

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GENERAL ELECTRIC COMPANY,  
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,  
Patent Owner.

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Case IPR2016-01289  
Patent 7,060,360 B2

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Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,  
and MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Request for Supplemental Briefing  
*37 C.F.R. § 42.20(d)*

A final hearing was conducted in this proceeding on September 18, 2017. During the presentation of arguments, Petitioner directed the Board to two appellate opinions, which issued after the filing of Petitioner's Reply. *See* Paper 16 (Reply, filed June 27, 2017). Specifically, Petitioner directed the panel's attention to these precedential opinions of our reviewing court:

(1) *Idemitsu Kosan Co. v. SFC Co.*, Civ. No. 2016-2721, 2017 WL 4078964 (Fed. Cir. Sept. 15, 2017) (hereinafter "*Idemitsu*") (precedential);  
and

(2) *Southwire Co. v. Cerro Wire LLC*, Civ. No. 2016-2287, 2017 WL 3927195 (Fed. Cir. Sept. 8, 2017) (hereinafter "*Southwire*") (precedential).

At the conclusion of the final hearing, Patent Owner requested leave to file a supplemental brief, limited to addressing Petitioner's arguments pertaining to those two opinions. Petitioner responded that, although it believes no additional briefing is required, any grant of supplemental briefing should provide Petitioner an equal opportunity to present a paper addressing both opinions.

Several factors persuade us that additional briefing is warranted under the particular circumstances presented in this case.

First, issues of timing favor granting the request. The *Idemitsu* and *Southwire* opinions both issued after merits briefing was concluded in this proceeding; in fact, the *Southwire* opinion issued 10 days, and the *Idemitsu* opinion issued 3 days, prior to the final hearing. Accordingly, we find that Petitioner was justified in directing our attention to those opinions for the first time during the final hearing. Given that the opinions were raised for the first time at the final hearing, moreover, Patent Owner's request for additional briefing was timely made.

Second, the scope of the request is reasonable. Patent Owner requests briefing that is limited to addressing Petitioner's newly-raised arguments pertaining to the *Idemitsu* and *Southwire* opinions. The interests of fairness favor providing Patent Owner an opportunity to respond to Petitioner's newly-raised arguments.

Third, additional briefing is warranted, given the relevance of the information at issue. The *Idemitsu* and *Southwire* opinions were designated by our reviewing court as precedential. Petitioner, during the final hearing, argued that those opinions may bear on issues that are disputed in this case. Further, our review of the opinions persuades us that additional briefing, narrowly tailored to the impact of those opinions on issues in dispute in this proceeding, may promote the just resolution of this case.

Fourth, granting Patent Owner's request for additional briefing will not disturb the timeline or significantly increase the costs associated with this proceeding. In that regard, moreover, Petitioner raised no concerns at the final hearing sufficient to persuade us that granting Patent Owner's request for limited additional briefing will significantly burden Petitioner.

Based on the totality of circumstances presented in this case, we determine that granting Patent Owner's request for additional briefing will serve the interests of justice. Accordingly, pursuant to our authority to "order briefing on any issue involved in the trial" (37 C.F.R. § 42.20(d)), we authorize additional briefing subject to the conditions set forth below.

It is:

ORDERED that Patent Owner's request for additional briefing is  
*granted*;

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FURTHER ORDERED that Petitioner shall file a supplemental brief, limited to addressing Petitioner's arguments pertaining to how the *Idemitsu* and *Southwire* cases bear on the disputed issues in the instant proceeding, by September 26, 2017;

FURTHER ORDERED that Petitioner's supplemental brief shall be limited to five (5) pages;

FURTHER ORDERED that Patent Owner shall file a supplemental brief, limited to responding to arguments raised in Petitioner's supplemental brief, by October 3, 2017;

FURTHER ORDERED that Patent Owner's supplemental brief shall be limited to five (5) pages;

FURTHER ORDERED that neither party shall file new evidence in the record of this proceeding in support of any supplemental brief; and

FURTHER ORDERED that no other briefing is authorized at this time.

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PETITIONER:

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