

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APEX TOOL GROUP, LLC,
Petitioner,

v.

MILWAIKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

PGR2020-00056
Patent 10,422,617 B1

Before GRACE KARAFFA OBERMANN, JOHN A. HUDALLA, and
AARON W. MOORE, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authorizing Additional Briefing
37 C.F.R. § 42.20(d)

Petitioner challenges the patentability of Patent No. 10,422,617 B1 (“the ’617 patent”). *See generally* Paper 1 (“Petition”). On July 30, 2020, Petitioner submitted an email to the Board requesting authorization to file a five-page Reply to Patent Owner’s Preliminary Response (Paper 9) to the Petition. Ex. 3001, 2 (copy of email correspondence). On July 31, 2020, Patent Owner submitted an email opposing Petitioner’s request. *Id.* at 1–2. That same day, the Board authorized the parties to file a Reply and Sur-reply. *Id.* at 1 (Board’s responsive email of July 31, 2020). An Order entered September 3, 2020, memorializes the terms and conditions of that additional briefing. Paper 11 (“the Order”). We advised the parties that the Reply and Sur-reply were limited in substance to a solitary argument raised in Patent Owner’s Preliminary Response, namely, “that the ‘conventional tape measure blade design’ identified as ‘Prior Art 2’ in the [’617] patent’s specification is not prior art.” Order, 2; Ex. 3001, 2.

The additional briefing authorized by the Order was completed on August 14, 2020. Four days later, the Director of the United States Patent and Trademark Office issued a memorandum setting forth guidance on how the Board shall consider statements by a patent applicant in a patent specification regarding the prior art when those statements are relied on in support of a request for *inter partes* review. *See* Memorandum from Andrei Iancu to Members of the Patent Trial and Appeal Board (Aug. 18, 2020), https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf (“AAPA Guidance Memo”).

Given the circumstances set forth above, and in order to more fully and fairly develop the arguments in light of the recent AAPA Guidance

Memo, we authorize, *sua sponte*, additional briefing limited to issues pertaining to the AAPA Guidance Memo as detailed below. *See* 37 C.F.R. § 42.20(d) (2019) (“The Board may order briefing on any issue involved in the trial.”). Specifically, any Additional Brief filed pursuant to this Order should address (1) whether the AAPA Guidance Memo has any bearing in post-grant review proceedings, including an explanation based on relevant points and authorities; and (2) the substantive effect of the AAPA Guidance Memo, if any, on the grounds stated in the Petition. Briefing will commence with simultaneous opening briefs followed by simultaneous responsive briefs, as set forth more particularly below.

It is

ORDERED that Petitioner is authorized to file an Additional Brief limited to issues pertaining to the AAPA Guidance Memo, namely,

(1) Whether the AAPA Guidance Memo has any bearing in post-grant review proceedings, including an explanation based on relevant points and authorities; and

(2) The substantive effect of the AAPA Guidance Memo, if any, on the grounds stated in the Petition;

FURTHER ORDERED that Patent Owner likewise is authorized to file an Additional Brief limited to issues pertaining to the AAPA Guidance Memo, namely,

(1) Whether the AAPA Guidance Memo has any bearing in post-grant review proceedings, including an explanation based on relevant points and authorities; and

(2) The substantive effect of the AAPA Guidance Memo, if any, on the grounds stated in the Petition;

FURTHER ORDERED that the Additional Briefs shall be five pages or less in substantive length and filed no later than September 23, 2020;

FURTHER ORDERED that Petitioner is authorized to file a Responsive Brief in the event that Patent Owner files an Additional Brief pursuant to the above authorization;

FURTHER ORDERED Patent Owner likewise is authorized to file a Responsive Brief in the event that Petitioner files an Additional Brief pursuant to the above authorization;

FURTHER ORDERED that any Responsive Brief filed pursuant to this Order shall be limited to responding to arguments made in the opposing party's Additional Brief, shall be five pages or less in substantive length, and shall be filed no later than September 30, 2020;

FURTHER ORDERED that no new evidence shall accompany any Additional Brief or Responsive Brief authorized by this Order; and

FURTHER ORDERED that no other briefing or relief is authorized at this time.

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