

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUTCHINSON TECHNOLOGY INC.,
HUTCHINSON TECHNOLOGY OPERATIONS (Thailand) CO., LTD.,
Petitioner,

v.

NITTO DENKO CORP,
Patent Owner.

Case IPR2017-01421
Patent 8,895,870

Before THOMAS L. GIANNETTI, CHRISTA P. ZADO, and
MELISSA A. HAAPALA, Administrative Patent Judges.

GIANNETTI, Administrative Patent Judge.

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

BACKGROUND

On May 9, 2018, a conference call was held among counsel for the parties and the panel. The purpose of the call was to discuss Patent Owner's request for authorization to strike pages 7–27 of Paper 23, Petitioner's Reply to Patent Owner's Response to the Petition. The call was requested by Patent Owner in an email to the Board dated May 3, 2018. A reporter engaged by Patent Owner was present on the call. Patent Owner has filed the transcript as Paper 30.

DISCUSSION

Patent Owner contends that in responding to Patent Owner's motion to amend, Petitioner exceeded the 25-page limit set forth in 37 C.F.R. § 42.24 for oppositions to motions to amend. Patent Owner contends that in addition to Petitioner's Opposition to the Motion to Amend (Paper 22), Petitioner's Reply (Paper 23) improperly addresses the substitute amended claim proposed by Patent Owner. The result is that Petitioner's challenge to the substitute claim exceeds the allotted page limit.

After discussing the matter, Petitioner agreed to refile its Reply (Paper 23), omitting the discussion of the proposed substitute claim. Petitioner will also refile its Opposition to the Motion to Amend (Paper 22). We granted Petitioner authorization for additional briefing in its refiled Opposition to address arguments under 35 U.S.C. § 103(c) directed to the Ohsawa reference and further authorized additional briefing for Patent Owner to reply.

OTHER MATTERS

The Board raised questions about Patent Owner's Objections (Paper 26) and provided guidance to Patent Owner's counsel. Patent Owner agreed to simplify the objections in light of the Board's guidance.

The Board agreed to take Petitioner's duty of candor issue under advisement.

ORDER

It is, therefore,

ORDERED that Patent Owner's request for authorization to file a motion to strike pages 7–27 of Paper 23 is *denied* as moot;

FURTHER ORDERED that within five business days of entry of this Order, Petitioner will file a revised version of its Reply to Patent Owner's Response to the Petition, omitting any discussion of Patent Owner's proposed substitute amended claim;

FURTHER ORDERED that within five business days of entry of this Order, Petitioner will file a revised version of its Opposition to Patent Owner's Motion to Amend, and that the page limit for the Opposition is extended by up to five additional pages directed solely to the issue of whether Ohsawa is disqualified as a reference under 35 U.S.C. § 103(c);

FURTHER ORDERED that the page limit for Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend is extended by up to five additional pages, solely to respond to Petitioner's supplemental briefing on this §103(c) issue;

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FURTHER ORDERED that Paper 26 is withdrawn; Patent Owner will have ten days from entry of this Order to refile simplified objections to Petitioner's evidence.

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