

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXOCAD GMBH AND EXOCAD AMERICA, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

Case IPR2018-00788
Patent 9,336,336 B2

Before IRVIN E. BRANCH, and FRANCES L. IPPOLITO, *Administrative Patent Judges.*

BRANCH, *Administrative Patent Judge.*

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

On November 2, 2018, the Board received an email message from Petitioner's counsel requesting a conference call and an authorization to file a motion to submit supplemental information in this proceeding. A telephone conference to discuss Petitioner's request was held on November 6, 2018, among counsel for Petitioner, counsel for Patent Owner, and Judges Branch and Ippolito. A court reporter was present and a transcript of the call has been entered as Exhibit 1021.

On the call, Petitioner asserted that the November 2, 2018 emailed request satisfies the requirements of 37 C.F.R. § 42.123(a) because (1) it was made within one month of the date trial was instituted (October 3, 2018), and (2) the supplemental information is relevant to a claim for which trial was instituted because it relates to a reference involved in the proceeding. Petitioner described the proposed supplemental information as approximately three pages plus attachments such as a declaration.

Patent Owner opposed the authorization for the motion on various grounds. Among these, Patent Owner argued that the request is late because the November 6, 2018 conference call requesting authorization to file the motion is being held more than one month after the institution decision. Patent Owner also indicated that if Petitioner's motion is authorized, Patent Owner requests authorization to file an opposition to the motion.

After consideration of the parties' arguments, we granted Petitioner's request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) and authorized Patent Owner to file an opposition to Petitioner's motion. Petitioner's motion and Patent Owner's opposition shall be limited to five (5) pages. Petitioner's motion shall be filed no later than November 16, 2018, and Patent Owner's opposition shall

be filed no later than November 30, 2018. We also authorized Petitioner to submit with its motion the proposed supplemental information. Such exhibits will not be considered part of the record unless later entered as evidence by explicit order of the Board and will be expunged otherwise.

ORDER

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a motion to submit supplemental information is *granted*;

FURTHER ORDERED that Petitioner shall file its motion, limited to five (5) pages, no later than November 16, 2018;

FURTHER ORDERED that Patent Owner shall file its opposition, limited to five (5) pages, no later than November 30, 2018;

FURTHER ORDERED that any proposed supplemental information submitted as exhibits is provided merely for consideration of the motion for supplemental information, will not be entered as evidence of record, and shall not be cited in any paper, other than papers filed in accordance with this Order, unless later entered by explicit order of the Board; and

FURTHER ORDERED that no reply by Petitioner is authorized at this time.

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Patent 9,336,336 B2

PETITIONER:

Matthew B. Lowrie
Christopher J. McKenna
FOLEY & LARDNER LLP
mlowrie@foley.com
cmckenna@foley.com

PATENT OWNER:

Todd R. Walters, Esq.
Roger H. Lee, Esq.
BUCHANAN INGERSOLL & ROONEY PC
todd.walters@bipc.com
roger.lee@bipc.com