

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REACTIVE SURFACES LTD., LLP,
Petitioner,

v.

TOYOTA MOTOR CORPORATION,
Patent Owner.

Case IPR2016-01914
Patent 8,394,618 B2

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

KAISER, *Administrative Patent Judge*.

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

Reactive Surfaces Ltd., LLP (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–11 of U.S. Patent No. 8,394,618 B2 (Ex. 1001, “the ’618 patent”). Toyota Motor Corporation (“Patent Owner”) did not file a Preliminary Response. On March 23, 2017, we instituted trial to determine whether claims 1–11 are unpatentable as obvious. Paper 26 (“Dec.”).

After we instituted trial, Patent Owner filed a Response to the Petition, and Petitioner filed a Reply. Paper 37 (“Resp.”); Paper 41 (“Reply”). On November 13, 2017, Patent Owner contacted the Board by email and requested permission to file a sur-reply addressing three alleged pieces of new evidence or new argument introduced by Petitioner in the Reply. Patent Owner alternatively requested permission to file a motion to strike these portions of the Reply and the evidence cited therein.

We conducted a telephone conference to discuss Patent Owner’s requests. The conference was attended by counsel for Petitioner, counsel for Patent Owner, and Judges Ankenbrand and Kaiser. Following discussion with counsel for both parties, we denied Patent Owner’s request to move to strike any portion of the Reply, but we authorized Patent Owner to file a Sur-Reply addressing the following issues:

1. The discussion of Wang¹ at pages 9–11 of the Reply to support the argument that “stain removal by catalytic action and evaporation were well-known” in the prior art;

¹ Wang et al., US 2008/0119381 A1, published May 22, 2008 (Ex. 1025, “Wang”).

2. The discussion of allegedly new evidence at pages 24–25 of the Reply to support the public accessibility and prior-art status of Exhibit 1013; and
3. The declaration of Eric Ray, introduced along with the Reply, and the supporting evidence cited therein.

As discussed during the conference, Patent Owner’s Sur-Reply shall be filed no later than November 27, 2017, shall not exceed six (6) pages of argument, shall be limited to those issues described above, and shall not introduce any new evidence into the record.

It is, therefore,

ORDERED that Patent Owner is not authorized to file a motion to strike any portion of the Reply;

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply addressing only the following issues:

The discussion of Wang at pages 9–11 of the Reply to support the argument that “stain removal by catalytic action and evaporation were well-known” in the prior art;

The discussion of allegedly new evidence at pages 24–25 of the Reply to support the public accessibility and prior-art status of Exhibit 1013; and

The declaration of Eric Ray, introduced along with the Reply, and the supporting evidence cited therein;

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FURTHER ORDERED that Patent Owner's Sur-Reply shall not exceed six (6) pages of argument;

FURTHER ORDERED that Patent Owner's Sur-Reply shall not be filed any later than November 27, 2017; and

FURTHER ORDERED that Patent Owner's Sur-Reply shall not introduce any new evidence into the record of this proceeding.

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