

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NAVISTAR, INC.,
Petitioner,

v.

FATIGUE FRACTURE TECHNOLOGY, LLC,
Patent Owner.

Case IPR2018-00853
Patent 7,143,915 B2

Before LINDA E. HORNER, BENJAMIN D. M. WOOD, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

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

Petitioner Navistar, Inc. contacted the Board to request authorization to file a motion to strike portions of Patent Owner Fatigue Fracture Technology, LLC's sur-reply and exhibits accompanying the sur-reply. Exhibit 3001. Petitioner asserts that portions of the sur-reply and the accompanying exhibits contain new, untimely arguments. We hereby authorize Petitioner to file a five-page motion to strike on or before May 2, 2019. We further authorize Patent Owner to file a five-page opposition to the motion to strike on or before May 9, 2019.

We direct the parties' attention to the guidance provided in the Office Patent Trial Practice Guide, August 2018 Update. The Guide explains, "The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony." *See* Office Patent Trial Practice Guide, August 2018 Update, at 14 (August 13, 2018), available at <https://go.usa.gov/xU7GP> ("Guide Update"); *see also* 37 C.F.R. § 42.23(b) ("[a] reply may only respond to arguments raised in the [preceding brief]"). The Guide Update explains that "'respond,' in the context of § 42.23(b), does not mean embark in a new direction with a new approach as compared to positions taken in a prior filing." *Id.* at 15. A "sur-reply that raises a new issue or belatedly presents evidence may not be considered." *Id.*

In each motion to strike, Petitioner should identify by page and line numbers of the sur-reply or by exhibit number those portions of the sur-reply or accompanying exhibits Petitioner believes exceed the proper scope set forth in 37 C.F.R. § 42.23(b), identify exactly which arguments in those

identified portions the sur-reply and exhibits exceed the proper scope, and explain specifically why those arguments exceed the proper scope. Petitioner must also explain why their request to strike the entirety or a portion of Patent Owner's sur-reply warrants such an exceptional remedy.

Patent Owner may then file an opposition to the motion to strike in which Patent Owner responds to each item set forth by Petitioner, citing by paper or exhibit, page, and line number, to the issue the sur-reply argument is addressing.

The parties are not permitted to submit any additional arguments regarding the patentability of the challenged claims in the motion to strike or the opposition and no additional evidence may be submitted. If we determine that any issue identified by Petitioner in its motion warrants additional briefing, we will issue an additional order providing instructions for such briefing. Absent such an order, no further briefing is authorized. That is, the parties shall not submit any proposed replies and sur-replies to the motion and opposition.

It is hereby:

ORDERED that Petitioner's request for authorization to file a motion to strike is *granted*;

FURTHER ORDERED that Petitioner may file a five-page motion to strike by May 2, 2019 in accordance with the instructions above;

FURTHER ORDERED that Patent Owner may file a five-page opposition to the motion to strike by May 9, 2019 in accordance with the instructions above; and

FURTHER ORDERED that no additional briefing is authorized.

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