

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEXEON LTD.,
Petitioner,

v.

ONED MATERIAL, LLC,
Patent Owner.

Case IPR2017-00543 (Patent 7,939,218 B2)
Case IPR2017-00851 (Patent 8,440,369 B2)¹

Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in both proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On May 9, 2018, a telephone conference was held among respective counsel for Nexeon Ltd. (“Petitioner”) and OneD Material, LLC (“Patent Owner”), and Judges Kokoski, Tornquist, and Abraham. The purpose of the call was to discuss proposed additional briefing and schedule changes in light of the orders modifying the institution decision in each proceeding to include review of all challenged claims and all challenged grounds.

IPR2017-00543, Paper 26; IPR2017-00851, Paper 28.

Patent Owner argued that, due to the number of grounds added to each proceeding, it would need three months to conduct additional discovery and prepare a Patent Owner Response in each case. As a result, the schedule jointly proposed by the parties extends beyond our 12-month statutory deadlines for issuing final written decisions in these proceedings. Petitioner explained that the parties believe that the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661 (U.S. Apr. 24, 2018), would constitute good cause for extending the 12-month deadline. *See* 37 C.F.R. § 42.100(c) (“An *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge. . .”).

We advised the parties that extensions of the 12-month statutory deadline are given only for good cause, and, if an extension is necessary, the preference is to keep the extension as short as possible. We further advised the parties that additional briefing should be limited to addressing only the newly-instituted grounds and claims, for instance, in a supplemental Patent

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Owner Response and a supplemental Petitioner Reply thereto.² Accordingly, we directed the parties to file a joint brief in each proceeding explaining why the parties need to extend the schedule beyond the 12-month statutory deadline. Each joint brief shall be limited to seven (7) pages, with the proposed schedule filed separately as an exhibit, and shall be filed no later than May 21, 2018.

In light of the circumstances, we confirmed with the parties that the hearings currently scheduled for May 31, 2018 will be postponed, and will be rescheduled in due course.

Accordingly, it is

ORDERED that the parties shall file a joint brief in each proceeding in accordance with the guidance set forth in this Order;

FURTHER ORDERED that each joint brief shall not exceed seven pages, and shall be filed no later than May 21, 2018; and

FURTHER ORDERED that the oral hearings currently scheduled for May 31, 2018 are postponed until further notice.

² If Patent Owner intends to file a motion to amend with respect to any newly-instituted claims, such briefing should be included in the proposed schedule.

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PETITIONER:

S. Richard Carden
James V. Suggs
Scott Dyar
McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP
carden@mbhb.com
suggs@mbhb.com
dyar@mbhb.com

PATENT OWNER:

Jennifer Hayes
Ronald Lopez
NIXON PEABODY LLP
jenhayes@nixonpeabody.com
rflopez@nixonpeabody.com