

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION,
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Cases IPR2018-00082 (Patent 6,088,802)
IPR2018-00084 (Patent 6,003,135)¹

Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

¹ This Order applies to each referenced case. The parties are not authorized to use this heading style.

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IPR2018-00084 (Patent 6,003,135)

I. INTRODUCTION

In an e-mail message sent February 2, 2018, Petitioner requested a conference call with the Board to request authorization to file a reply to Petitioner's Preliminary Response in each of the above identified cases. On February 8, 2018, a conference call was conducted involving counsel for Petitioner, counsel for Patent Owner, and Judges Fishman and Pettigrew. Petitioner engaged the services of a court reporter and committed to filing a copy of the transcript of the conference call by February 15, 2018.

Following the conference call, the panel determined this Order should precede filing of the transcript to assure the parties have clear directions for the below-authorized filings.

II. *GENERAL PLASTIC*

Patent Owner's Preliminary Responses (IPR2018-00082, Paper 6; IPR2018-00084, Paper 6; both filed January 26, 2018) argue, *inter alia*, this panel should exercise our discretion under 35 U.S.C. § 314(a) to deny the Petitions in the above-identified cases. Patent Owner's arguments discuss the non-exclusive factors enumerated in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha* (Case IPR2016-01357, Paper 19). In the conference call, Petitioner noted that these Petitions were filed October 16, 2017, before the relevant portion of *General Plastic* was designated as a Precedential decision of the Board effective October 18, 2017. Petitioner requests authorization to file a Reply brief (in each above-identified case) responsive to the arguments presented in Patent Owner's Preliminary Responses regarding *General Plastic*. Patent Owner indicated it did not object to such a Reply by Petitioner.

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Upon consideration of the arguments discussed during the conference call, we are persuaded that Petitioner has shown good cause to authorize its request to file a Reply in each case to address whether we should exercise our discretion to deny the Petitions under 35 U.S.C. § 314(a). *See* 37 C.F.R. § 42.108 (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”). In particular, we note that the Petition in each case was filed (October 16, 2017) prior to the Precedential designation on October 18, 2018 of a portion of *General Plastic* addressing a non-exhaustive list of factors (the “*General Plastic* factors”) to be considered by the Board when evaluating whether to exercise discretion under § 314(a).

Accordingly, Petitioner is authorized to file a Reply to Patent Owner’s Preliminary Response in each of the above-identified cases addressing the *General Plastic* factors. Petitioner’s Reply regarding the *General Plastic* factors shall not exceed five (5) pages and shall be filed no later than February 20, 2018. Patent Owner is authorized to file a Sur-Reply to Petitioner’s Reply in each case. Patent Owner’s Sur-Reply regarding the *General Plastic* factors shall not exceed three (3) pages and shall be filed no later than February 26, 2018.

III. 37 C.F.R. § 42.104(b)(3) COMPLIANCE

In Patent Owner’s Preliminary Responses, Patent Owner argues, *inter alia*, that the Petitions should be denied because the Petitions fail to comply with 37 C.F.R. § 42.104(b)(3) (“[w]here the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific

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portions of the specification that describe the structure, material, or acts corresponding to each claimed function”). Patent Owner’s Preliminary Responses argue “[a]s a threshold matter, all Grounds should be denied institution because Petitioner has failed to meet its burden under 37 C.F.R. § 42.104(b)(3) to propose claim constructions that it believes are correct under applicable law.” IPR2018-00082 Paper 6, 2–3; IPR2018-00084 Paper 6, 10. Patent Owner quotes from two decisions by other panels of the Board in support of its assertion that the Petition must indicate its agreement with such claim constructions and not merely identify claim constructions of a District Court or the Patent Owner. In the conference call, Petitioner argues Patent Owner incorrectly interprets our rule 42.104(b)(3) as requiring Petitioner to indicate its agreement with an identified claim construction and further notes that the quoted panel decisions are not precedential decisions of the Board binding on this panel. Instead, Petitioner argues in the conference call that our rule merely requires the Petition to identify the claim construction it proposes to be used for that Petition and does not require Petitioner to agree with that claim construction.

Upon consideration of the arguments discussed during the conference call, we are persuaded that Petitioner has shown good cause to authorize its request to file a Reply in each proceeding to address whether each Petition has complied with 37 C.F.R. § 42.104(b)(3). In particular, Petitioner’s Reply should explain why Petitioner believes prior panel decisions interpreting 37 C.F.R. § 42.104(b)(3) are in error.

Accordingly, Petitioner is authorized to include three (3) additional pages in its Reply to Patent Owner’s Preliminary Response in each of the above-identified cases addressing proper interpretation of our rule 37 C.F.R.

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§ 42.104(b)(3). Patent Owner is authorized to include three (3) additional pages in its Sur-Reply in each case responding to Petitioner's arguments directed to proper interpretation of our rule 37 C.F.R. § 42.104(b)(3).

IV. ORDERS

In consideration of the foregoing, it is hereby:

ORDERED Petitioner is authorized to file a Reply to Patent Owner's Preliminary Response in Cases IPR2018-00082 and in IPR2018-00084;

FURTHER ORDERED Petitioner's Reply in each case is limited to five (5) pages directed to the *General Plastics* factors plus three (3) pages directed to interpretation of our rule 37 C.F.R. § 42.104(b)(3);

FURTHER ORDERED Petitioner's Reply in each case shall be filed no later than February 20, 2018;

FURTHER ORDERED Patent Owner is authorized to file a Sur-Reply to Petitioner's Reply in Cases IPR2018-00082 and in IPR2018-00084;

FURTHER ORDERED Patent Owner's Sur-Reply in each case is limited to three (3) pages directed to the *General Plastics* factors plus three (3) pages directed to interpretation of our rule 37 C.F.R. § 42.104(b)(3); and

FURTHER ORDERED Patent Owner's Sur-Reply in each case shall be filed no later than February 26, 2018.

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