

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

Case IPR2018-01442
Patent 9,695,751 B2

Before HYUN J. JUNG and SCOTT A. DANIELS,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge.*

ORDER

Granting Authorization for Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

A conference call was conducted September 23, 2019, between Judges Daniels and Jung, and Patent Owner's counsel, Mr. Holt and Mr. Renner, and Petitioner's counsel, Mr. Ferguson and Mr. Musher, to discuss Mr. Holt's request, in an email to the Board of September 20, 2019, to submit four U.S. patents to the Board along with Patent Owner's Sur-Reply.

During the call Mr. Holt explained that the four patents are offered in response to Petitioner's evidence and arguments, which Patent Owner asserts were first raised in Petitioner's Reply, as to the level of ordinary skill in the art and the understanding and interpretation of a prior art reference, namely Knip's Figure 10, relied upon by Petitioner in its single reference obviousness challenge to claims 3 and 16.

Mr. Ferguson argued that Petitioner's assertions as to the level of one of ordinary skill in the art and the understanding of Knip's Figure 10 are not new arguments or evidence, as they were initiated in the Petition, and that Patent Owner's submission of these four patents is untimely and should have occurred earlier.

We determined Patent Owner's request was a request for authorization to file a Motion to Submit Supplemental Information. *See* 37 C.F.R. §§ 42.123(b). We point out that supplemental information must be responsive and not simply new evidence that could have been filed earlier. *See* Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012). During the call we authorized Patent Owner's counsel to file a five page motion no later than September 27, 2019. We authorized Petitioner's counsel to file a five page opposition no later than October 4, 2019. The parties should meet and confer regarding

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changes to due dates 3, 4, and 5 to accommodate filing of Patent Owner's sur-reply subsequent to our determination on the Motion. We also indicated to the parties that if the Motion were to be granted, Petitioner would be given an opportunity to file a narrowly tailored response to the four patents.

The due date for oral argument (if requested) is unchanged, and remains scheduled for October 30, 2019.

After considering Patent Owner's request, it is:

ORDERED that Patent Owner's request for authorization to file a Motion to Submit Supplemental Information, limited to five pages and due no later than September 25, 2019, is *granted*; and

FURTHER ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's Motion to Submit Supplemental Information, also limited to five pages, no later than October 4, 2019.

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