

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.

Case IPR2018-00297
Patent RE45,553 E

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

ZECHER, *Administrative Patent Judge*.

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

I. DISCUSSION

A conference call in this proceeding was held on September 5, 2018, between respective counsel for Petitioner and Patent Owner, and Judges Zecher, Horvath, and Galligan. Patent Owner, Thermo Fisher Scientific Inc. and Thermo Fischer Scientific (Bremen) GmbH (collectively, “Thermo”), requested the conference call to discuss its intention to file a motion to amend.

During the conference call, Thermo represented that it intends to file a motion to amend that proposes a reasonable number of substitute claims for claims 32–35 and 62–66 of U.S. Patent No. RE45,553 E. In particular, Thermo represented that it would be proposing a smaller set of substitute claims than the nine claims on which we instituted trial. As one example, Thermo represented that it may propose one substitute independent claim, along with three or four substitute dependent claims. For further information and guidance on filing a motion to amend, we directed the parties to *Western Digital Corp. v. SPEX Technologies, Inc.*, Case IPR2018-00082 (PTAB Apr. 25, 2018) (Paper 13) (informative).

Both parties also inquired about the recent updates to the *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756 (Aug. 14, 2012) (“*Trial Practice Guide*”),¹ and the proper procedure for requesting a sur-reply to allow (1) Petitioner, Agilent Technologies, Inc. (“Agilent”), to respond to Thermo’s reply to an opposition to a motion to amend, and (2) Thermo to respond to Agilent’s reply. We explained that, when, as here, a scheduling order was issued prior to the updates to the *Trial Practice Guide*, we handle requests for sur-replies on a case-by-case basis. We explained that the parties should wait for the record to develop further before determining whether a sur-reply is necessary.

¹https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf

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II. ORDER

In consideration of the foregoing, it is hereby ORDERED that Thermo has satisfied the conference requirement of 37 C.F.R. § 42.121(a) for this proceeding.

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