

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SENSIO, INC.,  
Petitioner,

v.

SELECT BRANDS, INC.,  
Patent Owner.

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Case IPR2013-00580  
Patent D686,447

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Before JOSIAH C. COCKS, THOMAS L. GIANNETTI, and  
BENJAMIN D. M. WOOD, Administrative Patent Judges.

COCKS, *Administrative Patent Judge.*

ORDER

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

### *I. Introduction*

On August 7, 2014, a conference call was conducted in connection with IPR2013-00580, which involves Patent D686,447 (“the ’447 patent”). Petitioner, Sensio, Inc. (“Petitioner”), was represented by lead counsel, Kathleen Daley, and Elizabeth Ferrill. Patent Owner, Select Brands, Inc., (“Patent Owner”), was represented by lead counsel, Scott Brown, and Matthew Walters. Judges Cocks, Giannetti, and Wood participated on behalf of the Board. The call was requested by Patent Owner.

### *II. Discussion*

During the call, Patent Owner represented that there were three issues that it sought to discuss with the Board.

#### *1.*

Patent Owner requested that it be permitted to file a sur-reply to the Reply to Patent Owner’s Response that was filed by Petitioner on July 24, 2014 (Paper 17). Patent Owner, in its Response, has attempted to establish that the inventors of the ’447 patent reduced to practice the claimed invention prior to the effective dates of the prior art involved in the grounds of unpatentability on which trial has been instituted. According to Patent Owner, Petitioner, in its Reply, has raised improperly a challenge to the inventorship of the ’447 patent, specifically pertaining to matters of conception, that go beyond the issue of reduction to practice. Patent Owner requests that it be given leave to file a sur-reply so as to address those matters.

Petitioner responded that it did not raise any issue with respect to inventorship as a part of its reply briefing, and instead simply responded to arguments presented in Patent Owner’s Response concerning reduction to practice

of the invention of the '447 patent. To that end, Petitioner opposed Patent Owner's request to file a sur-reply.

As noted by Patent Owner on the call, it is Patent Owner who bears the burden of establishing a legally sufficient basis to show prior invention by the inventors of the '447 patent of the claimed invention prior to the relevant date. Given that Petitioner's Reply does appear to raise matters pertaining to conception of the inventor of the '447 patent, and because Patent Owner does bear the burden with respect to this particular issue, we think a sur-reply is appropriate and helpful in this case. Accordingly, we grant Patent Owner's request for leave to file a sur-reply. The sur-reply shall not exceed five (5) pages in length and is due by close of business (COB) on August 14, 2014. No response by Petitioner to the sur-reply is authorized.

2.

Patent Owner indicated that Petitioner has submitted declaration testimony of Mr. Lance Rake in connection with its reply briefings and that Patent Owner intends to cross-examine Mr. Rake. Patent Owner requested leave to file a motion for observations on cross-examine pertaining to that testimony. Petitioner does not oppose the request. The panel indicated that Patent Owner may file such observations. The observations are due by DUE DATE 4 (*see* Scheduling Order, Paper 7). Petitioner may file responses to the observations by DUE DATE 5. Both parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012), for guidance as to the length and content of the observations and responses.

3.

Patent Owner conveyed that it has conferred with Petitioner, but the parties have been unable to reach agreement as to the location and date for Mr. Rake's cross-examination. Patent Owner requested that the cross-examination take place next week at its law offices in Kansas, near where Mr. Rake also resides.

Petitioner responded that both it and Mr. Rake would prefer to have the cross-examination conducted at the offices of Petitioner's counsel in Washington, D.C. because, during the week of August 11, 2014, Mr. Rake is traveling on the East Coast and could be made available on August 12, 2014 in Washington, D.C.

The rules governing *inter partes* review proceedings generally provide that testimony may be taken at any reasonable time and location within the United States. *See* 37 C.F.R. § 42.53. In light of Patent Owner's request that the testimony be taken next week when Mr. Rake is traveling on the East Coast, and the presence of Petitioner's counsel in D.C., the panel expressed the view that D.C. is a reasonable location for the deposition. Patent Owner represented to the panel that it was now agreeable to conducting the cross-examination of Mr. Rake in Washington, D.C.

### *III. Order*

It is

ORDERED that Patent Owner is authorized to file a sur-reply to Petitioner's Reply to Patent Owner Response (Paper 17);

FURTHER ORDERED that the sur-reply shall not exceed five (5) pages in length and is due no later than COB on August 14, 2014;

FURTHER ORDERED that no response to the sur-reply is authorized;

FURTHER ORDERED that Patent Owner may file a motion for observations on cross-examination of Mr. Lance Rake. The observations are due by DUE DATE 4 (*See Paper 7*);

FURTHER ORDERED that Petitioner may file responses to the observations by DUE DATE 5; and

FURTHER ORDERED that, absent any other agreement among the parties, any cross-examination of Mr. Rake shall occur at the law offices of Petitioner's counsel in Washington, D.C. during the week of August 11, 2014.

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