

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP, INC.,
Petitioner,

v.

MEMJET TECHNOLOGY, LTD.,
Patent Owner.

Case IPR2016-00537
Patent 7,156,492 B2

Before JAMESON LEE and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

DECISION
Conduct of the Proceedings
37 C.F.R. § 42.51

INTRODUCTION

Patent Owner filed a Preliminary Response on May 9, 2016. Petitioner contacted the Board on June 13, 2016, requesting authorization to file a Reply addressing Patent Owner's argument that, pursuant to 35 U.S.C. § 103(c), the Silverbrook '142 patent (US 6,428,142) cannot be used to challenge the validity of the '492 patent (US 7,156,492).

The Board conducted a conference call with the parties on June 15, 2016. The participants were Dion Bregman and Lindsey Shin for Petitioner, James Glass and John McKee for Patent Owner, and Judges Horvath and Lee.

For the reasons discussed *infra*, we grant Petitioner's request.

DISCUSSION

The '492 Patent claims priority, through a chain of continuation applications, to Australian provisional application AU-PR3996. In its Preliminary Response, Patent Owner argues AU-PR3996 was owned by Silverbrook Research Pty, Ltd. because it was filed on behalf of that entity. *See* Paper 7, 19–20; Ex. 2003.

Petitioner argues Patent Owner's evidence is insufficient to prove ownership of AU-PR3996 under Australian patent law, and we should grant Petitioner's request to file a reply because the Board would benefit from briefing on §§ 15 and 29 of the Australian patent laws pertaining to the application for and ownership of patents. Petitioner therefore requests the Board grant it the right to file a 5 page reply, including a short declaration from Australian counsel.

Patent Owner opposes Petitioner's request, arguing the Board should deny the request because Patent Owner's evidence is *prima facie* proof that Silverbrook Research Pty, Ltd. owned AU-PR3996 under § 195 of the Australian patent laws. Patent Owner requests, should the Board grant Petitioner's request to file a reply, that Patent Owner be granted the right to file a sur-reply with additional evidence. Petitioner does not oppose Patent Owner's request to file a sur-reply with additional evidence in the form of a rebuttal declaration.

The evidence cited by Patent Owner to prove ownership of AU-PR3996 is a printout of that application's details from the electronic Register of the Australian Patent Office. *See* Ex. 2003. Whether that printout proves ownership of AU-PR3996 may be a question of Australian law. *Cf. Int'l Nutrition Co. v. Horphag Research Ltd.*, 257 F.3d 1324, 1329–30 (Fed. Cir. 2001)(approving district court's application of French law to determine ownership of a US patent pursuant to a contractual agreement including a provision to apply French law); *see also Akazawa v. Link New Tech. Int'l, Inc.*, 520 F.3d 1354, 1357–1358 (Fed. Cir. 2008) (remanding case to district court to apply Japanese intestacy law to determine succession of a US patent owned by a deceased Japanese citizen).

“In determining an issue of foreign law, the Board may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.” 37 C.F.R. § 42.62(d). Because we agree with Petitioner that the Board would benefit from briefing by the parties on ownership of AU-PR3996 under Australian law, we grant Petitioner's request to file a reply, and Patent Owner's request to file a sur-reply on that issue only. However, because the parties could not

reach agreement on waiver of any right to cross-examining the other party's declarant, Petitioner's reply and Patent Owner's sur-reply may not introduce testimonial evidence.

ORDER

It is ORDERED that Petitioner may file a Reply to Patent Owner's Preliminary Response on the issue of ownership of AU-PR3996, not to exceed five (5) pages in length, and due on or before June 24, 2016; and

FURTHER ORDERED that Petitioner's Reply shall not contain testimonial evidence; and

FURTHER ORDERED that Patent Owner may file a Sur-Reply to Petitioner's Reply on the issue of ownership of AU-PR3996, not to exceed five (5) pages in length, and due on or before July 1, 2016; and

FURTHER ORDERED that Patent Owner's Sur-Reply shall not contain testimonial evidence.

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Patent No. 7,156,492 B2

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