call to discuss that example, and should provide the example in that request. Even if a list is subsequently authorized, this contention, at most, warrants a list and does not warrant a sur-reply.

ORDER

We *deny* Patent Owner's request for authorization to file a sur-reply to Petitioner's Reply.

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