Trials@uspto.gov
571-272-7822

Paper 8
Entered: August 16, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WENDT CORPORATION,
Petitioner,

v.

IQASR, LLC,
Patent Owner.

Case IPR2017-01080
Patent No. 9,132,432 B2

Before BEVERLY M. BUNTING, KEVIN W. CHERRY, and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

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

Wendt Corporation ("Petitioner") requested a conference call regarding its request for authorization to file a Reply to the Preliminary Response filed by IQASR, LLC ("Patent Owner"). Patent Owner opposes Petitioner's request. We convened the conference call on August 14, 2017, with Judges Marschall, Cherry, and Bunting and counsel for Petitioner and Patent Owner in attendance.

Petitioner argues that a Reply is necessary to address the alleged indefiniteness of the term "magnetic fuzz" in the claims challenged in the Petition. The parties have already briefed the indefiniteness issue extensively. *See* Petition ("Pet.") 14–31; Patent Owner's Preliminary Response ("Prelim. Resp.") 4–22. Petitioner requests that we "find all claims indefinite" based on the indefiniteness of "magnetic fuzz." Pet. 31. Patent Owner argues that we should institute even if the term is "arguably indefinite . . . so that the Patent Owner may use its statutory right to file a motion to amend the claims to address any such indefiniteness issue." Prelim. Resp. 4–5 (citing laws and regulations relating to amendments generally for support). Patent Owner also addresses the merits of Petitioner's indefiniteness arguments. *See id.* at 6–22. Both parties rely on experts to support their respective positions. *See* Exs. 1004, 2001.

According to Petitioner, the proposed Reply would address (1) the legal and policy reasons in support of declining to institute *inter partes* review due to indefiniteness; (2) reasons why the Board should make factual findings related to indefiniteness even though it cannot institute an *inter partes* review or issue a final decision finding any claims not patentable based on indefiniteness; and (3) Patent Owner's use of its expert testimony. Petitioner does not seek to introduce additional expert testimony in conjunction with its proposed Reply. Finally, Petitioner argues that we should not institute an *inter partes* review on indefinite

claims merely to provide Patent Owner an opportunity to amend those claims and cure the indefiniteness, as Patent Owner proposes. Patent Owner argues that Petitioner provides insufficient grounds to justify a Reply. When queried, Patent Owner did not provide any support for its proposition in the Patent Owner Preliminary Response that we should institute review of claims with indefinite terms, to allow Patent Owner to amend those claims.

After considering the respective positions of the parties, we find that Petitioner has not shown good cause to file a Reply. Petitioner already addressed the indefiniteness issue at length in the Petition, and had a full opportunity to present the legal, policy, and factual reasons in support of its position. Even if the Petition did not anticipate every argument Patent Owner or its expert would set forth in the Preliminary Response, that does not automatically entitle Petitioner to a Reply to address the new issues. As such, we do not view Petitioner's present arguments as sufficient to warrant a Reply here. Regarding Petitioner's argument that we should not institute on claims with indefinite terms merely to allow Patent Owner to amend the problematic terms and cure the indefiniteness problem, we agree. Patent Owner could not provide any support for that position, and we are unaware of any basis for such an approach. Petitioner need not file a Reply to further address the issue.

ORDER

Accordingly, it is hereby

ORDERED that Petitioner's request for authorization to file Reply to Patent Owner's Preliminary Response is DENIED.

For PETITIONER:

Robert Brunelli
Kendria Pearson
SHERIDAN ROSS P.C.
rbrunelli@sheridanross.com
kpearson@sheridanross.com

For PATENT OWNER:

Luke Santangelo
Travis Whitsitt
Misha Macaw
SANTANGELO LAW OFFICES, P.C.
lukes@idea-asset.com
twhitsitt@idea-asset.com
misham@idea-asset.com