

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED (MCO),
Petitioner,

v.

WILLIS ELECTRIC COMPANY, LIMITED,
Patent Owner.

Case: IPR2016-01610 (Patent 8,454,186 B2)

Case: IPR2016-01612 (Patent 8,454,187 B2)

Case: IPR2016-01613 (Patent 9,044,056 B2)

Cases: IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)¹

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

On October 12, 2017, a conference call was held with Judges Saindon,

¹ This Order addresses the same issues in the *inter partes* reviews listed in the Appendix. Therefore, we issue one Order to be filed in all of the cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

Plenzler, and Parvis and counsel for the parties in attendance. The call was held to give the parties an opportunity to discuss the impact of the Federal Circuit’s en banc decision in *Aqua Prods., Inc. v. Matal*, No. 2015-1177 (Fed. Cir. Oct. 4, 2017) (“*Aqua Products*”) with respect to pending Motions to Amend. As background, Willis Electric Company, Limited (“Patent Owner”) filed Motions to Amend in each of the proceedings listed in the Appendix. *See, e.g.*, IPR2016-01610, Paper 57. Polygroup Limited (“Petitioner”) filed an Opposition to each of Patent Owner’s Motions to Amend (*see e.g.*, IPR2016-01610, Paper 101) and Patent Owner filed a Reply to each of Petitioner’s Oppositions to the Motion to Amend (*see, e.g.*, IPR2016-01610, Paper 113). The Scheduling Order set the date for Oral Argument for November 15, 2017. *See e.g.*, IPR2016-01610, Paper 39. Both parties have requested a hearing. *See e.g.*, IPR2016-01610, Papers 126, 129.

During the October 12, 2017 conference call, the parties were asked whether additional briefing is warranted as a result of the Federal Circuit’s decision in *Aqua Products*. Petitioner, additionally, raised two other issues, which we address in a separate order.

The Parties’ Positions

Petitioner contends that additional briefing is required as follows:

Submission	Pages	Time
Petitioner’s Initial Brief (Opposition)	25 pages per matter	4 weeks
Patent Owner’s Reply	25 pages per matter	4 weeks
Petitioner’s Sur-Reply	15 pages per matter	3 or 4 weeks

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

Petitioner, additionally, proposes that the hearing date be re-set to mid-January or early February 2018. Petitioner further requests that the Chief Administrative Patent Judge extend the one-year period for the final determinations (*see* 37 C.F.R. § 42.100(c)) in each of the instant *inter partes* reviews.

Patent Owner also contends additional briefing is warranted on motion to amend issues. Patent Owner provides two alternative proposals. Patent Owner's first proposal is set forth below ("Option 1").

Submission	Pages	Time
Patent Owner provides Substitute Claims	No suggestion provided	2 or 3 weeks
Petitioner's Initial Brief (Opposition)	25 pages per matter	2 or 3 weeks
Patent Owner's Reply	25 pages per matter	2 or 3 weeks
Petitioner's Sur-Reply	15 pages per matter	2 weeks

Like Petitioner's proposal, Patent Owner's Option 1 includes a request to re-set the hearing date, but Patent Owner requests an earlier hearing date. In particular, Patent Owner requests that the hearing be re-set to mid-December.

Patent Owner, alternatively, requests a wait and see approach ("Option 2") that would not involve any additional briefing or changes to the current schedule, at this time. Patent Owner, however, proposes additional briefing after the Final Written Decision, if Patent Owner does not prevail on the challenged claims. Additionally, Patent Owner requests that with Option 2, the Chief Administrative Patent Judge extend the one-year period for the

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

final determinations with respect to only the Motions to Amend (*see* 37 C.F.R. § 42.100(c)), in the event that Patent Owner elects to file Motions to Amend.

Discussion

At this stage in the proceeding, and because both parties request essentially the same briefing, we grant the parties' requests, as modified and set forth below. In addition to the agreed-to briefing, we grant Patent Owner's request to file revised substitute claims, and authorize Patent Owner to file a motion limited to 25 pages per matter to set forth its revised substitute claims, as well as its contentions needed to satisfy the statutory criteria in 35 U.S.C. §§ 316(d)(1)(a)–(b) and 316(d)(3), and 37 C.F.R. § 42.121. We further set an expedited schedule.

The additional briefing that we authorize in each of the instant *inter partes* reviews is set forth below.

Submission	Pages	DUE DATE
Patent Owner's Revised Substitute Claims	25 pages per matter	November 1, 2017
Petitioner's Initial Brief (Opposition)	25 pages per matter	November 15, 2017
Patent Owner's Reply	25 pages per matter	November 29, 2017
Petitioner's Sur-Reply	15 pages per matter	December 6, 2017

Because the parties will not have time to complete the additional briefing prior to the November 15, 2017 hearing date set forth in the Scheduling Order, we hereby modify "DUE DATE 7," i.e., the date set for oral argument in our Scheduling Order, to Friday December 15, 2017. The

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

parties' requests for oral argument will be addressed in a separate order.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED our Scheduling Orders (see, e.g., IPR2016-01610, Paper 39) are hereby modified in each of IPR2016-01610, -01612, -01613, -01615, -01616, and -01617, such that DUE DATE 7, i.e., the date set for oral argument is now December 15, 2017;

FURTHER ORDERED that the parties are authorized to file the additional briefs set forth below, such briefs are subject to the page limits and due dates also set forth below.

Submission	Pages	DUE DATE
Patent Owner's Revised Substitute Claims	25 pages per matter	November 1, 2017
Petitioner's Initial Brief (Opposition)	25 pages per matter	November 15, 2017
Patent Owner's Reply	25 pages per matter	November 29, 2017
Petitioner's Sur-Reply	15 pages per matter	December 6, 2017

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

PETITIONER:

Christopher Forstner
Ryan Schneider
Alexis Simpson
Robert Angle
Dabney J. Carr, IV
TROUTMAN SANDERS LLP
Chris.forstner@troutmansanders.com
Ryan.schneider@troutmansanders.com
Alexis.simpson@troutmansanders.com
Robert.angle@troutmansanders.com
Dabney.carr@troutmansanders.com

Jason Eisenberg
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
Jasone-ptab@skgf.com

PATENT OWNER:

Larina Alton
Luke Toft
FOX ROTHSCHILD LLP
lalton@foxrothschild.com
ltoft@foxrothschild.com

Doug Christensen
CHRISTENSEN FONDER DARDI
christensen@cfpatlaw.com

IPR2016-01610 (Patent 8,454,186 B2)
IPR2016-01612 (Patent 8,454,187 B2)
IPR2016-01613 (Patent 9,044,056 B2)
IPR2016-01615, -01616, and -01617 (Patent 8,936,379 B1)

APPENDIX

<i>Inter Partes</i> Review	U.S. Patent No.
IPR2016-01610	8,454,186 B2
IPR2016-01612	8,454,187 B2
IPR2016-01613	9,044,056 B2
IPR2016-01615 IPR2016-01616 IPR2016-01617	8,936,379 B1