

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUTOQUIP, INC.,
Petitioner

v.

GRACO MINNESOTA, INC.
Patent Owner

Case IPR2013-00452
Patent 6,554,204

Before BRIAN J. MCNAMARA, GEORGIANNA W. BRADEN, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

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

On June 26, 2014, we conducted a teleconference with counsel concerning Graco Minnesota Inc.'s ("Patent Owner's") filing of an unauthorized Reply (Paper 16) to Autoquip Inc.'s ("Petitioner's") Reply to the Patent Owner Response (Paper 15). Michael Griggs represented Petitioner and William Weimer represented Patent Owner. Judges McNamara, Braden and Parvis participated in the conference.

Our rules do not provide for the filing of a sur-reply by the Patent Owner to the Petitioner's Reply to the Patent Owner Response. Patent Owner did not seek our authorization to file such a document. Therefore, Paper 16 is unauthorized and will be expunged.

During the teleconference, we also discussed the following issues and confusing use of terminology that may have led to Patent Owner's unauthorized filing of Paper 16. The Patent Owner Response states that Patent Owner reserves the right to challenge certain documents that form the grounds on which we instituted trial, because Petitioner "failed to authenticate the documents as prior art." PO Resp. 3. Petitioner's Reply to the Patent Owner Response argues that Patent Owner failed to object to the documents within the ten business day time frame set forth in 37 C.F.R. § 42.64(b)(1). Reply 2. Without waiving its argument concerning Patent Owner's failure to object, Petitioner also submitted the declaration of Michael Elberson, Ex. 1008 ("Elberson declaration"), purportedly "authenticating the documents." *Id.* at 3. Patent Owner's unauthorized sur-reply, Paper 16, argued that Patent Owner was not required to object, that the burden to submit sufficient evidence is on the Petitioner, and that Petitioner's submission of the Elberson declaration was unauthorized because Petitioner did not file a motion

to submit supplemental evidence under 37 C.F.R. § 42.123 (a) and (b). Paper 16, 1-2.

Objections to the admissibility of evidence (e.g., objections based on relevance, hearsay, and authenticity) are made under 37 C.F.R. § 42.64 and must be asserted within the time frames specified in that rule. Thus, if Patent Owner were objecting to the authenticity of the documents, Patent Owner would be required to assert the objection within 10 business days of the institution of the trial or the objection would be waived. 37 C.F.R. § 42.64(b)(1). If Patent Owner had timely objected to admissibility of the evidence, Petitioner would have the right to serve Patent Owner with supplemental evidence in response to the objection, within ten business days. The supplemental evidence, which is different from supplemental information under 37 C.F.R. § 42.123, would not be filed with the Board. If Patent Owner believed that Petitioner had not overcome the objection, Patent Owner could file a Motion to Exclude in order to preserve the objection. 37 C.F.R. § 42.64(c).

In this case, Patent Owner did not serve an objection under 37 C.F.R. 42.64(b)(1). Notwithstanding the argument that Petitioner did not “authenticate the documents as prior art,” the Patent Owner Response states that “Patent Owner does not challenge the content of the documents, and, therefore, does not challenge the consideration of the content of the documents relative to the subject matter of claim 1 set forth in the Decision.” PO Resp. 3. During the teleconference, Patent Owner clarified that it was not objecting to the admissibility of the documents based on authenticity, but instead was challenging whether the documents, which have copyright notices, constitute prior art. Thus, the Patent Owner Response challenges the sufficiency of the evidence, rather than its admissibility, and

demands that Petitioner prove the documents asserted in its challenges to the patentability of the claims constitute prior art.

Petitioner replied with the Elberson declaration, Ex. 1008, which is not supplemental information under 37 C.F.R. §123, but is directly responsive to assertions made in the Patent Owner Response. Patent Owner may wish to cross examine Mr. Elberson concerning the assertions in his declaration and take appropriate further action in this proceeding. However, the filing of Paper 16 was not an appropriate response and was not authorized by the Board.

In consideration of the above, it is
ORDERED that Paper 16 be expunged.

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