

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARIOSA DIAGNOSTICS
Petitioner

v.

THE BOARD OF TRUSTEES OF THE LELAND
STANFORD JUNIOR UNIVERSITY
Patent Owner.

Case IPR2013-00308
Patent 8,296,076 B2

Before LORA M. GREEN, RAMA G. ELLURU, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

A conference call was held on Wednesday, May 21, 2014, between Greg Gardella, representing Petitioner; Robert Huntington, representing Patent Owner; and Judges Green, Elluru, and Kamholz. A court reporter was present on the call, and a transcript of the call will be filed by Patent Owner in due course.¹ Patent Owner requested the call to discuss a declaration that Petitioner intended to file with its reply to the Patent Owner Response.

Patent Owner stated it believed that the declaration being offered by Petitioner was belatedly presenting new evidence that was in fact necessary for Petitioner's case. Patent Owner also stated that while Petitioner had offered cross-examination of the declarant, it would have no opportunity to respond to that new evidence in its briefings, or to counter it with additional evidence. Petitioner responded that the declaration did not raise new issues, but responded to the claim construction argued by Patent Owner in its Response.

We acknowledge that Petitioner's reply "may only respond to arguments raised in the corresponding opposition." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (citing 37 C.F.R. § 42.23). We also caution Petitioner that a reply that raises new issues or belatedly raises new evidence will not be considered, and we will not distinguish proper portions of the reply from improper portions. *Id.* Petitioner, however, is not prohibited under the rules from supporting its reply with new evidence, such as the declaration being discussed here. In that regard, we agree with the reasoning in *Liberty Mutual*

¹ This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

Insurance Co. v. Progressive Casualty Insurance Co., CBM2013-0000, slip op. at 24 (PTAB September 2, 2013 (Paper 26)), that it is standard procedure for Petitioner to have the last word with regard to the petition, and that one or more reply declarations may be necessitated by Patent Owner's response, as Petitioner cannot anticipate everything that may be in that response. *Id.*

That does not mean that Patent Owner cannot respond to any declarations that may be filed with Petitioner's reply. Patent Owner will have the opportunity to cross-examine the declarant, and can file observations on cross-examination. In addition, if Patent Owner feels that the reply and the declaration go beyond the scope of a proper reply, they can bring that to the panel's attention by requesting a conference call, or during oral argument, if requested.

Patent Owner also noted that because of the dates in the Scheduling Order, Petitioner had offered to make the declarant available for deposition on May 27, 2014. According to Patent Owner, the declaration was to be served on May 22, 2014, and with the holiday weekend, that would not be sufficient time to prepare for the deposition. Petitioner noted that it was willing to confer with Patent Owner to arrive at a more convenient time for Patent Owner to take the deposition. To support that process, we authorize the parties to stipulate to changes in DUE DATES 4 and 5, with the proviso that if the parties are going to request oral argument, that the request be filed by DUE DATE 4 as set forth in the Scheduling Order (Paper 8), that is, by May 29, 2014.

In consideration of the foregoing, it is hereby:

ORDERED, that the parties are authorized to file a stipulation as to DUE DATES 4 and 5 to accommodate the cross-examination of the declarant whose

Case IPR2013-00308
Patent 8,296,076 B2

declaration is being filed with Petitioner's reply; and

FURTHER ORDERED, that if the parties request oral argument, that the request be made by the DUE DATE 4 as set forth in the Scheduling Order.

PETITIONER:

Greg Gardella
cpdocketgardella@oblon.com

Scott McKeown
cpdocketmckeown@oblon.com

Kevin Laurence
cpdocketlaurence@oblon.com

Dianna DeVore
ddevore@ariosadx.com

Sarah Brashears
sbrashears@covergentlaw.com

PATENT OWNER:

Robert Huntington
dhuntington@rfem.com

Sharon Crane
scrane@rfem.com