

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NESTE OIL OYJ,
Petitioner,

v.

REG SYNTHETIC FUELS, LLC,
Patent Owner.

Case IPR2013-00578
Patent No. 8,231,804

Before RAMA G. ELLURU and CHRISTOPHER L. CRUMBLEY,
Administrative Patent Judges.

CRUMBLEY, *Administrative Patent Judge.*

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

On September 23, 2014, pursuant to a request from Petitioner Neste Oil Oyj (“Neste”), a conference call was held among Michael Flibbert, representing Neste; Jeanne Gills, representing Patent Owner REG Synthetic Fuels, LLC (“REG”); and

Judges Elluru and Crumbley. Neste requested the call to discuss various exhibits filed with REG's September 9, 2014 reply brief.

During the call, Neste contended that some of the exhibits submitted by REG are beyond the scope of proper reply evidence. In particular, Neste argued that REG presented new evidence regarding the Dindi reference—and REG's attempt to antedate that reference—that should have been included as part of the prima facie case set forth in REG's prior briefing. Neste specifically identified the following exhibits: 1) Exhibits 2057 and 2058, relevant to prior conception; 2) Exhibits 2053 and 2061, relevant to suitability for intended use; and 3) Exhibits 2062-2064, relevant to diligence. Neste argued that all three issues are part of REG's prima facie case of prior invention, and should not have been established for the first time in a reply.

Neste also contended that submission of these exhibits at this time deprived it of the opportunity to present expert testimony on the evidence, and respond to the new evidence in a brief. In response, REG asserted that it had raised the prior invention arguments in its preceding briefs, and that the new exhibits were submitted to respond to specific arguments made by Neste in its opposition brief.

Upon considering both parties' arguments, we noted that the panel can determine for itself whether the objected-to reply evidence should have been submitted prior to REG's reply, and can disregard any improperly submitted evidence accordingly. Neste agreed that nothing particular about this case would prevent the panel from making this determination after oral hearing. We further explained that Neste may file a motion for observations after the cross-examination of REG's reply declarants, and that it can note during the oral hearing which

arguments and evidence it believes are new. In so doing, Neste can create a record and notify the panel of the alleged new issues and evidence.

For these reasons, we explained that we discern no reason to deviate from the Board's typical practice of waiting until after oral hearing to determine if any reply evidence was improperly submitted. We are not unsympathetic to Neste's argument that this practice requires the Board and parties to prepare for oral hearing by reviewing evidence that may ultimately be determined to have been improperly filed. Nevertheless, we consider it beneficial to evaluate REG's reply evidence—and determine what weight, if any, to give it—when reviewing the parties' papers and preparing the final written decision. We cautioned REG, however, that it relies on any newly submitted evidence at its own peril, as it risks basing its prior invention argument on evidence that, ultimately, may not be considered because it was improperly submitted.

In light of the foregoing, it is

ORDERED that Petitioner is not authorized at this time to file a motion to strike Patent Owner's reply exhibits.

Case IPR2013-00578
Patent No. 8,231,804

For Petitioner:

Michael J. Flibbert
Maureen D. Queler
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
michael.flibbert@finnegan.com
maureen.queler@finnegan.com

For Patent Owner:

Joseph P. Meara
Jeanne Gills
Michael R. Houston
FOLEY & LARDNER LLP
jmeara@foley.com
jmgills@foley.com
mhouston@foley.com