

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEXEON LTD.,
Petitioner,

v.

ONED MATERIAL, LLC
Patent Owner.

Case IPR2017-00851
Patent 8,440,369 B2

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

KOKOSKI, *Administrative Patent Judge*.

EXTENDED SCHEDULING ORDER

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. As a result of this modification, five grounds (a number of which include numerous obviousness combinations) were added to this *inter partes* review. See Paper 33 (“J. Br.”), 1–3 (identifying the grounds asserted in the Petition, the grounds originally instituted, and the newly-instituted grounds).

On May 21, 2018, with Board authorization (Paper 32), the parties filed a Joint Brief in Support of Good Cause to Extend the Schedule along with a joint proposed schedule of supplemental briefing to address the newly-instituted grounds. J. Br., Ex. A. Having found that good cause exists to do so, the Chief Administrative Patent Judge extended the one-year period for issuing a Final Written Decision in this proceeding for up to six months from the current August 25, 2018 deadline. Papers 34, 35.

The Appendix to this Extended Scheduling Order sets due dates for the parties to take action with respect to the newly-instituted grounds in this proceeding. See Paper 28, 2; Paper 7, 8, 36–37. In setting these due dates, we considered the parties’ jointly proposed schedule, as well as the parties’ requests regarding the page length of the requested supplemental briefing. J. Br. 6–7, Ex. A. The due dates set forth in this Order cannot be changed without prior authorization from the Board.

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D), apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorney’s fees

incurred by any party may be levied on a person who impeded, delays, or frustrates the fair examination of a witness.

A. DUE DATES

1. DUE DATE 8

The patent owner may file—

A supplemental response to the petition (37 C.F.R. § 42.120), limited to the merits of the previously non-instituted grounds.

The patent owner must file any such response by DUE DATE 8, limited to 25 pages. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

2. DUE DATE 9

The petitioner must file any supplemental reply to the patent owner's supplemental response by DUE DATE 9, limited to 12 pages.

3. DUE DATE 10

a. Each party must file any observations on the cross-examination testimony of a supplemental reply witness (*see* section C, below) by DUE DATE 10.

b. Each party must file any motion to exclude evidence in connection with the previously non-instituted grounds (37 C.F.R § 42.64(c)) and any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 10.

4. DUE DATE 11

a. Each party must file any response to an observation on cross-examination testimony of a supplemental reply witness by DUE DATE 11.

b. Each party must file any opposition to a motion to exclude evidence in connection with the previously non-instituted grounds by DUE DATE 11.

5. DUE DATE 12

Each party must file any reply for a motion to exclude evidence in connection with the previously non-instituted grounds by DUE DATE 12.

6. DUE DATE 13

The oral argument (if requested by either party) is set for DUE DATE 13.

B. CROSS-EXAMINATION

Except as the parties might otherwise agree, for each due date—

1. Cross-examination begins after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).
2. Cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

C. OBSERVATIONS ON CROSS-EXAMINATION

Observations on cross-examination provide the parties with a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768 (Aug. 14, 2012). The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not

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exceed a single, short paragraph. The opposing party may respond to the observation. Any response must be equally concise and specific.

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