

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP,
Petitioner,

v.

BENHOV GMBH, LLC,
Patent Owner.

Case IPR2017-00930
Patent 8,170,884 B2

Before BARBARA A. PARVIS, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, Administrative Patent Judges.

FISHMAN, *Administrative Patent Judge.*

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

I. INTRODUCTION

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '930 patent is unpatentable. Paper 9, 2, 39–40. We modify our institution decision to institute on all the challenged claims and all the grounds presented in the Petition.

On April 30, 2018, oral arguments were presented in the above-identified case. We asked the parties whether either party felt the need for additional briefing regarding issues arising from the *SAS* decision. Petitioner requested additional briefing directed to the newly instituted claims and ground but Patent Owner perceived no such need unless Petitioner was authorized to provide additional briefing.

II. DISCUSSION

In accordance with our rules, other than in exceptional circumstances, Petitioner's Reply to the Patent Owner's Response "may only respond to arguments raised in the . . . patent owner response." 37 C.F.R. § 42.23(b). Thus, where a patent owner elects not to file a response with regard to a ground of unpatentability, a petitioner is limited to the petition and associated evidence with regard to that ground, and may not submit additional argument or evidence. *See id.* This would be true even if we had instituted the newly instituted grounds in our original Decision on Institution. In general, permitting a petitioner to file additional arguments

and evidence under these circumstances would unfairly prejudice a patent owner, who would not have reasonably foreseen that the petitioner would essentially “supplement” its petition *sua sponte*. Here, Patent Owner’s Response (Paper 12) did not address the previously non-instituted claims and grounds and, thus, Petitioner’s Reply (Paper 14) had no basis to respond to any (non-existent) Patent Owner arguments regarding the newly instituted claims and grounds.

We recognize that the *SAS* decision has presented the Board and the parties with an unusual situation. In view of the particular facts of these proceedings and out of an abundance of caution, we will permit Petitioner to comment on the sufficiency of the Petition with respect to the newly instituted claims and grounds.

Accordingly, we authorize Petitioner to file a Supplemental Reply Brief, not to exceed ten (10) pages, limited to addressing issues regarding the newly added claims and grounds raised by: (1) our Decision on Institution (Paper 9) or (2) Patent Owner’s Response (Paper 12). Petitioner’s Supplemental Reply Brief shall be filed no later than May 23, 2018. No new evidence may be submitted with Petitioner’s Supplemental Reply Brief.

Furthermore, if Petitioner files a Supplemental Reply Brief, we authorize Patent Owner to file a Supplemental Response Brief in response to Petitioner’s Supplemental Reply Brief, not to exceed ten (10) pages, limited to responding to issues raised in Petitioner’s Supplemental Reply Brief. If Patent Owner chooses to file a Supplemental Response Brief, it shall be filed no later than May 30, 2018. Patent Owner may file new evidence with its

Supplemental Response Brief limited to evidence responsive to issues raised by Petitioner's Supplemental Reply Brief.

Still further, if Patent Owner files a Supplemental Response Brief, we authorize Petitioner to file a Sur-Reply to Patent Owner's Supplemental Response Brief, not to exceed five (5) pages, limited to rebutting issues raised in Patent Owner's Supplemental Response Brief. Petitioner may file new evidence with its Sur-Reply, limited to evidence responsive to issues raised by Patent Owner's Supplemental Response Brief. Petitioner's Sur-Reply, if any, shall be filed no later than June 6, 2018.

III. ORDER

In view of the foregoing discussion, it is hereby:

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition;

FURTHER ORDERED that Petitioner is authorized to file a Paper ("Supplemental Reply Brief") by May 23, 2018, not to exceed ten (10) pages, limited to addressing issues, regarding the newly added claims and grounds, raised by our Decision on Institution (Paper 9) or by Patent Owner's Response (Paper 12);

FURTHER ORDERED that Petitioner shall not file any new evidence with its Supplemental Reply Brief;

FURTHER ORDERED that, if Petitioner files a Supplemental Reply Brief, Patent Owner is authorized to file a Paper ("Supplemental Response Brief") by May 30, 2018, not to exceed ten (10) pages, limited to addressing issues raised by Petitioner's Supplemental Reply Brief;

FURTHER ORDERED that Patent Owner is authorized to file new evidence with its Supplemental Response Brief limited to evidence responsive to issues raised by Petitioner's Supplemental Reply Brief;

FURTHER ORDERED that, if Patent Owner files a Supplemental Response Brief, Petitioner is authorized to file a Paper ("Sur-Reply to Patent Owner's Supplemental Response Brief") by June 6, 2018, not to exceed five (5) pages, limited to rebutting issues raised in Patent Owner's Supplemental Response Brief; and

FURTHER ORDERED that Petitioner may file new evidence with its Sur-Reply limited to evidence responsive to issues raised by Patent Owner's Supplemental Response Brief.

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