

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMP PLUS, INC., dba ELCO LIGHTING,
Petitioner,

v.

DMF, INC.,
Patent Owner.

IPR2019-01094
Patent 9,964,266 B2

Before CHRISTOPHER L. CRUMBLY, JEFFREY W. ABRAHAM, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

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

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The Board received email correspondence from the parties on July 31, 2020 concerning four issues. Ex. 3010 (July 31, 2020 email correspondence directed to the Board from Patent Owner and Petitioner). The Board held a conference call with the parties on August 11, 2020 to discuss the issues.

Jurisdiction

Patent Owner alleges that the Petition is barred as to claims 17 and 21 under 35 U.S.C. § 315(a)(1) because Petitioner filed a declaratory judgment action alleging invalidity of those claims in a parallel district court action.

Patent Owner may file a motion to dismiss of no more than five pages on or before August 17, 2020. Petitioner may file a response of no more than five pages on or before August 24, 2020.

Transcript of Deposition of James Benya

Patent Owner alleges that poor audio quality caused portions of the July 7, 2020 transcript of the deposition of James Benya (Ex. 1038) to be mistranscribed, and seeks authority to replace the original version with a revised version certified by the court reporter. Petitioner cites to Exhibit 1038 repeatedly in its Reply (Paper 42).

Patent Owner may file the revised deposition transcript certified by the court reporter as a new exhibit with its sur-reply. Existing Exhibit 1038 shall remain a part of the record.

New Arguments in Petitioner's Reply Brief

Patent Owner alleges that Petitioner makes new arguments in its Reply Brief (Paper 42), and requests permission to file a separate document identifying the new arguments.

The general purpose of a sur-reply is to address matters presented in an opposing party's reply. Under such circumstances, Patent Owner may

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identify and address any new arguments in Petitioner's Reply in its sur-reply. Patent Owner's request for an additional filing on new arguments is denied.

Alleged Inconsistent Statements by Petitioner

Patent Owner alleges that Petitioner made statements in the Petition that are inconsistent with statements made in U.S. Patent No. 10,295,163 (the "'163 patent") and its prosecution history. Patent Owner contends that Petitioner was required to disclose the inconsistent statements in discovery in compliance with 37 C.F.R. § 42.51(b)(1)(iii). Patent Owner argues that the inventor listed on the '163 patent is a Director of Operations for Petitioner.

Petitioner disputes that the statements identified by Patent Owner are inconsistent, and asserts that the inventor listed on the '163 patent, while an employee of Petitioner, filed the application leading to the '163 in his individual capacity, and thus any statements made in the patent or during prosecution of the application leading to the patent are from the inventor himself, and not attributable to Petitioner.

Even accepting Patent Owner's allegations that statements made in the Petition are inconsistent with statements made in connection with the '163 patent as accurate, we do not agree that such statements made in the '163 patent and its prosecution history are relevant—and thus discoverable—in this matter, given that the inventor of the '163 patent was acting in his individual capacity, and not on behalf of Petitioner, in making such statements. As a result, we deny Patent Owner's request to submit evidence of the allegedly inconsistent statements made in the '163 patent and its prosecution history.

ORDER

It is

ORDERED that Patent Owner is authorized to file a motion to dismiss the *inter partes* review as barred under 35 U.S.C. § 315(a)(1) of no more than five pages on or before August 17, 2020, and Petitioner may file a response of no more than five pages on or before August 24, 2020;

FURTHER ORDERED that Patent Owner is authorized to submit the revised certified version of the July 7, 2020 deposition transcript of James Benya as a new exhibit with its sur-reply;

FURTHER ORDERED Patent Owner's request for authorization to submit a document separate from its sur-reply identifying new arguments in Petitioner's Reply is DENIED; and

FURTHER ORDERED that Patent Owner's request for authorization to submit evidence of alleged inconsistent statements made in the '163 patent and its prosecution history is DENIED.

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