

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORP.,
Patent Owner.

Case IPR2018-00386
Patent No. 9,490,411 B2

Case IPR2018-00437
Patent No. 9,537,071 B2

Before SALLY C. MEDLEY, WILLIAM V. SAINDON, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

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

IPR2018-00386 (Patent No. 9,490,411 B2)
IPR2018-00437 (Patent No. 9,537,071 B2)

On February 4, 2019, a telephone conference call was held to discuss Petitioner's request to file sur-sur-replies in each of these proceedings in response to Patent Owner's Sur-Replies, filed January 29, 2019 (IPR2018-00386, Paper 28; IPR2018-00437, Paper 39). A transcript of the telephone conference has been entered into the record in each proceeding. IPR2018-00386, Ex. 1042; IPR2018-00437, Ex. 1042.

According to Petitioner, good cause for the requested sur-sur-replies exists because Patent Owner's Sur-Replies contain new arguments and evidence regarding claim construction. *Id.* at 5:18–22. Petitioner states that Patent Owner's Sur-Reply in IPR2018-00386 includes new drawings, exhibits, and arguments that Petitioner should be permitted to address. *Id.* at 5:23–7:5; 13:20–15:5. Regarding IPR2018-00437, Petitioner states that Patent Owner's claim-construction arguments cite a Final Written Decision in IPR2018-01608 dated January 9, 2019, which issued after the December 11, 2018 deadline for Petitioner's Reply, and Petitioner contends that it should be permitted to address Patent Owner's arguments regarding that Decision, among other things. *Id.* at 7:6–23; 15:6–17.

Patent Owner contends that its Sur-Replies do not include new evidence or new arguments. *Id.* at 9:24–12:19. According to Patent Owner, the purportedly new drawings and exhibits are demonstratives used during cross examination of Petitioner's expert witness, and the purportedly new arguments relate to the parties' original claim-construction positions, not newly argued claim terms or improper new arguments that could amount to good cause for a sur-sur-reply. *See Id.*

At this stage, based on our current understanding of the parties' positions and our review of the parties' briefs, we are not persuaded that

IPR2018-00386 (Patent No. 9,490,411 B2)

IPR2018-00437 (Patent No. 9,537,071 B2)

Patent Owner's Sur-Replies include improper new arguments or new evidence. Instead, based upon our current review, Patent Owner's arguments are properly responsive to Petitioner's arguments. Further, the allegedly new evidence consists of material illustrating an argument, which is particularly apt in this case given that much of the dispute involves the relative spatial positions of structures. Notwithstanding, because the parties' dispute certain claim interpretations that are central to this proceeding and, reviewing the existing briefing, we believe that additional briefing on the issues identified above would be beneficial and provide us further development of the issues. Therefore, we determine that allowing Petitioner to file a sur-sur-reply will be helpful to our decision-making process.

Petitioner is authorized to file one sur-sur reply common to both proceedings, not exceed three pages of argument. Patent Owner is permitted one response to Petitioner's sur-sur-reply subject to the same limitations, to be entered in each proceeding. Neither party's paper may cite evidence not already of record as of the mailing date of this order.

V. ORDER

In view of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a single, common sur-sur-reply not to exceed three pages in response to Patent Owner's Sur-Replies, with the same sur-sur-reply being filed in each of the proceedings, by February 11, 2019

FURTHER ORDERED that Patent Owner is authorized to file in each of these proceedings a single, common response to Petitioner's sur-sur-reply, not to exceed three pages, by February 15, 2019.

IPR2018-00386 (Patent No. 9,490,411 B2)

IPR2018-00437 (Patent No. 9,537,071 B2)

PETITIONER:

Gabrielle E. Higgins

James L. Davis, Jr.

Christopher M. Bonny

James F. Mack

Scott McKeown

gabrielle.higgins@ropesgray.com

James.L.Davis@ropesgray.com

Christopher.Bonny@ropesgray.com

James.Mack@ropesgray.com

Scott.McKeown@ropesgray.com

VIZIO2NichiaIPRs@ropesgray.com

PATENT OWNER:

Martin Zoltick

Michael Jones

Mark Rawls

Robert P. Parker

Derek F. Dahlgren

mzoltick@rfem.com

mjones@rfem.com

mrawls@rfem.com

rparker@rfem.com

ddahlgren@rfem.com