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Paper 13
Entered: January 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAVETAMER GYROS, LLC,
Petitioner,

v.

SEAKEEPER, INC.,
Patent Owner.

Cases IPR2017-01931 and IPR2017-01996[1]
Patents 8,117,930 B2 and 7,546,782 B2

Before LORA M. GREEN, MICHAEL W. KIM, and PATRICK R. SCANLON, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

ORDER
Dismissing the Petition
37 C.F.R. § 42.71(a)

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[1] This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading when filing a single paper in the listed proceedings, provided that such heading includes a footnote attesting that "numbering aside, the word-for-word identical paper is filed in each proceeding identified in the heading."

Petitioner filed Motions to Dismiss the Petitions[2] in these proceedings on December 18, 2017 (Paper 9 in IPR2017-01931, Paper 8 in IPR2017-01996[3]), as authorized by the Board in a paper dated December 11, 2017 (Paper 8; "Order"). The Motions to Dismiss also seek authorization to file corrected petitions in new proceedings. As also authorized by the Board in its Order, Patent Owner filed Oppositions to Petitioner's Motions to Dismiss on December 26, 2017. Paper 12.

In its Motions to Dismiss, Petitioner describes how the Adams Patent, Patent No. US 6,973,847 (Ex. 1006), rather than the Adams Publication, Pub. No. US 2004/0244513 (Ex. 1043, filed with Petitioner's Motions to Dismiss), was relied upon in challenging the claims of U.S. Patent No. 8,117,930 ("the '930 patent") and U.S. Patent No. 7,546,782 ("the '782 patent). Paper 9, 1; *see id.* at 2–3. The Adams Patent was relied upon by Petitioner in all of its challenges of the '930 patent, and serves as the basis "for the strongest grounds" challenging the '782 patent. *Id.* at 1–2. According to Petitioner, although the Adams Publication is prior art to the patent challenged in these proceedings under 35 U.S.C. § 102, the Adams Patent is not prior art to the challenged patents. *Id.* at 1.

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[2] We note that Petitioner and Patent Owner filed the first page of our order of December 11, 2017 (Paper 8) as the first page of the Motion to Dismiss (Paper 9) and the Opposition of the Motion to Dismiss (Paper 12), as well as the Declarations filed by Petitioner accompanying its Motion to Dismiss (Papers 10 and 11). The parties should not use the first page of our order as the first page of their orders and declarations, as it makes it unclear who is the author of the paper, as the front page of our order indicates both the panel and the author of the order. The parties should consult with Trials@uspto.gov if they have additional questions as to the proper formatting of their cover pages. In addition, the Declarations accompanying Petitioner's Motions to Dismiss should have been filed as petitioner exhibits, and not papers.

[3] We will refer only to the papers and exhibits in IPR2017-01931 hereinafter.

Patent Owner responds that "[i]t would be unjust to allow [Petitioner] to escape the consequences of its flawed petitions, especially when those flaws have been identified to the Board by [Patent Owner's] legal work." Paper 12, 1. In addition, Patent Owner contends that "[w]hether [Petitioner's] follow-on petitions should be allowed to proceed in light of *General Plastic* and 35 U.S.C. § 325(d) is a question that should be addressed by the Board if and when [Petitioner] files such follow-on petitions." *Id.* at 8.

37 C.F.R. § 42.71(a) states that "[t]he Board may take up petitions . . . in any order, [and] may . . . dismiss any petition." Under these circumstances, we grant the requests of Petitioner to dismiss the Petitions and terminate these proceedings. Terminating the proceeding at this stage increases the efficiency of the Board and the parties, as Patent Owner need not file a Preliminary Response in IPR2017-01996, and we need not address challenges that are based on a reference that Petitioner admits is not prior art to the challenged patents in a decision on institution.

We note further that both Petitioner and Patent addressed the factors set forth in *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, (PTAB September 6, 2017) (Paper 19) (precedential), which sets forth a non-exhaustive list of factors ("*General Plastics* factors") the Board takes into consideration in evaluating follow-on petitions. *See* Paper 9, 8–10; Paper 12, 9-10. We agree with Patent Owner (Paper 12, 8) that it would be premature, however, to address those factors in these proceedings, and at this time. As we stated in our Order authorizing the briefing as to why dismissal is appropriate, "Petitioner should consider addressing those factors when it refiles its petitions." Order 3. Thus, although Petitioner is certainly free to refile new petitions and proceedings challenging the '930 and '782 patents, the appropriate place for both Petitioner and

Patent Owner to address those *General Plastics* factors, as to why or why not the follow-on Petitions are appropriate in these circumstances, is in those new proceedings themselves.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Petitioner's requests to terminate these proceedings is *granted*; and

FURTHER ORDERED that the Petitions in these proceedings are *dismissed*.

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