

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILENT TECHNOLOGIES, INC.,
Petitioner,

v.

THERMO FISHER SCIENTIFIC INC. and
THERMO FISHER SCIENTIFIC (BREMEN) GMBH,
Patent Owner.

Cases

IPR2018-00297 (Patent RE45,553 E)
IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2)
IPR2018-00313 (Patent RE45,386 E)¹

Before MICHAEL R. ZECHER, JOHN F. HORVATH, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

ORDER

Denying Leave to File Replies to the Preliminary Responses
37 C.F.R. § 42.108(c)

¹ This Order addresses an issue that is identical in all four cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties may not use this style heading unless authorized.

IPR2018-00297 (Patent RE45,553 E) IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2) IPR2018-00313 (Patent RE45,386 E)

On April 3, 2018, Petitioner contacted us via email to request a call to seek leave to file a Reply to Patent Owner’s Preliminary Response under 37 C.F.R. § 42.108(c) in each of these proceedings. On April 9, 2018, we held a conference call with the parties to discuss Petitioner’s request. A transcript of the call has been entered as an exhibit in each proceeding. IPR2018-00297, Ex. 1041.² We reiterate some of the discussion here, but we need not repeat all of the details because the complete discussion is reflected in the transcript.

Petitioner explained that it seeks leave to file replies addressing Patent Owner’s arguments on two issues: (1) reasonable expectation of success in each proceeding; and (2) discretionary denial in Cases IPR2018-00297, IPR2018-00298, and IPR2018-00313. With respect to the first issue, Petitioner argued Patent Owner’s suggestion that an obviousness analysis must address reasonable expectation of success is legally incorrect, and Petitioner noted that at least one case cited by Patent Owner issued after the petitions were filed and, thus, could not have been addressed in the petitions. Ex. 1041, 6:6–9:7, 19:21–20:14. With respect to the second issue, Petitioner argued that § 325(d) “does not actually permit discretionary denial of IPRs” and, therefore, that it could not have anticipated Patent Owner’s arguments regarding § 325(d). Ex. 1041, 9:16–11:22. On the call, Petitioner also

² For purposes of expediency, we refer to the papers and exhibits filed in Case IPR2018-00297. The same papers were filed in Cases IPR2018-00298, IPR2018-0299, and IPR2018-00313.

IPR2018-00297 (Patent RE45,553 E) IPR2018-00298 (Patent RE45,386 E)
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addressed redundancy and the factors set forth in *General Plastic*³ regarding discretionary denial. Ex. 1041, 12:1–13:3.

Patent Owner responded that Petitioner has not shown that good cause exists for a reply. Ex. 1041, 13:6–19:13. In particular, Patent Owner responded that, although Petitioner’s request shows that there is disagreement between the parties on various issues, such disagreement is “not the type of good cause under the regulations that warrants a Reply in IPR proceedings.” Ex. 1041, 13:6–14:10.

Our Rules governing IPRs provide that “[a] petitioner may seek leave to file a reply to the preliminary response” but that “[a]ny such request must make a showing of good cause.” 37 C.F.R. § 42.108(c). Having reviewed the record and after considering the parties’ positions, we agree with Patent Owner that Petitioner has not shown that good cause exists for a reply under these circumstances. Petitioner’s arguments show there is disagreement between the parties, which is to be expected in adversarial proceedings. Good cause, however, requires more. We are aware of the legal standards for obviousness and we are fully capable of assessing Petitioner’s obviousness contentions to determine whether the threshold for institution has been satisfied without the need for further briefing. With respect to discretionary denial, the record adequately reflects Petitioner’s statutory interpretation of § 325(d) (Ex. 1041, 9:16–11:22), and we determine that no additional briefing is necessary or warranted on this issue or other issues regarding discretionary denial.

³ *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, (PTAB Sept. 6, 2017) (Paper 19) (precedential). Section II.B.4.i. of *General Plastic* was designated precedential on October 18, 2017.

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In consideration of the foregoing, it is

ORDERED that Petitioner's request for leave to file a Reply to Patent Owner's Preliminary Response under 37 C.F.R. § 42.108(c) in each proceeding is *denied*.

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