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IPR2014-01555 Paper 36
IPR2014-01557 Paper 28
IPR2014-01558 Paper 44
Entered: 9 October 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

EMERACHEM HOLDINGS, LLC,
Patent Owner.

Case IPR2014-01555 (Patent 5,451,558)
Case IPR2014-01557 (Patent 7,951,346 B2)
Case IPR2014-01558 (Patent 5,599,758)

Before FRED E. McKELVEY, *Administrative Patent Judge*.

ORDER AUTHORIZING MOTIONS

I. Background

The Board has received from Michael J. Bradford (counsel for Patent Owner) an email dated 8 October 2015 (12:16 p.m.), the relevant portion of which reads (bold in original):

As explained in more detail below, for Case Nos. IPR2014-01558, 2014-01555, and 2014-01557, Patent Owner hereby seeks leave from the Board to file motions to exclude new evidence and argument raising new issues submitted by Petitioner with its Reply in violation of 37 C.F.R. §42.23(b) and §42.123(b) and/or requests a telephone conference with the

Board so that Patent Owner may seek guidance regarding how to proceed with its request to exclude Petitioner's Reply and new supporting evidence.

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Petitioner Reply (Paper Nos. 39, 40) at p. 14, ln. 5 – p. 15, ln. 5 & p. 16, lns. 1-3 - In the Petition, Petitioner asserted that the system shown in Saito's (Exhibit 1008B) Figure 1 and described on page 1 of Saito included an exhaust gas that met the requirements of claim 3 concerning a regenerating gas comprising carbon dioxide. *See* Petition (Paper 1), p. 39, lns. 15-17. On pages 14-15 of the Reply, Petitioner now admits that Saito's system does not disclose a regenerating gas that comprises up to 10% carbon dioxide. However, for the first time in the Reply, Petitioner now alleges that a prior art method mentioned in Saito discloses such a regenerating gas. Similarly, in the Petition, Petitioner asserted that the system shown in Saito's Figure 1 and described on page 1 of Saito included an exhaust gas that met the requirements of claims 16 and 20 concerning an inert carrier gas comprising steam. *See* Petition (Paper 1), p. 39, lns. 15-17. On pages 14-15 and 16 of the Reply, Petitioner now admits that Saito's system does not disclose an inert carrier gas that comprises steam. However, for the first time in the Reply, Petitioner now alleges that a prior art method mentioned in Saito discloses such a regenerating gas. These new issues raised for the first time in the Reply are in violation of 37 C.F.R. §42.23(b). "[A] reply that raises new issues or belatedly presents evidence will not be considered and may be returned." *Office Patent Trial Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Patent Owner has improperly and unfairly been deprived of the ability to present a response to arguments concerning these new issues. Accordingly, Patent Owner wishes to file a motion to exclude these new issues and arguments raised in the Reply.

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Exhibit 1055, Exhibit 1015 ¶¶13-20 & Ex. A-E thereto and Petitioner’s Reply (Paper No. 32) at p. 15-16 - In the Petition, Petitioner asserted that Hoekstra (Exhibit 1005A) anticipated claims in the ‘558 patent. However, both parties’ experts subsequently agreed that the catalyst described in the only example disclosed in Hoekstra does not anticipate the ‘558 patent claims. For the first time in the Reply, Petitioner now asserts that Hoekstra’s example includes a “typographical error” in a reported weight and Petitioner has improperly attempted to introduce foreign counterparts to Hoekstra with the Reply that allegedly include the correct weight in the example as well as a new declaration from Petitioner’s expert discussing these foreign counterparts. *See* Exhibit 1055, Exhibit 1015 ¶¶13-20 & Ex. A-E thereto and Petitioner’s Reply (Paper No. 32) at p. 15-16. These new issues raised in the Reply are in violation of 37 C.F.R. §42.23(b). “[A] reply that raises new issues or belatedly presents evidence will not be considered and may be returned.” *Office Patent Trial Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Patent Owner has improperly and unfairly been deprived of the ability to present a response to arguments concerning these new issues. Furthermore, Petitioner has neither requested authorization to file a motion to submit supplemental information nor shown that this supplemental information could not have been obtained earlier, as required by 37 C.F.R. §42.123(b). The foreign counterparts were readily available to Petitioner at the time it filed the Petition. As such, Petitioner could not meet the requirements of 37 C.F.R. §42.123. Accordingly, Patent Owner wishes to file a motion to exclude this new evidence and the new issues and arguments raised in the Reply.

