

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOPGOLF INTERNATIONAL, INC.,  
Petitioner,

v.

AMIT AGARWAL,  
Patent Owner.

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Case IPR2017-00928  
Patent 5,370,389

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Before LORA M. GREEN, MICHELLE N. WORMMEESTER, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

A conference call was held on Thursday, April 26, 2018, between Patent Owner, Amit Agarwal; counsel for Petitioner, Dorothy Whelan and K. Nicole Williams; and Administrative Patent Judges Green, Wieker, and Wormmeester. Mr. Agarwal arranged for a court reporter to be present on the call, and agreed to file a copy of the transcript as an exhibit.<sup>1</sup> Mr. Agarwal requested the call to seek authorization to file a sur-reply to Petitioner's Reply accompanied by a new expert declaration, as well as to file additional briefing based on the United States Supreme Court's decision in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 2018 WL 1914662 (U.S. Apr. 24, 2018) ("*Oil States*").

Specifically, as to the request for authorization to file a sur-reply, Mr. Agarwal asserted that it was improper for us to change obviousness theories mid-stream, during oral argument. According to Mr. Agarwal, we changed our construction of "significantly lower" from the construction of that term in our Decision on Patent Owner's Request for Rehearing. Paper 14, 10. In particular, Mr. Agarwal stated that during the oral hearing in this proceeding we stepped away from that construction.

Mr. Agarwal contended further that Petitioner asserted a new obviousness theory for the first time during oral argument. Mr. Agarwal maintained that new theory was that the inner-most section of the target of Bertoncino could be stretched to the full size of the target. Petitioner responded that was not a new argument, but that argument had been made at page 50 of the Petition, as well as discussed at page 13 of the Reply.

Mr. Agarwal argued also that he should be allowed to respond to our questions at the oral hearing regarding friction. We responded that those questions

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<sup>1</sup> This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

came up in the context that both the challenged patent (Ex. 1001, 5:29–42) and Bertoncino (Ex. 1004, 6:33–14) teach the use of a material that reduces the momentum of the ball, that is, a material that absorbs the impact of the ball to prevent the ball from bouncing out of the target. The questions related to whether those teachings had been considered by his expert. In response to our question on the call as to whether Mr. Agarwal was aware of those teachings of the use of a shock absorbing material before the oral hearing, Mr. Agarwal stated he was.

Finally, Mr. Agarwal stated that he should have an opportunity to respond to a reference that Petitioner had filed with its Reply, Meikle (Ex. 1015). In particular, Mr. Agarwal stated that he should have had the opportunity to swear behind that reference. In response to our question as to why he had not requested a sur-reply after Petitioner had filed its Reply, but waited until after the oral hearing had been held, Mr. Agarwal agreed that it would have been preferable to have requested the sur-reply to respond to the Meikle reference shortly after Petitioner had filed its Reply. Mr. Agarwal responded further that he had to at least request a sur-reply to preserve arguments on appeal. In addition, Mr. Agarwal asserted that due process necessitated that we authorize the sur-reply, as well as an accompanying expert declaration.

We noted that we are required by statute to issue a final written decision within one year from institution. *See* 35 U.S.C. § 316(a)(11). We observed that if Mr. Agarwal were to be allowed to file a sur-reply and an additional expert declaration, Petitioner would then be entitled to cross-examination of that expert, and then may also aver that due process requires it the opportunity to file a sur-sur-reply. Under those circumstances, we remarked that we most likely would not be able to meet our one-year statutory deadline. Mr. Agarwal maintained that the requirement for due process outweighed our requirement to meet our statutory

deadline, and, moreover, argued that deadline may be extended by six months for good cause.

The difficulty with Mr. Agarwal's argument is that interpretation of the good cause exception would essentially read the one-year deadline out of the statute. Specifically, the only good cause for extending the statutory deadline articulated by Mr. Agarwal during the conference call was due process. That argument could be made by virtually every party in virtually every proceeding, and it is unclear to us how under those circumstances how any proceedings would then meet the one-year statutory deadline.

We noted also in response that we would base the final written decision on the arguments and evidence that were of record before the oral hearing, and not on any new argument that was made for the first time at oral hearing. We remarked further that we had not yet issued a final written decision in this proceeding, and, therefore, Mr. Agarwal was basing his request on statements and questions that were made during oral hearing but have not been made finally in any written decision. In that regard, we noted that oral hearing is an opportunity for the panel to test the parties' arguments, especially around the edges, and is not necessarily reflective of any reasoning that will be relied upon in the final written decision.

In view of the forgoing, Mr. Agarwal is not authorized to file a sur-reply to Petitioner's Reply, nor is Mr. Agarwal authorized to file an additional expert declaration.

Mr. Agarwal requested also that he be allowed to file briefing based on the Supreme Court's decision in *Oil States*. In particular, Mr. Agarwal noted that the Supreme Court's decision in *Oil States* left open the question of whether retroactive application of the *inter partes* review process to those patents for which the process was not in place at the time of issue is unconstitutional. *Oil States*,

2018 WL 1914662 at \*11. In order to preserve the argument on appeal, Mr. Agarwal asked for five pages of briefing on the issue.

Petitioner, in response, stated it did not, in principle, oppose Mr. Agarwal's request to preserve for appeal the issue of whether application of *inter partes* review retroactively to the patent challenged in the instant proceeding is unconstitutional. Petitioner noted, however, that it did not feel extensive briefing would be necessary. Rather, Petitioner stated that one page on the issue from Mr. Agarwal, as well as a one-page response from Petitioner, would be sufficient. Mr. Agarwal agreed.

We, thus, authorize Mr. Agarwal to file a one (1) page paper, not including the title page, addressing the constitutional question left open by *Oil States* regarding the retroactive application of *inter partes* review to a patent that issued before that process was in place, which must be filed within one (1) week of the mailing of this Order. Petitioner is then authorized to file a one (1) page response, not including the title page, which must be filed within one (1) week of the filing of Mr. Agarwal's paper. Mr. Agarwal is not authorized to file a reply to Petitioner's response, and neither party is authorized to file new evidence.

Accordingly, it is:

ORDERED that Mr. Agarwal's request to file a sur-reply to Petitioner's Reply, as well as a new expert declaration, is *denied*;

FURTHER ORDERED that Mr. Agarwal's request to file a paper preserving the argument that the application of *inter partes* review to a patent that issued before that process was in place is unconstitutional is *granted*;

FURTHER ORDERED that Mr. Agarwal is authorized to file a one (1) page paper, not including the title page, addressing the constitutional question left open

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