

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OPUS KSD INC.,
Petitioner,

v.

INCISIVE SURGICAL INC.,
Patent Owner.

Case IPR2017-01438
Patent 8,821,517 B2

Before FRANCES L. IPPOLITO, JAMES A. WORTH, and MICHAEL L.
WOODS, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

On August 29, 2017, pursuant to a request by Petitioner, the Board held a conference call between Judges Ippolito, Worth, and Woods and counsel for the parties. Petitioner presented two requests: (1) a request for authorization to file a Reply to Patent Owner's Preliminary Response; and (2) a request for authorization to file a motion to deem facts admitted. This proceeding is in a preliminary stage and no decision on institution has been entered.

1. Request for Reply

On the call, Petitioner requested a Reply to address whether Patent Owner's statutory disclaimer of all claims in U.S. Patent No. 8,821,517 B2 ("the '517 patent") that have been challenged in the Petition should be treated as a request for adverse judgment. Petitioner asserted that alleged facts related to the prosecution of the '517 patent and alleged copying of claims by the Patent Owner have bearing on our decision on whether to institute an *inter partes* review, and especially, whether adverse judgment applies to our review of the Petition and Preliminary Response.

In response, Patent Owner disagreed with Petitioner's position that alleged facts regarding prosecution and copying provide a basis (e.g., equitable basis) for the Board to treat Patent Owner's statutory disclaimer as a request for adverse judgment. Nonetheless, Patent Owner does not oppose Petitioner's request provided that Patent Owner may file a Sur-reply.

We appreciate that the parties have raised this issue early in the preliminary proceeding and authorize both parties to provide additional briefing to aid our review of the Petition, Preliminary Response, and Patent Owner's statutory disclaimer. We authorize Petitioner to file its Reply by September 5, 2017. Petitioner's brief is limited to five (5) pages. Patent Owner may file a Sur-reply, also limited to five (5) pages, by September 12,

2017. Additionally, at this time, we do not authorize that any testimonial evidence and/or declarations may accompany the briefs. Should either party anticipate a need to file supporting testimonial evidence and/or declarations, the parties are instructed to confer and contact the Board with available dates/times for a conference call.

2. Motion to Deem Facts Admitted

Petitioner requested that certain material facts, including facts related to alleged copying of claims and priority of the '517 patent, be deemed admitted facts on this record. Petitioner argued that the alleged facts sought to be deemed admitted are relevant to arguments it will rely upon in the Reply to Patent Owner's Preliminary Response, which we have authorized above.

Patent Owner reiterated its argument that there is no equitable basis for treating a statutory disclaimer as adverse judgment against Patent Owner, and, further sought clarity on the Board's jurisdiction for authorizing and deciding Petitioner's motion in light of Patent Owner's statutory disclaimer. We understand Patent Owner's position to be that the statutory disclaimer deprives us of jurisdiction to allow and review briefing on whether certain facts can be deemed admitted.

While we note Patent Owner's objection for the record, we disagree that the Board does not have jurisdiction to authorize the filing of Petitioner's motion. Petitioner asserts that the alleged facts at issue pertain to our review of the Petition, Patent Owner's Preliminary Response, Patent Owner's statutory disclaimer, and, ultimately, our decision whether to institute trial. As such, we determine per, at least, 35 U.S.C. § 314(a), we have jurisdiction to consider the parties' briefing on alleged facts that Petitioner represents are relevant to our review of the information presented

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in the Petition and Preliminary Response. *See also* 37 C.F.R. § 42.2 (“*Preliminary Proceeding* begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted.”). Moreover, we note that the grant of authorization to file the motion is not a decision to grant or deny the motion. Rather, having considered the parties’ arguments on the call, we are persuaded that allowing the parties to brief this issue in the record is in the interest of justice to maintain a clear and complete record of this dispute between the parties as it relates to the arguments presented in the Petition and Patent Owner’s Preliminary Response.

Accordingly, we authorize Petitioner to file a motion to deem facts admitted. Petitioner’s brief is limited to five (5) pages to be filed by September 5, 2017. Patent Owner may file an opposition, also limited to five (5) pages, by September 12, 2017. Petitioner may further file a reply to Patent Owner’s opposition by September 19, 2017, limited to three (3) pages. Additionally, at this time, we do not authorize that any testimonial evidence and/or declarations may accompany the briefs. Should either party anticipate a need to file supporting testimonial evidence and/or declarations, the parties are instructed to confer and contact the Board with available dates/times for a conference call.

Accordingly, it is

ORDERED that Petitioner is authorized to file, no later than September 5, 2017, a Reply to Patent Owner’s Preliminary Response, limited to five (5) pages;

FURTHER ORDERED that Patent Owner is authorized to file, no later than September 12, 2017, a Sur-reply to Petitioner’s Reply, limited to five (5) pages;

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FURTHER ORDERED that Petitioner is authorized to file, no later than September 5, 2017, a Motion to Deem Facts Admitted, limited to five (5) pages;

FURTHER ORDERED that Patent Owner may file, no later than September 12, 2017, an Opposition to Petitioner's Motion, limited to five (5) pages;

FURTHER ORDERED that Petitioner may file, no later than September 19, 2017, a Reply to Patent Owner's Opposition to Petitioner's Motion, limited to three (3) pages; and

FURTHER ORDERED that Petitioner and Patent Owner are not authorized at this time to file supporting testimonial evidence and/or declarations with the aforementioned briefing.

PETITIONER:

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