

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEXEON LTD.,  
Petitioner,

v.

ONED MATERIAL, LLC,  
Patent Owner.

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Case IPR2017-00851  
Patent 8,440,369 B2

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

KOKOSKI, *Administrative Patent Judge*.

ORDER

Extending One-Year Pendency for Good Cause  
*35 U.S.C. § 316(a) and 37 C.F.R. § 42.100*

On February 7, 2017, Nexeon Ltd. (“Petitioner”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1–28 of U.S. Patent No. 8,440,369 B2 (“the ’369 patent,” Ex. 1001) with respect to the following grounds:

Reference	Basis	Challenged Claims
Niu	§ 102(b)	1–28
Oyama	§ 102(b) or §102(a)	1–28
Oyama	§ 103(a)	9, 28
Choi	§102(b) or § 102(a)	1–3, 5–7, 15–24, 26, 28
Choi	§ 103(a)	1, 9, 28
Chow	§ 102(b) or § 102(e)	1–3, 5–8, 10, 13, 15–24, 26, 28
Chow	§ 103(a)	1, 28
Debe	§ 102(b)	1–3, 5–10, 13, 15–18, 20–23, 26, 28
Debe	§ 103(a)	1–28
Yang	§ 103(a)	1–3, 5–8, 10, 15–24, 26, 28

Pet. 9–10. On August 25, 2017, upon finding that Petitioner demonstrated a reasonable likelihood that it would prevail on its challenge that at least one claim of the ’369 patent is unpatentable, we instituted an *inter partes* review of all challenged claims, but limited the proceeding to the following subset of grounds:

Reference(s)	Basis	Challenged Claim(s)
Oyama	§ 102(b)	1–28
Oyama and Song	§ 103(a)	9
Oyama, Shi, and/or Wang	§ 103(a)	28
Chow	§ 102(b) or § 102(e)	1–3, 5–8, 10, 13, 15–24, 26, 28
Debe	§ 102(b)	1–3, 5–10, 13, 15–18, 20– 23, 26, 28
Yang and Lu	§ 103(a)	1–3, 5–8, 10, 15–24, 26, 28

Paper 7, 36–37. On April 27, 2018, we modified our institution decision to include review of “all challenged claims and all of the grounds presented in the Petition.” Paper 28, 2.

Pursuant to 35 U.S.C. § 316(a)(11), “the final determination in an inter partes review [shall] be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months . . . .” The Director delegated the authority to extend the one-year period to the Chief Administrative Patent Judge. *See* 37 C.F.R. § 42.100(c). In particular, 37 C.F.R. § 42.100(c) provides: “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 . . . .” The one-year period normally available to issue a Final Written Decision expires on August 25, 2018.

On May, 21, 2018, with Board authorization (Paper 32), the parties filed a Joint Brief in Support of Good Cause to Extend the Schedule

“J. Br.,” Paper 33). The parties note that there are five newly-instituted grounds, one of which (obviousness of claims 1–28 based on Debe) includes at least eight different combinations of prior art references. J. Br. 1–3. The parties also note that “the Petition contained four different obviousness permutations of Choi that also involved Debe, Wang, Meyer and Shi” as well as “different obviousness permutations of Chow based on Reynolds and Wang.” *Id.* at 4.

Patent Owner, OneD Material, LLC., states that it “intends to prepare a full substantive response” for these newly-instituted grounds, which Patent Owner argues “will take considerable time and resources, in addition to responding to entirely new references [Patent Owner] has not yet analyze[d] substantively.” J. Br. 3–4. Patent Owner also notes that its Preliminary Response “raised only procedural issues” with respect to the newly-instituted grounds, and therefore Patent Owner has not previously prepared any substantive arguments as to those grounds. *Id.* at 5–6. Patent Owner argues that “it would be greatly prejudiced without at least three months to conduct expert discovery and prepare a substantive supplemental Patent Owner response to the grounds that are now subject to the proceedings as a result of the [Supreme Court’s] decision in *SAS Inst.*” *Id.* at 4. The parties argue that, although the requested additional discovery and briefing would extend the schedule past the one-year statutory deadline,<sup>1</sup> “there is good cause to extend [it] in this extraordinary circumstance where the change in

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<sup>1</sup> The parties included a proposed schedule with their Joint Brief. *See* J. Br., Ex. A. We will issue an Extended Scheduling Order that sets forth the deadlines for and scope of the supplemental briefing in this case.

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the law, the *SAS* decision, is putting entirely new grounds and new references at issue that were not previously.” *Id.* at 6.

In light of the circumstances presented here, including the large number of newly-instituted grounds and prior art references encompassed therein, the Chief Administrative Patent Judge has determined that good cause exists to extend the one-year period for issuing a Final Written Decision here. Paper 34; 37 C.F.R § 42.100(c). Accordingly, the time to administer the present proceeding is extended by up to six months.

It is therefore

ORDERED that good cause exists to extend the time of pendency of this proceeding; and

FURTHER ORDERED that this proceeding is extended by up to six months.

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