

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLSTEEL INC.,
Petitioner,

v.

DIRTT ENVIRONMENTAL SOLUTIONS LTD.,
Patent Owner.

Case IPR2015-01691
Patent 8,024,901 B2

Before SALLY C. MEDLEY, SCOTT A. DANIELS, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

On September 13, 2018, a conference call was held involving counsel for the respective parties and Judges Medley, Daniels, and Harlow. The purpose of the conference call was to discuss whether the parties seek further briefing and oral hearing for newly instituted claims 8, 11, 13, and 21–23. Paper 46.

During the conference call, Petitioner proposed filing limited briefing and a limited Dr. Beaman declaration regarding claims 8, 11, 13, and 21–23,

directing attention to the Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 (Aug. 2018) (providing link to Trial Practice Guide Update: <https://go.usa.gov/xU7GP> (“Trial Practice Guide Update”). Patent Owner argued that no further briefing was necessary, but if Petitioner is provided an opportunity to file further briefing, Patent Owner would like to respond.

The Trial Practice Guide Update states that, in response to issues arising from the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018), “the Board will permit the petitioner, in its reply brief, to address issues discussed in the institution decision. . . . Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability. But a petitioner may submit directly responsive rebuttal evidence in support of its reply.” Trial Practice Guide Update, 14. Petitioner argues that the above guidance applies to the situation here, where we recently modified the Institution Decision to include review of claims 8, 11, 13, and 21–23.

Upon consideration of the record, we authorize Petitioner to file a supplemental brief for the limited purpose of addressing the issues discussed in the Institution Decision regarding claims 8, 11, 13, and 21–23. Paper 10 (“Dec.”).¹ In support of the supplemental brief, Petitioner may submit a declaration for the purpose of presenting “rebuttal evidence” to the findings and determinations we made in the Institution Decision regarding claims 8,

¹ We note, that the Patent Owner Response does not address the newly instituted claims. Paper 24. To the extent there are overlapping issues between the newly instituted claims and the previously instituted claims, the parties already have had a full and fair opportunity to address such overlapping issues.

11, 13, and 21–23. Consistent with the Trial Practice Guide Update, Petitioner may not submit new evidence, issues, or argument that it could have presented earlier, e.g. to make out a prima facie case of unpatentability. Trial Practice Guide Update, 14. The Trial Practice Guide Update provides the following:

Examples of new issues are new theories or arguments necessary to make out petitioner’s case-in-chief for the unpatentability of an original or proposed substitute claim, such as a newly raised rationale to combine the prior art references that was not expressed in the petition. It is also improper to present in reply new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to “gap-fill” by teaching a claim element that was not present in the prior art presented with the petition.

Id. (internal citations omitted).

With these principles in mind, it would not be appropriate for Petitioner to fill in the gaps of the Petition by showing, for the very first time, how the prior art of record describes a claim element that was not accounted for previously. Rather, Petitioner’s supplemental brief is limited to identifying matters that Petitioner believes we misapprehended or overlooked in the Petition, or how we otherwise erred in the Institution Decision for claims 8, 11, 13, and 21–23.

Petitioner’s supplemental brief is limited to 12 pages. Any additional declaration made on behalf of Dr. Beaman is limited to 15 pages. The brief and declaration are due no later than October 19, 2018. Patent Owner may file a response to Petitioner’s supplemental brief, limited to 12 pages, no later than November 28, 2018. To the extent necessary, Patent Owner may cross examine Dr. Beaman and may submit the transcript of any such

deposition in support of its response. Patent Owner may not, however, submit any new evidence in support of the response. Lastly, Petitioner is permitted to file a reply to Patent Owner's response limited to five pages, but may not include any new evidence in support of the reply.² The parties also are authorized to file a request for oral argument explaining why it is necessary to hold an oral hearing and whether the requesting party is amenable to a telephonic hearing.

The parties are not authorized to file any other papers or evidence without prior Board authorization.

It is:

ORDERED that Petitioner is authorized to file a supplemental brief in compliance with this order no later than October 19, 2018, limited to 12 pages;

FURTHER ORDERED that Patent Owner is authorized to file a responsive brief to Petitioner's supplemental brief in compliance with this order no later than November 28, 2018, limited to 12 pages;

FURTHER ORDERED that Petitioner is authorized to file a reply to Patent Owner's responsive brief in compliance with this order no later than December 12, 2018, limited to 5 pages; and

FURTHER ORDERED that the parties are authorized to file a request for oral argument in compliance with this order no later than December 19, 2018; and

² Although the panel does not foresee the need for additional evidence in connection with either Patent Owner's response or Petitioner's reply, to the extent that either party believes that responsive evidence is necessary, it may contact the panel to request authorization to submit such evidence.

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FURTHER ORDERED that the parties are not authorized to file any other papers or evidence without prior Board authorization.

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