

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UMICORE AG & CO. KG,
Petitioner,

v.

BASF CORPORATION,
Patent Owner.

Cases IPR2015-01121, IPR2015-01123, IPR2015-01124, IPR2015-01125¹
Patents 7,601,662 and 8,404,203

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. §§ 42.5, 42.123(b)

¹ This order addresses similar topics in four cases. We exercise our discretion to issue a single Order, to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2015-01121, IPR2015-01123, IPR2015-01124, IPR2015-01125
Patents 7,601,662 and 8,404,203

On April 29, 2016, a conference call was held between counsel for the parties and Judges Crumbley, Kokoski, and Abraham. The purpose of the call was to discuss Patent Owner's request for authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b), which pertains to the submission of supplemental information more than one month after the date trial is instituted.² Specifically, Patent Owner seeks to submit a copy of U.S. Patent Application No. 2016/0038875 ("the '875 application"), published February 11, 2016, the day before Patent Owner's response to the Petition was due. Patent Owner argues that the '875 application, filed by Petitioner, contains information that is inconsistent with positions taken by Petitioner in these proceedings.

Petitioner opposes Patent Owner's request. Specifically, during the conference call, Petitioner questioned the relevance of the '875 application and argued that Patent Owner reasonably could have obtained the supplemental information earlier. Petitioner also argued that it would be prejudiced by allowing Patent Owner to file its motion to submit supplemental information at this stage of the proceedings, because, *inter alia*, depositions are over and Petitioner's Reply is due on May 13, 2016.

After considering the parties' arguments, we authorize Patent Owner to file an eight-page motion to submit supplemental information by Friday, May 13, 2016. Petitioner is authorized to file an eight-page opposition by Tuesday, May 24, 2016. No reply is authorized at this time.

² In IPR2015-01121 and IPR2015-01125, we instituted trial on October 29, 2015. In IPR2015-01123 and IPR2015-01124, we instituted trial on November 2, 2015.

IPR2015-01121, IPR2015-01123, IPR2015-01124, IPR2015-01125
Patents 7,601,662 and 8,404,203

Pursuant to section 42.123(b) of our Rules, Patent Owner's motion "must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R. § 42.123(b). Furthermore, with regard to Petitioner's arguments regarding prejudice, because the '875 application is currently not part of the record, Petitioner need not address it in its Reply, which is currently due May 13, 2016. The Board may, if appropriate, permit the parties to submit further briefing addressing the '875 application if Patent Owner's motion to submit supplemental information is granted.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b) is *granted*;

FURTHER ORDERED that Patent Owner's motion shall be no more than eight (8) pages and filed no later than May 13, 2016;

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner's motion, which shall be no more than eight (8) pages and filed no later than May 24, 2016; and

FURTHER ORDERED that no reply is authorized at this time.

IPR2015-01121, IPR2015-01123, IPR2015-01124, IPR2015-01125
Patents 7,601,662 and 8,404,203

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