

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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H&S MANUFACTURING COMPANY, INC.,  
Petitioner,

v.

OXBO INTERNATIONAL CORPORATION,  
Patent Owner.

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Case IPR2016-00950  
Patent 8,166,739 B2

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Before PHILLIP J. KAUFFMAN and JAMES A. TARTAL,  
*Administrative Patent Judges.*

TARTAL, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding  
37 C.F.R. §§ 42.5(a), 42.20(d)

A conference call was held on May 31, 2017, between respective counsel for Petitioner, H&S Manufacturing Company, Inc., Patent Owner, Oxbo International Corporation, and Judges Kauffman and Tartal. Patent Owner sought authorization to file: (1) an opinion and order related to the challenged patent issued by the District Court of the Western District of Wisconsin on May 23, 2017, in *Oxbo Int'l Corp. v. H&S Mfg. Co., Inc.*, 3:15-cv-00292-jdp, as an exhibit; and (2) a surreply to Petitioner's Reply to address new evidence provided by Petitioner. Petitioner opposed Patent Owner's requests. Subsequent to the conference the parties also filed additional documents as exhibits without prior authorization, which we discuss further below.

With regard to the District Court order, Patent Owner contended that the order addresses the patent challenged in this proceeding, is a public document, and should be available to the Board as supplemental legal authority. Petitioner contended that the order is not binding authority on the Board, is premised on a different record than what has been developed in this proceeding, and applies different legal standards, but Petitioner also acknowledged that the order may be informative. In light of the recent issuance of the order, it could not have been brought to our attention earlier and, as a public decision of a district court, it is informative at least as to issues before the district court that are related to the patent at issue in this proceeding. Accordingly, Patent Owner was authorized to file a copy of the order as an exhibit. Subsequent to the conference call, Patent Owner submitted the District Court order on June 16, 2017, as Exhibit 2020. Paper 30.

With regard to Patent Owner's request to file a surreply, Patent Owner contended that Petitioner's Reply includes new evidence, including Exhibit 1025, an Operator's Manual for Petitioner's mergers, which Petitioner relies upon concerning arguments pertaining to copying and secondary considerations of nonobviousness. *See* Reply (Paper 28), 17. Petitioner argued that Patent Owner was obligated to address the issue of secondary considerations in its Response, and should not be permitted to remedy deficiencies through a surreply or to use a surreply as a backdoor to introduce new arguments based on the order issued in the district court, addressed above.

We have considered both parties' arguments, and, based on the circumstances of this case, we are persuaded it is appropriate to allow Patent Owner to file a short surreply to Petitioner's Reply. *See* 37 C.F.R. §§ 42.5(a), 42.20(d); *see also Belden Inc. v. Berk-Tek, LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (noting that, in *inter partes* review proceedings, when new evidence is submitted by a petitioner in its reply, a patent owner may request permission to submit a surreply responding to the new evidence). Our decision to authorize a surreply is influenced by the fact that Petitioner's Reply is accompanied by new evidence related to secondary considerations of nonobviousness that Patent Owner could not reasonably have been expected to directly address in its Response. The surreply shall be limited to three (3) pages and shall be filed no later than July 21, 2017. The surreply shall be directed only to new evidence introduced by Petitioner pertaining to secondary considerations of nonobviousness. Although Patent Owner is not precluded from citing any decision in support of its arguments, including the

district court order addressed above, Patent Owner may not present new arguments that are not responsive as a surreply to Petitioner's Reply. Patent Owner may not introduce new evidence or testimony with its surreply. Petitioner is not authorized to file a responsive paper.

Subsequent to the conference call the parties appear to have filed additional documents not discussed during the conference call as exhibits without seeking leave from the Board in advance. On June 23, 2017, Patent Owner filed Exhibit 2021. On July 12, 2017, Petitioner filed Exhibit 1027 and Exhibit 1028 as purported supplemental authority. Paper 39. Because neither party sought leave to file Exhibits 1027, 1028, and 2021 as supplemental authority in advance, these exhibits shall be expunged. If either party seeks to file additional supplemental authority, prior to requesting a call with the Board, that party shall discuss its request with opposing counsel and identify times when counsel for both parties are available for a teleconference with the Board. Counsel should further consider whether it is necessary to file documents as additional supplemental authority, or whether, instead, the information may be addressed sufficiently during oral argument.

For the foregoing reasons, it is hereby:

ORDERED that Patent Owner is authorized to file as an exhibit the opinion and order related to the challenged patent issued by the District Court of the Western District of Wisconsin on May 23, 2017, in *Oxbo Int'l Corp. v. H&S Mfg. Co., Inc.*, 3:15-cv-00292-jdp;

FURTHER ORDERED that Patent Owner is authorized to file a surreply limited to three (3) pages and responsive only to arguments in

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Petitioner's Reply addressing new evidence concerning secondary considerations of nonobviousness, to be filed no later than July 21, 2017; and

FURTHER ORDERED that no other document is authorized to be filed as an exhibit as supplemental authority, and that Exhibits 1027, 1028, and 2021 shall be expunged.

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