

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELPHI TECHNOLOGIES, INC.,
Petitioner,

v.

MICROCHIP TECHNOLOGY INC.,
Patent Owner.

Case IPR2017-00861 (Patent 7,627,708 B2)
Case IPR2017-00864 (Patent 7,523,243 B2)¹

Before BRIAN J. McNAMARA, DANIEL N. FISHMAN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

FISHMAN, *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 identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

IPR2017-00861 (Patent 7,627,708 B2)

IPR2017-00864 (Patent 7,523,243 B2)

I. JUNE 7 CONFERENCE CALL

In an order mailed May 10, 2018, we authorized additional briefing by the parties (Paper 40²) culminating in Petitioner's Sur-Reply filed on June 1, 2018 (Paper 46). On June 7, 2018, the Board received an email message from Patent Owner requesting a conference call with the parties. On that same day, we conducted the requested call with the parties' counsel and Judges McNamara, Fishman, and Clements to discuss (1) Patent Owner's request to file a Sur-Sur-Reply responsive to Petitioner's Sur-Reply and (2) Patent Owner's request for clarification as to the issues that may be discussed at the scheduled oral argument.

In the conference call, we denied authorization for Patent Owner's request to file a Sur-Sur-Reply and clarified that all issues of record may be discussed in the scheduled oral argument.

In the conference call, Petitioner indicated it had attempted (on short notice) to arrange a court reporter to transcribe the conference call. We delayed the start of the call to await arrival of the court reporter but the reporter did not show up. Patent Owner indicated it was recording the call and would file a transcript of that recording. At oral argument, on June 14, 2018, Patent Owner indicated that it had technical difficulties with the recording of the June 7 conference call and, thus, would be unable to file any transcript of the call. Petitioner responded that it desired authorization to file email messages exchanged between the parties leading up to the June 7 conference call to memorialize the issues discussed and the positions of the parties. We instructed the parties to confer and reach an agreement as to the messages to be filed.

² Citations are to IPR2017-00861 unless otherwise noted.

IPR2017-00861 (Patent 7,627,708 B2)

IPR2017-00864 (Patent 7,523,243 B2)

On June 18, 2018, the Board received an email message from Petitioner indicating, in essence, that the parties could not agree what email messages and other information should be filed regarding the June 7 conference call. On June 19, 2018, the Board received an email message from Patent Owner responsive to Petitioner's email the day before expressing its concerns regarding Petitioner's proposed email messages to be filed and requesting yet another conference call to discuss its concerns.

We do not authorize any further filings regarding the substance of the June 7, 2018 conference call. We perceive no need for any documentation memorializing the conference call beyond this order.

We further remind the parties that email messages to the Board shall not include argument regarding any issues but, instead, shall briefly indicate that the parties had conferred on an issue, cannot reach agreement on the issue, and request a conference call with the Board to resolve the issue.

II. PATENT OWNER'S REQUEST FOR REHEARING

On May 21, 2018, Patent Owner filed a Request for Rehearing (Paper 44) requesting the panel to reconsider its Decision on Institution (Paper 14) as modified by our order of May 3, 2018 (Paper 38) responsive to the recent Supreme Court decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Our rules authorize a party dissatisfied with a decision to file a request for rehearing of that decision. See 37 C.F.R. § 42.71. These rules do not normally require or authorize a reply from a party opposing such a Request for Rehearing. However, in this case, the request raises issues of particular interest to the Board—issues that arise in the context of a modified

IPR2017-00861 (Patent 7,627,708 B2)

IPR2017-00864 (Patent 7,523,243 B2)

institution decision pursuant to the recent *SAS* decision. In particular, Patent Owner's Request for Rehearing raises the following questions.

1. *Whether Patent Owner's Request for Rehearing is timely.*

Although our rules allow a request for rehearing to be filed for any decision, a request to rehear a decision on institution is due within 14 days or 30 days of that decision (depending on the granting or denial of review). This Request for Rehearing indicates it is a request to rehear the decision in our order of May 3, 2018 (modifying the Decision on Institution). The request is, therefore, only timely if it is, in fact, a request to rehear the May 3, 2018 order. If the request is to reconsider the underlying Decision on Institution (entered August 29, 2017), the request is not timely filed. The substance of Patent Owner's argument is, arguably, directed to the underlying, earlier Decision on Institution and not directed to the May 3, 2018 order modifying that decision. If so, the Request for Rehearing is not timely filed.

2. *Whether 35 U.S.C. § 312(a)(4) precludes consideration, and therefore institution, of a petition if one of multiple grounds does not comply with 37 C.F.R. § 42.104(b)(4).* The substance of Patent Owner's Request for Rehearing asserts that the Petition should have never been considered because there was no statutory authority to do so under 35 U.S.C. § 312(a)(4). Specifically, the statute recites that a petition "may be considered only if . . . the petition provides such other information as the Director may require by regulation." 35

IPR2017-00861 (Patent 7,627,708 B2)

IPR2017-00864 (Patent 7,523,243 B2)

U.S.C. § 312(a)(4). In our Decision on Institution, we had originally denied review of some claims because the Petition failed to adequately specify where each element of the claim is found in the references as required by our regulation 37 C.F.R. § 104(b)(4). In its Request for Reconsideration, Patent Owner argues that failure of the Petition to comply with 37 C.F.R. § 42.104(b)(4) required that the Petition not be considered in accordance with 35 U.S.C. § 312(a)(4).

We request further briefing regarding (1) whether this Request for Rehearing is timely filed based on the issues raised in this request; and (2) whether 35 U.S.C. § 312(a)(4) demands compliance with *every* regulation under 37 C.F.R. § 42 to permit institution of review.

At oral argument, in response to a question from the panel, Petitioner indicated it had no desire to file a Reply to Patent Owner's Request for Rehearing but would consider doing so if requested.

Accordingly, we authorize Petitioner to file an Opposition to Patent Owner's Request for Rehearing. If Petitioner files such a Paper, the Paper shall be no more than ten (10) pages, shall be filed no later than July 13, 2018, and shall be limited to the above-identified issues regarding Patent Owner's Request for Rehearing. We further authorize Patent Owner to file a Reply in Support of its Request for Rehearing no later than July 27, 2018, consisting of no more than ten (10) pages, and addressing the above-identified issues regarding its Request for Rehearing.

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