

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERIMAGE 3D, INC. and
MASTERIMAGE 3D ASIA, LLC,
Petitioner,

v.

REALD INC.,
Patent Owner.

Case IPR2015-00035
Patent 7,857,455 B2

Before JAMES B. ARPIN and BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Authorization
to File a Motion to Expunge
37 C.F.R. §§ 42.5(a), 42.7

I. DISCUSSION

On November 30, 2015, a conference call was held to discuss Patent Owner's request for authorization to file a motion to expunge Petitioner's

Supplemental Reply to Patent Owner's Response (Paper 60). Counsel for Petitioner and Patent Owner, respectively, and Administrative Patent Judges Arpin and Gerstenblith participated in the call.

Patent Owner asserted that Petitioner's Supplemental Reply and two accompanying claim charts exceeded the scope we set forth for said filing in our Order of November 17, 2015 (Paper 56). In particular, Patent Owner contended that Petitioner's inclusion of two additional¹ claim charts (Paper 60, Appendices 2 and 3) comparing claim 1 of U.S. Patent No. 8,220,934 B2 (Ex. 1010) and claim 1 of U.S. Patent Application Publication No. 2008/0225236 A1 (Ex. 1020), respectively, to U.S. Provisional Patent Application No. 60/827,657 (Ex. 1005, "the '657 provisional"), and the corresponding discussion thereof in the Supplemental Reply, raised a new patentability challenge not included in the Petition (Paper 1). Petitioner disagreed with Patent Owner's assertions and opposed Patent Owner's authorization request.

During the call, we denied Patent Owner's request for authorization to file a motion to expunge. We indicated that, if Patent Owner believes Petitioner's Supplemental Reply raises a new patentability challenge, Patent Owner can indicate that position in its Sur-Reply, which we authorized in the same November 17th Order referenced above (Paper 56, 3). Also, we explained that new patentability challenges are not raised appropriately in a reply, as indicated by our Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2002), and that we are able to determine if Petitioner raised a new challenge exceeding the scope of the authorized

¹ Patent Owner's request was not directed to Petitioner's Appendix 1 (Paper 60), comparing claim 1 of U.S. Patent No. 7,905,602 B2 (Ex. 1004, "Schuck") to U.S. Provisional Application No. 60/827,657 (Ex. 1005).

Supplemental Reply, after reviewing all of the relevant materials and without the aid of a motion to expunge from Patent Owner.

After we denied Patent Owner's request for authorization, Patent Owner requested that we expand the page limit for its Sur-Reply, so that it could address what it perceives to be the new patentability challenge by Petitioner.² We explained that, by Petitioner's use of some of its pages on the issue of concern to Patent Owner, Petitioner correspondingly used fewer pages to address whether the '657 provisional provides sufficient written description support for Schuck's claims, such that Schuck should be entitled to the '657 provisional's filing date. Moreover, "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." Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. Accordingly, we were not persuaded of the need to expand Patent Owner's Sur-Reply based on the assertions in Petitioner's Supplemental Reply, and we denied Patent Owner's request.

II. ORDER

It is:

ORDERED that Patent Owner is not authorized to file a motion to expunge Petitioner's Supplemental Reply (Paper 60); and

FURTHER ORDERED that the page limit for Patent Owner's Sur-Reply, set forth in Paper 56, is not expanded.

² During the call, we initially proposed additional Sur-Reply pages to Patent Owner as an alternative to authorizing a motion to expunge. Patent Owner refused that proposal as inadequate.

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