

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORP.,
Patent Owner.

Case IPR2018-00437
Patent 9,537,071 B2

Before SALLY C. MEDLEY, WILLIAM V. SAINDON, and NATHAN A.
ENGELS, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Request to File Certain Documents
Denying Petitioner's Request for Additional Pages in a Response
37 C.F.R. § 42.5

On November 7, 2018, a conference call was held to discuss two issues raised by the parties. A court reporter was present on the call and Petitioner was instructed to file the transcript as an exhibit.

1.

First was Patent Owner's request for guidance regarding submission of Information Disclosure Statements (IDS) filed in various patent applications, as well as Petitioner's invalidity contentions from the co-pending district court litigation. Patent Owner stated its desire to file that information as part of its effort to comply with its duty of candor under 37 C.F.R. § 42.11(a) in view of its Contingent Motion to Amend. During the call, Patent Owner represented that the various references cited in the IDSs and the contentions were not material to the patentability of the proposed substitute claims. Patent Owner provided a copy of these documents to Petitioner.

The facts relating to Patent Owner's request here are similar to those found in *MLB Advanced Media, L.P., v. Front Row Techs., LLC*, IPR2017-01127, Paper 24 (PTAB Jan. 16, 2018) (non-precedential). There, the patent owner was also concerned about its duty of candor under Rule 42.11(a) and analogized its request to submit an extensive list of exhibits as analogous to submitting an IDS during prosecution. *MLB*, Paper 24, 6. As the panel in *MLB* found, and with which we agree:

During examination, . . . 37 C.F.R. § 1.56(a) only imposes "a duty to disclose to the Office all information known to [an individual associated with the filing and prosecution of a patent application] to be material to patentability There is no duty to submit information which is not material to the patentability of any existing claim."

Id. Because Patent Owner here represents that the various items are not material to patentability, we hold that there is no reason to enter them into the record at this time. Accordingly, to the extent Patent Owner's request for guidance is a request to file the IDSs and invalidity contentions, that request is denied.

2.

The second issue raised during the call was Petitioner's request for 25 additional pages or, in the alternative, a total of 10,000 words, for its opposition to Patent Owner's Contingent Motion to Amend. Petitioner argued that the additional pages were necessary due to the number of proposed amendments and potential challenges to those amendments under 35 U.S.C. §§ 103 and 112. Petitioner represented that it had begun drafting its opposition and that it did not see how it would be able to comply with the default 25 page limit. Petitioner also directed our attention to *Westinghouse Air Brake Tech. Corp. v. Siemens Industry, Inc.*, IPR2017-00580, Paper 25 (PTAB Jan. 18, 2018), which it believed represented a similar situation and where the Board granted a 10,000 word response.

In *Westinghouse*, the Board granted a petitioner 10,000 words to oppose to a contingent motion to amend. *Westinghouse*, Paper 24, 3. The Board noted that the patent owner in that proceeding submitted two sets of substitute claims, that 35 U.S.C. § 101 was at issue, and that there was additional prior art in related petitions. *Id.* at 2. The Board also took into consideration the fact that *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), had recently issued.

In the present case, however, we do not have two alternative sets of substitute claims, and Petitioner did not raise the issue of § 101. Further,

since *Westinghouse*, we are not aware of any other Board panel granting a contested request for additional pages for an opposition to a contingent motion to amend. Indeed, our informative decision *Western Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 13, 9 (PTAB Apr. 25, 2018) later reaffirmed the default 25 page limit of Rule 42.24(b)(3).

Although we will waive the rule when sufficient need is shown, waiver should not swallow the rule. Here, we are not persuaded that there is anything sufficiently unusual with Patent Owner's Motion to Amend to justify such a significant increase in pages. Patent Owner proposes to amend eight claims; three of which (claims 29, 32, and 34) are essentially changing the claim's dependency; and one of which merely changes a single word (claim 33). The remainder share many of the same amendments, and we are not apprised of any particularly unusual issue presented by the proposed amendments. Likewise, we do not view Petitioner's argument that it bears the burden on the motion persuasive; prior to *Aqua Products*, patent owners faced the same 25-page default limit to meet their burden. Our *Western Digital* decision reaffirmed the default page limit after *Aqua Products*. Accordingly, Petitioner's present request for 10,000 total words or 25 additional pages is denied.

It is so ORDERED.

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