

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI, INC.,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

Case IPR2015-01164 (Patent 7,554,290 B2)
Case IPR2015-01165 (Patent 7,944,173 B2)
Case IPR2015-01166 (Patent 7,999,510 B2)¹

Before GRACE KARAFFA OBERMANN and PATRICK R. SCANLON,
Administrative Patent Judges.

SCANLON, *Administrative Patent Judge.*

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

¹ This Decision addresses issues pertaining to all three cases. Thus, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

IPR2015-01164 (Patent 7,554,290 B2)

IPR2015-01165 (Patent 7,944,173 B2)

IPR2015-01166 (Patent 7,999,510 B2)

In a conference call in the above-captioned proceedings held on February 8, 2016, the Board authorized Patent Owner to file a motion for additional discovery in the instant proceedings. *See* Paper 13.² Patent Owner subsequently requested that the February 16, 2016, due date for its Patent Owner Response be extended until after the Board is able to decide the motion for additional discovery. Patent Owner indicated via email that the parties met and conferred regarding adjusting the dates in the instant proceedings, but Petitioner was not willing to do so without an agreement to also extend dates in related proceedings IPR2015-00595, IPR2015-00596, and IPR2015-00597.³ The Board granted an extension until at least February 19, 2016, via an email dated February 12, 2016, so that the issue of a further extension could be addressed in another conference call.

Such a conference call was held on February 16, 2016, and included Judge Obermann, Judge Scanlon, counsel for Petitioner, Hilti, Inc. (“Hilti”), and counsel for Patent Owner. Also participating in the conference call were counsel for Chervon North America, Inc. (“Chervon”) and counsel for Positec Tool Corporation (“Positec”). Chervon and Positec are petitioners, together with Hilti, in the first set of proceedings.

During the call, Patent Owner indicated that moving dates in the first set of proceedings would be unreasonable because the parties have already moved the dates, and there is no latitude to move the dates further with oral arguments in the first set of proceedings scheduled at the end of April. We

² For convenience, we refer to papers filed in IPR2015-01164. Similar papers were filed in IPR2015-01165 and IPR2015-01166.

³ For convenience, we refer to proceedings IPR2015-00595, IPR2015-00596, and IPR2015-00597 as “the first set of proceedings.”

IPR2015-01164 (Patent 7,554,290 B2)

IPR2015-01165 (Patent 7,944,173 B2)

IPR2015-01166 (Patent 7,999,510 B2)

note that Due Date 2, the date by which Petitioner's Reply is to be filed, has been changed by stipulation in the first set of proceedings from February 1, 2016 to February 22, 2016. IPR2015-00595, Paper 44, 1.

Petitioner indicated that extending the time for Patent Owner to file its Response in the instant proceedings will provide the Patent Owner an opportunity to preview Petitioner's Reply in the first set of proceedings, and thus be able to respond to Petitioner's Reply arguments in the Patent Owner Response. Petitioner directed the Board's attention to *Toyota Motor Corp. v. Hagenbuch*, Case IPR2014-00123 (PTAB July 16, 2014) (Paper 14) as an instance in which a similar situation was addressed by granting the patent owner an extension to file its Patent Owner Response when the patent owner agreed to stipulate to an extension for the petitioner to file its Reply in a related proceeding, such that said Reply would not have been filed prior to the Patent Owner Response. Petitioner also indicated that the need for the requested extension in the instant proceedings arose solely from Patent Owner's unreasonable delay in seeking to file its motion for additional discovery.

Upon consideration of both parties' positions, we determine that Patent Owner's interest in having its motion for additional discovery decided prior to filing its Patent Owner Response outweighs Petitioner's interest in denying Patent Owner the opportunity of previewing Petitioner's Reply from the first set of proceedings. Petitioner elected to participate in both the instant proceedings and the first set of proceedings and, thus, could have foreseen the possibility of Patent Owner having the opportunity to preview papers from the first set of proceedings. Indeed, based on the original schedules in these matters, Petitioner's Reply in the first set of proceedings would have been due

IPR2015-01164 (Patent 7,554,290 B2)
IPR2015-01165 (Patent 7,944,173 B2)
IPR2015-01166 (Patent 7,999,510 B2)

two weeks prior to Patent Owner's Response in the instant proceedings. Also, the opportunity to preview papers works both ways. For instance, Petitioner had the opportunity to preview Patent Owner's Preliminary Response from the first set of proceedings prior to filing the Petition in the instant proceedings.

Moreover, we are not convinced that it is appropriate to further extend the due date for Petitioner's Reply in the first set of proceedings. As noted above, this due date has already been extended three weeks. Also, we are not persuaded by Petitioner's citation to the *Toyota* case. That decision, which is not binding precedent, can be distinguished because the facts are sufficiently different from the present facts.

Based on these circumstances, Patent Owner is granted an extension of time to file its Response in each of the instant proceedings until after the motion for additional discovery is decided. Specifically, if Patent Owner's motion for additional discovery is denied, then Patent Owner is granted an extension of five business days after such denial to file its Response in each of the instant proceedings. If Patent Owner's motion for additional discovery is granted, then Patent Owner is granted an extension of five business days after production of the additional discovery to file its Response in each of the instant proceedings.

Accordingly, it is

ORDERED that Patent Owner's request for an enlargement of time to file its Response in each of the instant proceedings is *granted*;

FURTHER ORDERED that, if Patent Owner's motion for additional discovery is denied, then Patent Owner is granted an extension of five

IPR2015-01164 (Patent 7,554,290 B2)

IPR2015-01165 (Patent 7,944,173 B2)

IPR2015-01166 (Patent 7,999,510 B2)

business days after such denial to file its Response in each of the instant proceedings; and

FURTHER ORDERED that, if Patent Owner's motion for additional discovery is granted, then Patent Owner is granted an extension of five business days after production of the additional discovery to file its Response in each of the instant proceedings.

IPR2015-01164 (Patent 7,554,290 B2)
IPR2015-01165 (Patent 7,944,173 B2)
IPR2015-01166 (Patent 7,999,510 B2)

PETITIONER:

Jonathan Lindsay
Mark Neblett
Scott Bittman
CROWELL & MORING LLP
jlindsay@crowell.com
mneblett@crowell.com
sbittman@crowell.com

PATENT OWNER:

Dion M. Bregman
Charles C. Huse
MORGAN, LEWIS & BOCKIUS LLP
dbregman@morganlewis.com
chuse@morganlewis.com
milwaukee_ipr@morganlewis.com