

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVX CORPORATION and
AVX FILTERS CORPORATION,
Petitioner,

v.

GREATBATCH, LTD,
Patent Owner.

Case IPR2014-00697
Patent 5,905,627

SCOTT E. KAMHOLZ, *Administrative Patent Judge.*

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

A conference call was held on December 26, 2014, at Petitioner's request, to discuss Petitioner's concerns regarding Patent Owner's contact with a witness. According to Petitioner, a lawyer for Patent Owner contacted Mr. John Prymak, did not ascertain whether Mr. Prymak was represented by counsel, and asked Mr. Prymak questions about the substance of a prior-art reference at issue in this proceeding (Ex. 1011, "the Hazzard reference"). Petitioner asserted that Patent Owner's contact with Mr. Prymak was improper. Petitioner requested authorization to file a declaration of Mr. Prymak now to address the information Patent Owner elicited from Mr. Prymak concerning the Hazzard reference.

Petitioner was not given authorization to file a declaration of Mr. Prymak at this stage of the proceeding. Whatever the nature of Patent Owner's contact with Mr. Prymak, it is irrelevant to the present case so far, because no testimony of Mr. Prymak has yet been filed. Should Petitioner choose, it may present a declaration of Mr. Prymak with its Reply to the Patent Owner Response. Petitioner is reminded that all Reply evidence must be responsive evidence, i.e., directly refuting Patent Owner Response evidence, and not new evidence proffered to improve its position. *See* 37 C.F.R. § 42.23(b); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767 ("[A] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply.").

Accordingly, it is

ORDERED that Petitioner is not authorized to file a declaration of Mr. John Prymak before DUE DATE 2.

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PETITIONER:

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Michael R. Houston
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PATENT OWNER:

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Robert Mihail
NEIFELD IP LAW, PC