Exhibit 1016 and Petitioner’s Reply (Paper No. 32) at p. 23-24 - In support of the Reply, Petitioner submits a new dictionary definition (Exhibit 1016) as evidence. This new evidence filed with the Reply is in violation of 37 C.F.R.

§42.23(b). “[A] reply that raises new issues or belatedly presents evidence will not be considered and may be returned.” *Office Patent Trial Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Patent Owner has improperly and unfairly been deprived of the ability to present a response to arguments concerning this new evidence. Also, Petitioner has neither requested authorization to file a motion to submit supplemental information nor shown that this supplemental information could not have been obtained earlier, as required by 37 C.F.R. §42.123(b). The dictionary definition was readily available to Petitioner at the time it filed the Petition. As such, Petitioner could not meet the requirements of 37 C.F.R. §42.123. Accordingly, Patent Owner wishes to file a motion to exclude this new evidence and the new arguments raised in the Reply concerning this evidence.

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Exhibit 1019, Ex. A – In support of the Reply, Petitioner submits evidence as Exhibit A to a declaration from Petitioner’s expert (Exhibit 1019) concerning the alleged meaning of “particulate matter” to a person of ordinary skill. This new evidence filed with the Reply is in violation of 37 C.F.R. §42.23(b). “[A] reply that raises new issues or belatedly presents evidence will not be considered and may be returned.” *Office Patent Trial Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). Patent Owner has improperly and unfairly been deprived of the ability to present a response to arguments concerning this new evidence. Also, Petitioner has neither requested authorization to file a motion to submit supplemental information nor shown that this supplemental information could not have been obtained earlier, as required by 37 C.F.R. §42.123(b). The new evidence was readily available to Petitioner at the time it filed the Petition. As such, Petitioner could not meet the requirements of 37 C.F.R. §42.123. Accordingly, Patent Owner wishes to file a motion to exclude this new evidence and the new arguments raised in the Reply concerning this evidence.

The Board also has received from Steven F. Meyer (counsel for Patent Petitioner) an email dated 8 October 2015 (1:59 p.m.), the relevant portion of which reads:

It is Petitioner's understanding that it is improper to present extensive legal arguments in an email to the PTAB. Nevertheless, Petitioner finds it necessary to respond that in each instance identified below by Patent Owner, the evidence and/or argument is not new, but rather appears in the Petition and/or is responsive to an argument made by Patent Owner in its Response.

II. Discussion and Order

New issues raised in a reply have been, and continue to be, a problem in IPR cases. Belated presentation of reply evidence can be prejudicial to a patent owner. On the other hand, patent owners have too often cried foul when evidence is properly relied upon in a reply. In a reply, a petitioner legitimately may respond to arguments made in an opposition. To do so, often it is necessary to rely on (1) evidence already cited in a petition or (2) new evidence. A motion to supplement is not necessary if evidence relied upon in a reply is limited to responding to arguments made in an opposition. Furthermore in a petition, a petitioner does not have to anticipate all possible arguments which a patent owner made present in an opposition on the merits.

Upon consideration of the emails, on or before **16 October 2015**, Patent Owner is authorized to file a Motion to Exclude.

The motion is limited to **5 pages**.

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The motion shall not include argument as to the merits of patentability and shall not serve in any way as supplementing arguments made in Patent Owner's opposition on the merits.

The motion shall be limited to (1) identifying the exhibit sought to be excluded and (2) a very brief discussion as to why it is being improperly relied upon by Petitioner in its Reply:

“The exhibit sought to be excluded is Ex. ____.

The exhibit should be excluded because [explain why].”

Petitioner is authorized to file an Opposition to any Motion to Exclude.

Any opposition is limited to **5 pages**.

Any opposition is due on or before **23 October 2015**.

Any Opposition shall *not* include arguments related to the merits of patentability or serve to supplement any argument made by Petitioner in the Petition or Petitioner's reply on the merits.

Any Opposition shall be limited to (1) identifying the exhibit sought to be excluded and (2) a very brief discussion as to why it is properly relied upon by Petitioner in its Reply:

“Patent Owner seeks to exclude Exhibit ____.

The exhibit is properly relied upon in the Reply because [explain why].”

A reply is not authorized.

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