

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTINGHOUSE AIR BRAKE TECHNOLOGIES CORPORATION
(d/b/a WABTEC CORPORATION),
Petitioner,

v.

SIEMENS INDUSTRY, INC.,
Patent Owner.

Case IPR2017-00580
Patent 9,233,698 B2

Before KRISTEN L. DROESCH, MEREDITH C. PETRAVICK, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

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Petitioner filed a Petition requesting *inter partes* review of claims 1, 2, 5, 10, 11, 14, 17 and 18 of U.S. Patent No. 9,233,698 B2 (“the ’698 Patent”). On July 20, 2017, the Board instituted an *inter partes* review of claims 1, 2, 10, 11, 17, and 18 of the ’698 Patent, a subset of the challenged claims in the Petition. Paper 12, 28–29. Oral argument was held on April 17, 2018. Thereafter, on April 24, 2018, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) (“SAS decision”).

Pursuant to our Order of April 27, 2018 (Paper 49), the parties conferred to discuss supplemental briefing and a corresponding schedule for supplemental briefing in light of our modification to institute review of all of the challenged claims presented in the Petition. A conference call was held on May 8, 2018 between counsel for the parties and Judges Droesch, Petravick, and Goodson.

A. Supplemental Briefing Schedule

Prior to the conference call, the parties submitted their proposals for a supplemental briefing schedule. The parties’ proposals for a supplemental briefing schedule is reproduced below:

Wabtec/Siemens IPRs – Siemens/Wabtec Proposed Schedule adjustments Post SAS Decision

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Event	Date (Siemens Proposal)	Date (Wabtec Proposal)
Deposition of Pullen – <i>directed to non-instituted grounds</i>	May 30, 2018 AGREED	
<u>SUPPLEMENTAL DUE DATE 1</u> – <i>directed to non-instituted grounds</i> Patent owner’s response to the petition; Patent owner’s motion to amend the patent	June 13, 2018 AGREED	
<u>SUPPLEMENTAL DUE DATE 2</u> – <i>directed to non-instituted grounds</i> Petitioner’s reply to patent owner’s response to petition; Petitioner’s opposition to motion to amend	June 27, 2018 AGREED	
<u>SUPPLEMENTAL DUE DATE 3</u> – <i>directed to non-instituted grounds</i> Patent owner’s reply to petitioner’s opposition to motion to amend	July 27, 2018	July 13, 2018
<u>SUPPLEMENTAL DUE DATE 4</u> – <i>directed to non-instituted grounds</i> Motion for observation regarding cross-examination of reply witness Motion to exclude evidence Request for oral argument	August 3, 2018	July 20, 2018
<u>SUPPLEMENTAL DUE DATE 5</u> – <i>directed to non-instituted grounds</i> Response to observation Opposition to motion to exclude	August 17, 2018	July 27, 2018
<u>SUPPLEMENTAL DUE DATE 6</u> – <i>directed to non-instituted grounds</i> Reply to opposition to motion to exclude	August 24, 2018	August 3, 2018
<u>SUPPLEMENTAL DUE DATE 7</u> – <i>directed to non-instituted grounds</i> Oral argument (if requested)	Board to Schedule	NOT NECESSARY

During the conference call, counsel for the parties informed the panel that May 30, 2018, was the earliest availability of Petitioner’s declarant Dr. Pullen for a supplemental deposition. Counsel for Patent Owner further indicated that Patent Owner wanted to file a motion to amend to address newly added challenged claims 5 and 14, and may need to file a motion to exclude, a motion for observation, and request additional oral argument.

As evidenced in the chart reproduced above, the parties’ proposals for a supplemental briefing schedule extend beyond the one-year period

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normally available to issue a Final Written Decision, which expires on July 20, 2018. Pursuant to 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c), the Chief Administrative Patent Judge determined that good cause exists to extend the one-year period for issuing a Final Written Decision in the present proceeding. *See* Paper 51; *see also* Paper 52 (Order). Accordingly, based upon the Chief Administrative Patent Judge's determination that good cause exists to extend the one-year period for issuing a Final Written Decision, and after considering the parties' proposals and the information received during the conference call, we provide the supplemental briefing schedule as follows:

Supplemental Due Date 1 <i>Patent Owner's supplemental response to the Petition</i> <i>Patent Owner's supplemental motion to amend the patent</i>	June 13, 2018
Supplemental Due Date 2 <i>Petitioner's reply to supplemental patent owner's response</i> <i>Petitioner's opposition to supplemental motion to amend</i>	June 27, 2018
Supplemental Due Date 3 <i>Patent Owner's reply to Petitioner's opposition to supplemental motion to amend</i>	July 16, 2018
Supplemental Due Date 4 <i>Supplemental Motion for observation regarding cross-examination of supplemental reply witness</i> <i>Supplemental Motion to exclude evidence</i> <i>Request for supplemental oral argument</i>	July 23, 2018
Supplemental Due Date 5 <i>Response to supplemental observation</i> <i>Opposition to supplemental motion to exclude</i>	July 30, 2018
Supplemental Due Date 6 <i>Reply to opposition to supplemental motion to exclude</i>	Aug. 6, 2018
Supplemental Due Date 7 <i>Supplemental oral argument (if requested and determined necessary)</i>	Aug. 17, 2018

B. Word Counts for Supplemental Briefing

During the conference call, the panel also asked the parties to provide proposals concerning the word limits for the proposed additional briefing. In a follow-up e-mail to the Board on May 11, 2018, the parties submitted their proposed word limits for the additional proposed briefing. The parties' agreed-upon word limit proposals are reproduced below:

Event	Word limits
SUPPLEMENTAL DUE DATE 1 – <i>directed to non-instituted grounds</i> Patent owner's response to the petition; Patent owner's motion to amend the patent	1,000 words for Response 1,000 words for Motion to Amend
SUPPLEMENTAL DUE DATE 2 – <i>directed to non-instituted grounds</i> Petitioner's reply to patent owner's response to petition; Petitioner's opposition to motion to amend	500 words for Reply 1,000 words for Opposition to Motion to Amend
SUPPLEMENTAL DUE DATE 3 – <i>directed to non-instituted grounds</i> Patent owner's reply to petitioner's opposition to motion to amend	500 words for Reply
SUPPLEMENTAL DUE DATE 4 – <i>directed to non-instituted grounds</i> Motion for observation regarding cross-examination of reply witness Motion to exclude evidence Request for oral argument	Normal page limits apply
SUPPLEMENTAL DUE DATE 5 – <i>directed to non-instituted grounds</i> Response to observation Opposition to motion to exclude	Normal page limits apply
SUPPLEMENTAL DUE DATE 6 – <i>directed to non-instituted grounds</i> Reply to opposition to motion to exclude	Normal page limits apply

We adopt the parties' agreed-upon word limits for the supplemental briefing.

C. Scope of Supplemental Briefing

Patent Owner's supplemental response to the petition may only address newly added challenged claims 5 and 14. In addition to addressing Patent Owner's supplemental response, Petitioner's supplemental reply may

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