

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SCHOTT GEMTRON CORPORATION,  
Petitioner,

v.

SSW HOLDING COMPANY, INC.,  
Patent Owner.

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Case IPR2014-00367  
Patent 8,286,561 B2

Before JUSTIN T. ARBES, PHILIP J. HOFFMANN, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on August 18, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Hoffmann, and Braden. The call was requested by Patent Owner to address an issue regarding the filing date accorded to the Petition in this proceeding, and to seek an extension of the trial schedule.

*Filing Date of the Petition*

Patent Owner argued that it recently discovered facts indicating that the Petition filed in this proceeding is time-barred under 35 U.S.C. § 315(b), and sought authorization to file a motion to dismiss. Specifically, Petitioner filed its Petition, along with Exhibits 1101–1109, in the Patent Review Processing System (PRPS) on January 18, 2014. Petitioner listed in its exhibit list that Exhibit 1109 was the “Declaration of Chris B. Schechter,” and referred to the exhibit throughout the Petition as a declaration from Mr. Schechter. *See, e.g.*, Paper 2 at v, 20, 23, 24, 36, 38, 44. The version of Exhibit 1109 filed on January 18, 2014, however, was not a declaration, but rather a copy of U.S. Patent Application Publication No. 2004/0202872 A1. Petitioner subsequently filed Mr. Schechter’s declaration, also numbered as Exhibit 1109, on January 21, 2014. The Petition was accorded a filing date of January 18, 2014. Paper 3.

During the call, Petitioner explained that it mistakenly filed the wrong document as Exhibit 1109 when it filed its Petition on Saturday, January 18, 2014. Petitioner stated that the Office was closed on Monday, January 20, 2014, but Petitioner contacted the Board by telephone on Tuesday, January 21, 2014, and was instructed to file the correct document. Also, Patent Owner acknowledged during the call that it was served with a copy of

Mr. Schechter's declaration on January 18, 2014, even though the correct document was not filed until January 21, 2014. *See* Paper 2 at 59 (certificate of service).

Patent Owner argued that (1) the filing date of January 18, 2014 accorded to the Petition is incorrect because Petitioner's filing did not include all "affidavits or declarations of supporting evidence and opinions" under 35 U.S.C. § 312(a)(3)(B); and (2) if the Petition is accorded a filing date of January 21, 2014, the Petition is untimely under 35 U.S.C. § 315(b) because Petitioner was served with a complaint alleging infringement of the challenged patent on January 18, 2013. Petitioner responded that (1) the January 18, 2014 date is correct because 35 U.S.C. § 312(a)(3)(B) requires only that a petition "identif[y]" declarations, not actually file them; and (2) even if January 21, 2014 is the correct filing date, the Petition is not time-barred under 37 C.F.R. § 1.7(a) because January 18–20, 2014 were a Saturday, Sunday, and federal holiday, respectively. Patent Owner stated that it had not had a chance to consider Petitioner's position on timing because it was raised for the first time during the call. We reminded the parties of the need to confer with each other before seeking intervention from the Board, and instructed the parties to discuss further and email the Board at *Trials@uspto.gov* by August 19, 2014, if any issues remain in dispute. In its email, Patent Owner indicated that it believes Petitioner was required to file a motion to correct the Petition, but Patent Owner no longer requests authorization to file a motion to dismiss.

Upon further consideration, we take the following actions to ensure the accuracy of the record. The Petition, as filed on January 18, 2014, did not include a copy of Mr. Schechter's supporting declaration and, therefore,

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was deficient under 35 U.S.C. § 312(a)(3)(B). The Petition will be accorded a filing date of January 21, 2014, the date the declaration was filed.

Petitioner is authorized to file a motion requesting that the Petition be accorded the earlier filing date of January 18, 2014. Petitioner should explain in the motion what actions it took in filing the Petition, and is encouraged to file corroborating evidence, such as a declaration from counsel who filed the Petition, in support. The parties are referred to *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00063, slip op. (PTAB Jan. 16, 2013) (Paper 21), and *Conmed Corp. v. Bonutti Skeletal Innovations LLC*, IPR2013-00624, slip op. (PTAB Feb. 21, 2014) (Paper 18), addressing motions to correct filed in similar circumstances. Once any motion to change the accorded filing date is decided, the parties may request a conference call if any issues remain regarding the timeliness of the Petition.

#### *Schedule*

Patent Owner requested that the due dates in the Scheduling Order (Paper 7) be extended so that the parties may take into account the final written decision in related Case IPR2013-00358 involving the same challenged patent. Petitioner opposed any extension of time. As explained during the call, we are persuaded that a one-week extension of DUE DATES 1 and 2 is appropriate under the circumstances.

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is accorded a filing date of January 21, 2014;

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FURTHER ORDERED that Petitioner is authorized to file, by August 28, 2014, a motion requesting that the Petition be accorded the earlier filing date of January 18, 2014, limited to five pages; Patent Owner is authorized to file an opposition by September 4, 2014, also limited to five pages; and no reply is authorized; and

FURTHER ORDERED that DUE DATES 1 and 2 in this proceeding are changed to September 5, 2014 and November 28, 2014, respectively, and no other due dates in the Scheduling Order (Paper 7) are changed at this time.

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