

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROQUETTE FRERES, S.A.,  
Petitioner,

v.

TATE & LYLE INGREDIENTS AMERICAS LLC,  
Patent Owner.

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Case IPR2017-01506, Patent 7,608,436 B2  
Case IPR2017-01507, Patent 8,057,840 B2<sup>1</sup>

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Before LORA M. GREEN, GRACE KARAFFA OBERMANN,  
and JACQUELINE T. HARLOW, *Administrative Patent Judges*..

OBERMANN, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request to File a Reply Brief  
Granting Patent Owner's Request to File a Sur-Reply Brief  
*37 C.F.R. § 42.20(d)*

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<sup>1</sup> This Order addresses issues common to both proceedings, therefore, we issue a single Order that is entered in both case files. The parties may use this style heading when filing an identical paper in both proceedings, provided that such heading includes a footnote attesting that "the word-for-word identical paper is filed in each proceeding identified in the heading."

IPR2017-01506 (Patent 7,608,436 B2)

IPR2017-01507 (Patent 8,057,840 B2)

At Petitioner's request, the Board conducted a telephone conference with counsel for both parties on October 3, 2017. Ex. 3001. Judges Obermann, Green, and Harlow participated in the call. Neither party engaged a court reporter. During the call, both parties presented arguments regarding Petitioner's request to file a Reply Brief, supported by limited additional evidence, targeted to addressing an "unanticipated" issue raised in the Preliminary Response. *Id.* After considering all arguments presented by both parties, we granted Petitioner's request subject to the conditions and schedule set forth below.

The Petition relied on the Board's decision in *Hamamatsu Corp. v. Sionyx, LLC.*, IPR2016-01910, Paper 22 (P.T.A.B. Mar. 30, 2017) (*Hamamatsu I*). Petitioner's request for additional briefing was triggered by arguments made in the Preliminary Response, pertaining to the Board's subsequent decision in *Hamamatsu Corp. v. Sionyx, LLC.*, IPR2016-01910, Paper 28 (P.T.A.B. May 26, 2017) (*Hamamatsu II*), which reverses one portion of *Hamamatsu I* cited in the Petition. Ex. 3001. During the call, we were persuaded that several factors favored granting Petitioner's request, given the particular circumstances presented in this case.

First, Petitioner shows sufficiently that the arguments in the Preliminary Response, pertaining to *Hamamatsu II*, were "unanticipated." Ex. 3001. The *Hamamatsu II* decision issued one business day before the filing of the Petition. During the conference call, counsel for Petitioner explained that the Petition was cite checked before issuance of the decision in *Hamamatsu II*. Accordingly, Petitioner was unaware of *Hamamatsu II* when the Petition was filed.

IPR2017-01506 (Patent 7,608,436 B2)

IPR2017-01507 (Patent 8,057,840 B2)

Second, considerations of timing and burden favor granting the request. The statutory due dates for the institution decisions in these cases fall on December 8, 2017, and December 15, 2017. Petitioner made the request for additional briefing well in advance of the due dates. Further, during the telephone conference, Petitioner proposed a reasonable briefing schedule that would include a Sur-Reply for Patent Owner. We were persuaded that the schedule proposed by Petitioner would not unduly burden either party or disturb the schedule in either proceeding. Patent Owner responded that it may require up to two weeks to prepare a Sur-Reply, in the event that Patent Owner resolves to include a supporting witness declaration. We pointed out that one week is reasonable in view of the impending deadline for the institution decisions and, further, observed that Patent Owner will have ample time and opportunity to fully develop its positions, in the context of a full Patent Owner's Response, should trial be instituted.

Third, interests of efficiency favor granting the request. Any error on Petitioner's part, in failing to discover the Board's decision in *Hamamatsu II* before filing of the Petition, is mitigated by the fact that *Hamamatsu II* issued only one business day before the filing of the Petition. Counsel for Petitioner confirmed that Petitioner has not been served with a district court complaint for infringement; therefore, Petitioner faces no statutory time bar that would preclude the filing of a Petition based on *Hamamatsu II*. Permitting additional briefing, under the circumstances, serves the interests of efficiency and speed in reaching a just resolution of the parties' dispute.

Fourth, the scope of the request is reasonable and narrowly tailored to develop issues necessary to our forthcoming decision on institution.

Petitioner requests briefing limited to addressing Patent Owner's

IPR2017-01506 (Patent 7,608,436 B2)

IPR2017-01507 (Patent 8,057,840 B2)

unanticipated arguments pertaining to *Hamamatsu II*. Those arguments relate to whether certain processes recited in the challenged claims impart distinctive structural and functional characteristics to a product. Ex. 3001. During the telephone conference, Petitioner demonstrated adequately that those issues warrant the submission of limited additional evidence, in the form of a short supplemental witness declaration. Granting the further request to include limited supporting evidence is warranted in view of the relevance of the information at hand. The interests of fairness favor providing Petitioner a limited opportunity to develop an evidentiary basis for briefing responsive to Petitioner's "unanticipated" arguments. Ex. 3001.

Based on the totality of the circumstances presented in this case, Petitioner shows good cause for a grant of the relief requested. Accordingly, pursuant to our authority to "order briefing on any issue involved in the trial" (37 C.F.R. § 42.20(d)), at the conclusion of the telephone conference, we authorized additional briefing subject to the conditions set forth below.

It is:

ORDERED that Petitioner's request for additional briefing is *granted* subject to the conditions and schedule set forth herein;

FURTHER ORDERED that Petitioner is authorized to file a Reply Brief limited to addressing arguments raised in the Preliminary Response, pertaining to the Board's decision in *Hamamatsu II*;

FURTHER ORDERED that Petitioner's Reply Brief shall be limited to seven (7) pages;

IPR2017-01506 (Patent 7,608,436 B2)

IPR2017-01507 (Patent 8,057,840 B2)

FURTHER ORDERED that Petitioner is authorized to file, in support of the Reply Brief, a single witness declaration, not to exceed fourteen (14) pages;

FURTHER ORDERED that Petitioner's Reply Brief and supporting declaration shall be filed no later than October 10, 2017;

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply Brief limited to addressing arguments raised in Petitioner's Reply Brief;

FURTHER ORDERED that Patent Owner's Sur-Reply Brief shall be limited to seven (7) pages;

FURTHER ORDERED that Patent Owner is authorized to file, in support of the Sur-Reply Brief, a single witness declaration, not to exceed fourteen (14) pages;

FURTHER ORDERED that Patent Owner's Sur-Reply Brief and supporting declaration shall be filed no later than October 17, 2017;

FURTHER ORDERED that no other briefing or supporting evidence is authorized at this time.

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