

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

ONE-E-WAY, INC.,
Patent Owner.

Case IPR2016-01638
Patent 9,282,396 B2

Before DAVID C. MCKONE, ROBERT J. WEINSCHENK, and
JOHN F. HORVATH, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Sony Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–17 of U.S. Patent No. 9,282,396 B2 (Ex. 1001, “the ’396 patent”). One-E-Way, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition. One of the issues presented in the Petition and the Preliminary Response is whether an amendment to an application that adds a statement incorporating by reference an earlier application to which priority was claimed constitutes improperly adding new matter to the application. Pet. 17; Prelim. Resp. 4–14. In addressing this issue, Petitioner cites to the Manual of Patent Examining Procedure (“MPEP”) (Pet. 17), and Patent Owner cites to several decisions by the United States Court of Appeals for the Federal Circuit (Prelim. Resp. 6–11).

The panel has determined that, in this particular case, it is appropriate to authorize Petitioner to file a limited reply to the Preliminary Response. Specifically, Petitioner is authorized to file a 7-page reply by February 8, 2017. The scope of the reply is limited to responding to Patent Owner’s argument that certain decisions by the Federal Circuit indicate that the prohibition against introducing new matter in a patent application after the filing date does not apply in the limited circumstance in which the application incorporates material from an earlier application in a chain of co-pending applications.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may file a 7-page reply according to the instructions above by February 8, 2017;

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FURTHER ORDERED that no additional evidence may be submitted with the reply; and

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

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