

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SWEEGEN, INC.,
Petitioner,

v.

PURECIRCLE SDN BHD AND PURECIRCLE USA INC.,
Patent Owners.

PGR2020-00070
Patent 10,485,257 B2

Before SUSAN L. C. MITCHELL, JENNIFER MEYER CHAGNON, and
JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, Administrative Patent Judge.

ORDER
Conduct of Proceedings
37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)

On October 30, 2020, Petitioner requested a conference call seeking permission to file a Reply to Patent Owner’s Preliminary Response. Paper 10 (“Preliminary Response”). More specifically, Petitioner requested authorization to file a Reply addressing Patent Owner’s arguments for denial of institution under 35 U.S.C. § 325(d) raised at pages 1–2 and 61–63 of the Preliminary Response.

A conference between the Board (Judges Wisz, Mitchell, and Chagnon) and the parties’ counsel took place on November 12, 2020. After considering the parties’ contentions made during the conference, we concluded that good cause exists for Petitioner’s request, and we authorize the filing of a Reply to the Preliminary Response. 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”).

We are persuaded Petitioner could not have foreseen Patent Owner’s particular arguments regarding 35 U.S.C. § 325(d), and thus, Petitioner should be given an opportunity to respond to those arguments now. Moreover, having a meaningful response from Petitioner on those arguments will help the Board determine whether denial of the Petition under § 325(d) is (or is not) appropriate. In particular, the Board would benefit from, *inter alia*, briefing on the factors set forth in *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate Gmbh*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) and *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential).

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In consideration of the forgoing, it is hereby:

ORDERED that Petitioner may file a five page Reply brief, addressing only discretionary denial under 35 U.S.C. § 325(d), no later than November 23, 2020;

FURTHER ORDERED that Patent Owner may file a five page Sur-Reply no later than December 4, 2020 in response to Petitioner's Reply; and

FURTHER ORDERED that no other briefing is authorized.

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