

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 IPR2017-01996¹
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
Conduct of the Proceedings
37 C.F.R. § 42.5

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 “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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A conference call was held on Wednesday, December 6, 2017, between counsel for Patent Owner, Edward Kelly; counsel for Petitioner, David Bennett; and Administrative Patent Judges Green, Kim, and Scanlon. Petitioner requested the call to request authorization to file a corrected Petition, or in the alternative, to terminate the proceeding and refile the Petitions.

Specifically, Petitioner stated that it mistakenly relied on the Adams patent, U.S. Patent No. 6,973,847, rather than the Adams publication, only the latter of which is prior art to the challenged claims under 35 U.S.C. § 102(b). Petitioner asserted the reliance on the Adams patent rather than the Adams publication was an inadvertent mistake. Petitioner acknowledged that it did not file the Adams publication as an exhibit with either Petition, but noted that Patent Owner would be aware of the reference, as it is Patent Owner's own work.

Petitioner suggested, therefore, that it could file a corrected Petition, citing 37 C.F.R. § 42.104(c), which allows for correction of clerical or typographical errors. Patent Owner responded that Petitioner's reliance on the Adams patent, rather than the Adams publication, cannot be characterized as a clerical error, but is rather an error of law. Thus, Patent Owner argued that Petitioner should not be allowed to file a corrected Petition.

We agree with Patent Owner that citing the incorrect reference in a Petition is not an error that is correctable under 37 C.F.R. § 42.104(c). We, thus, decline to authorize Petitioner to file a corrected petition in the two proceedings.

Petitioner suggested also that we allow it to terminate the instant proceedings, asserting that we have authorization under 37 C.F.R. § 42.71(a) to dismiss the Petitions. It could then refile corrected petitions. Patent Owner responded that 37 C.F.R. § 42.71(a) should not apply, and that Petitioner should be required to request adverse judgment under 37 C.F.R. § 42.73(b)(4).

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We agree with Petitioner that we have the authority to dismiss the Petitions under 37 C.F.R. § 42.71(a). We, therefore, authorize Petitioner to file a ten (10) page motion to dismiss in each proceeding, explaining how the error of citing to the Adams patent, rather than the Adams publication, arose and as to why dismissal is appropriate. The motions to dismiss are due within five (5) business days of the mailing date of this order. Patent Owner is then authorized to file ten (10) page opposition to the motion to dismiss in each proceeding, which is due within five (5) business days of Petitioner's filing of their motion to dismiss. We do not authorize Petitioner to file a reply to Patent Owner's opposition at this time. We point the parties attention to *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 the Board takes into consideration in evaluating follow-on petitions. Petitioner should consider addressing those factors when it refiles its petitions.

In addition, Patent Owner stated that the Petitions did not comply with the word count of 37 C.F.R. § 42.24(a). In particular, Patent Owner noted that Petitioner filed claim charts as exhibits, and did not include those claim charts in the word count. Petitioner responded that it referred to the claim charts in the Petition, but asked for guidance as to whether they should be considered part of the Petition, and, thus, included in the word count.

Generally, claim charts should be included as part of the petition, and should be included in the word count. *See* Office Patent Trial Practice Guide, 77 C.F.R 48756, 48764 (Aug. 14, 2012) ("Claim charts submitted as part of a petition, motion, patent owner preliminary response, patent owner response, opposition, or reply count towards applicable page limits."). Thus, to the extent that Petitioner is relying on the claim charts as part of its challenge, and the claim charts are

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required to support that challenge, the claim charts should be considered as part of the Petitions, and included in the word count for each Petition. To the extent that the claim charts are not included in the word count, we cannot rely on that information as part of the challenge to the claims.

In addition, Patent Owner filed its Preliminary Response in IPR2017-01931 on November 17, 2017. In IPR2017-01996, and in view of Petitioner's request for this conference call, Patent Owner requested an extension of time to file its preliminary response in that proceeding. IPR2017-01996, Paper 6. In an email dated December 5, 2017, we granted Patent Owner a one week extension for filing its preliminary response. In view of Petitioner's request to file a motion to dismiss these proceeding, we exercise our discretion, and move the due date for Patent Owner's preliminary response in IPR2017-01996 to January 8, 2018.

Accordingly, it is:

ORDERED that Petitioner is authorized to file a ten (10) page motion to dismiss in each proceeding, explaining how the error in citing to the Adams patent rather than the Adams publication occurred and as to why dismissal is appropriate. The motions to dismiss are due within five (5) business days of the mailing date of this order;

FURTHER ORDERED that Patent Owner is authorized to file a ten (10) page opposition to the motion to dismiss in each proceeding, which oppositions are due within five (5) business days of Petitioner's filing of their motion to dismiss; and

FURTHER ORDERED that the due date for Patent Owner's preliminary response in IPR2017-01996 is moved to January 8, 2018.

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Petitioner:

David E. Bennett
Brandee N. Woolard
COATS & BENNETT, PLLC
dbennett@coatsandbennett.com
bwoolard@coatsandbennett.com

Patent Owner:

Edward J. Kelly
ROPES & GRAY
Edward.kelly@ropesgray.com