

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CASCADES CANADA ULC and
TARZANA ENTERPRISES, LLC,
Petitioner,

v.

ESSITY HYGIENE AND HEALTH AB,
Patent Owner.

Case IPR2017-01902 (Patent 8,597,761 B2)
Case IPR2017-01921 (Patent 9,320,372 B2)¹

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
JON B. TORNQUIST, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in both proceedings. The parties are not authorized to use this style heading for any subsequent papers.

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IPR2017-01921 (Patent 9,320,372 B2)

On October 15, 2018, Judges Kokoski, Kalan, and Tornquist held a conference call with counsel for Petitioner and Patent Owner. Petitioner requested the conference to seek authorization to file a motion to strike sur-replies filed by Patent Owner in each of the above-named proceedings. *See* Paper 37; Paper 36.² In particular, Petitioner argued that the Scheduling Order did not authorize Patent Owner to file the sur-replies, and Patent Owner did not seek authorization to file the sur-replies. *See* Paper 11, 5–6; Paper 10, 5–6. Patent Owner responded that it relied on the August 2018 Update to the Trial Practice Guide (“Trial Practice Guide Update”), which provides for sur-replies instead of observations. *See* Trial Practice Guide Update, pages 14–15, Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 (Aug. 13, 2018). Patent Owner explained that, although there is no guidance in the Trial Practice Guide Update as to whether authorization was needed before filing a sur-reply in pending cases, Patent Owner understood the Trial Practice Guide Update to mean that sur-replies simply replaced observations on cross-examination in the Scheduling Order.

We advised Patent Owner that the Trial Practice Guide Update describes sur-replies as being provided for in newly-instituted cases, i.e., ones in which sur-replies “will be authorized by the scheduling order entered at institution,” where it “essentially replaces the previous practice of filing observations on cross-examination testimony.” *See* Trial Practice Guide Update, 14. The Scheduling Order in these proceedings, however, was issued prior to the Trial Practice Guide Update and does not authorize sur-replies. *See* Paper 11, Paper 10. Accordingly, we determined that Patent Owner’s sur-replies were unauthorized.

Our rules recognize that there are instances when failure to comply with the regulations may be mitigated. *See, e.g.*, 37 C.F.R. §§ 42.5(a) (“The Board may

² We sequentially refer to papers filed in IPR2017-01902 and IPR2017-01921.

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determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final order to administer the proceeding.”); 42.5(b) (“The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.”). Allowing Patent Owner to file sur-replies in these proceedings is consistent with the Trial Practice Guide Update. During the call, Patent Owner represented that its sur-replies comply with the limits set forth in the Trial Practice Guide Update, namely, that the sur-replies only reply to arguments made in Petitioner’s Replies and are not accompanied by new evidence. *See* Trial Practice Guide Update, 14–15. Under the circumstances, we waive the prior authorization requirement in this instance.

The Trial Practice Guide Update states that “[s]ur-replies, if authorized, are subject to the same word or page limits as the reply, unless the Board orders otherwise.” Trial Practice Guide Update, 6. Replies to patent owner responses are limited to 5,600 words. *Id.* Patent Owner’s sur-replies, however, exceed this 5,600 word limit. *See* Paper 37, 29; Paper 36, 29. Accordingly, we directed Patent Owner to re-file its sur-replies, limiting each sur-reply to 5,600 words, no later than October 22, 2018.

For the reasons set forth above, it is

ORDERED that Petitioner’s request for authorization to file a motion to strike is *denied*;

FURTHER ORDERED that the sur-replies filed by Patent Owner that exceed the word count limits (Paper 37, Paper 36) will be expunged; and

FURTHER ORDERED that Patent Owner is authorized to re-file a sur-reply in each proceeding, limiting each sur-reply to 5,600 words, no later than October 22, 2018.

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