

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS GAMESA RENEWABLE ENERGY, INC.,
Petitioner,

v.

GENERAL ELECTRIC COMPANY,
Patent Owner.

IPR2022-01279; Patent 7,629,705 B2
IPR2022-01479; Patent 6,921,985 B2

Before BARBARA A. PARVIS, JEFFREY W. ABRAHAM, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Granting In Part Petitioner's Request for Additional Briefing
37 C.F.R. § 42.108(c)

BACKGROUND

On January 27, 2023, Petitioner’s counsel requested authorization to file a reply to the Patent Owner Preliminary Response in each of the above identified proceedings. Specifically, in IPR2022-01479, Petitioner requested permission to “to reply to [Patent Owner’s] *General Plastic*^[1] analysis as presented in the Preliminary Response.” IPR2022-01479, Ex. 3001. In IPR2022-01279, Petitioner requested permission to reply to Patent Owner’s “analysis of 35 U.S.C. § 325(d),” “*General Plastic* analysis,” and characterizations of the Challenged Claims as presented in the Preliminary Response.” IPR2022-01279, Ex. 3001. Patent Owner opposed the requests.

A telephone conference to discuss Petitioner’s requests was held on February 1, 2023, among counsel for Petitioner, counsel for Patent Owner, and Judges Parvis, Abraham, and Howard.

Petitioner argues that the *General Plastic* argument was not foreseeable because this was Petitioner’s first petition against each of the challenged patents.² Petitioner further argues that based on the differences between Hudson—relied on in the Petition—and Erdman—which was relied on in earlier proceedings—it could not have reasonably expected an argument based on 35 U.S.C. § 325(d). Petitioner further argues that in light of the claim construction in a different proceeding, Petitioner could not have expected Patent Owner’s mischaracterization of the invention.

¹ *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i).

² This argument applies to both proceedings. The other arguments only apply to IPR2022-01279.

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Patent Owner argues that because *General Plastic* was designated precedential more than five years ago, *Valve*³ was designated precedential more than three years ago, and the Consolidated Trial Practice Guide⁴ (“CTPG”) was issued more than three years ago, it was reasonably foreseeable that Patent Owner would make a *General Plastic* argument for discretionary denial. Patent Owner further argues that, based on Petitioner’s discussion of the prior proceedings, it was reasonably foreseeable that Patent Owner would make an argument based on section 325(d). Patent Owner further argues that a mere disagreement over the description of the claims or prior art is not good cause.

ANALYSIS

A. *Legal Standard*

A petitioner “seek[ing] leave to file a reply to the preliminary response . . . must make a showing of good cause.” 37 C.F.R. § 42.108(c) (2022). “However, the Board does not expect that such a reply will be granted in many cases due to the short time period the Board has to reach a decision on institution.” CTPG 52.

When determining whether Petitioner has shown good cause for a reply to a preliminary response, the Board may assess whether the argument at issue in the Preliminary Response was reasonably foreseeable. *See, e.g., Illumina, Inc. v. The Trs. of Columbia Univ. in the City of New York*, IPR2018-00797, Paper 17 at 3 (PTAB Aug. 7, 2018) (Order) (stating that

³ *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, -00065, -00085, Paper 10 (PTAB May 1, 2019) (Precedential).

⁴ Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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“the Board may authorize a reply to afford a petitioner the opportunity to address evidence or arguments that it could not have reasonably foreseen”); *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2017-01824, Paper 13 at 3 (PTAB Dec. 15, 2017) (Order) (same).

B. General Plastic

In October 2017, the Director designated Section II.B.4.i. of *General Plastic* precedential. In the precedential portion of that decision, the Board held that although there is “no *per se* rule precluding the filing of follow-on petitions after the Board’s denial of one or more first-filed petitions on the same patent,” “[t]he Board consistently has considered a number of factors in determining whether to exercise that discretion.” *General Plastic*, Paper 19, 15. The decision then identified seven non-exhaustive factors that the Board considers when deciding whether to discretionarily deny institution to a follow-on petition. *Id.* at 16. *General Plastic* can be found on the USPTO’s website⁵ and is discussed in the Consolidated Trial Practice Guide.⁶ See CTPG 56–58.

Since that time, patent owners have routinely argued that the Board should exercise its discretion and deny institution based on *General Plastic* whenever a petition is not the first petition to challenge the patent, regardless of the identity of the two petitioners. See, e.g., *PNC Bank, N.A. v. United Services Auto. Ass’n*, IPR2021-01073, Paper 20 at 14–22 (PTAB Jan. 24, 2022) (Institution Decision) (Public Version Paper 25). Because the

⁵ Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>

⁶ It is also discussed in the August 2018 Trial Practice Guide Update. Available at https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf

General Plastic argument was reasonably foreseeable, Petitioner has not shown sufficient good cause for a reply.

C. 35 U.S.C. § 325(d)

35 U.S.C. § 325(d) provides that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Patent Owner’s 325(d) argument is premised on its argument that Hudson is “substantially the same prior art” as Erdman. However, because there is no facial similarity between Hudson and Erdman—for example, they do not involve the same authors/inventors, same company, same drawings, or same product—it was not reasonably foreseeable that Patent Owner would make its section 325(d) argument. Accordingly, Petitioner has shown sufficient good cause for a reply brief directed to that issue.

D. Characterization of Claimed Invention

Parties routinely disagree about the scope of the claims or the teachings of the prior art. But a mere disagreement regarding the characterization of the claimed invention is not sufficient good cause. We are able to review the claims on our own and determine, based on the preliminary record, whether Patent Owner’s description of the invention is consistent with the words of the claim. Accordingly, Petitioner has not shown good cause for a reply brief on this topic.

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