

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NATIONAL ENVIRONMENTAL PRODUCTS LTD
AND N.E.P., INC., D/B/A NEPTRONIC,
Petitioner,

v.

DRI-STEEM COPORATION,
Patent Owner.

Case IPR2014-01503
Patent 8,641,021

Before LINDA M. GAUDETTE, KRISTINA M. KALAN, and KERRY BEGLEY,
Administrative Patent Judges.

KALAN, *Administrative Patent Judge.*

ORDER
Conduct of Proceedings
37 C.F.R. § 42.5

Introduction

A conference call was held on October 31, 2014. The participants were respective counsel for the parties and Judges Gaudette and Kalan. Counsel for Patent Owner and Petitioner requested the call to discuss Petitioner's October 28, 2014 filing, entitled "Notice of Intent and Request to Submit Supplemental Information Under 37 C.F.R § 42.123 Through Filing a Revised *Inter Partes Review* Petition" (Paper 9).

The status of the proceeding is that on September 15, 2014, Petitioner filed a Petition (Paper 1), followed by a First Amended Petition (Paper 8) on October 14, 2014. The Petition was accorded a filing date of September 15, 2014. Paper 7, 1.

The Petitioner used the conference call to request authorization to file supplemental information as detailed in Paper 9. Specifically, Petitioner sought to supplement its Petition with a "recently discovered prior art patent," U.S. Patent No. 5,516,466 ("the '466 patent"), on which it intends to rely. Paper 9, 2-4. Patent Owner opposed Petitioner's request. We heard arguments from both parties. The request is *denied*.

Discussion

As an initial matter, the parties are instructed, generally, that the proper method for initiating communication with the Board in a situation such as the present is to request a conference call. That request may be made properly via an email to the Board; however, such an email may only request a call and provide a short explanation as to why the party requests the call. Petitioner's email dated October 30, 2014, containing substantive arguments concerning its request, is

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tantamount to filing an unauthorized motion. Accordingly, the Board is disregarding the email correspondence from both parties, apart from the portions of the emails requesting a conference call with the Board.

Because Petitioner's proposed submission is intended to supplement the Petition, and because Petitioner has stated that it intends to rely on the '466 patent, Petitioner in effect is asking for authorization to substantively amend its Petition. The Board's procedures for amendment of a Petition typically are limited to correction of a clerical or typographical mistake. 37 C.F.R. § 42.104(c). Nevertheless, the Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by the applicable rules. We are not persuaded, however, that Petitioner should be authorized to submit the proposed supplemental information in a revised Petition.

First, Paper 9 was filed without first obtaining Board authorization, which is required before a motion may be entered. 37 C.F.R. § 42.20(b). Petitioner did not cite to any order of general applicability authorizing its filing of Paper 9. Absent any order of general applicability or Board authorization, Paper 9 was improperly filed.

Second, the original petition should have included all of the asserted grounds of unpatentability. 37 C.F.R. § 42.104(b). The law requires that a petition must "identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3). Petitioner did not explain sufficiently during the call why the '466 patent was not included in its

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Petition, particularly in view of Patent Owner's assertions that the '466 patent was known to Petitioner over a year ago, is listed on the face of the patent at issue, and is relied upon in the companion litigation.

Third, Petitioner did not present a sufficient legal or factual basis to authorize the filing of a revised Petition. Petitioner does not identify specific authority to supplement a Petition at this stage in the proceeding, or persuade us that such supplementation is appropriate under these facts. Accordingly, Petitioner's request is denied. As discussed during the conference call, this Order does not estop Petitioner from requesting authorization from the Board to file a motion to submit supplemental information under 37 C.F.R § 42.123 if trial is instituted.

Conclusion

For all of the above-stated reasons, we are not persuaded that Petitioner should be authorized to file a revised Petition.

It is

ORDERED that Petitioner's request to file a revised Petition including supplemental information and/or substantive changes, prior to a Board decision on whether to institute *inter partes* review, is *denied*.

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PETITIONER:

Robert Kain
KAIN & ASSOCIATES, ATTORNEYS AT LAW, P.A.
rkain@complexip.com

Jerold Schneider
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY GROUP, PLLC
jerold.schneider@sriplaw.com

PATENT OWNER:

Thomas Leach
Andrew Lagatta
MERCHANT & GOULD P.C.
tleach@merchantgould.com
alagatta@merchantgould.com
BMcCall@merchantgould.com