

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDEN PARK ILLUMINATION, INC., LARSON ELECTRONICS LLC, FAR UV
TECHNOLOGIES, INC. and USHIO AMERICA, INC.,
Petitioners,

v.

S. EDWARD NEISTER,
Patent Owner.

Case IPR2023-00695
Patent 11,246,951

**PETITIONERS' OPPOSITION TO PATENT
OWNER'S MOTION FOR LEAVE TO SUBMIT
SUR-REPLY OUT OF TIME**

I. THE BOARD SHOULD DENY PATENT OWNER’S MOTION

On July 13th, the Board authorized the parties to submit supplemental briefing on a narrow issue relating to 35 U.S.C. 325(d). Ex. 3001. Petitioners timely filed its Reply on July 24th. Patent Owner’s Sur-reply was due by August 2nd. Patent Owner failed to meet that deadline. On August 9th, following oral argument by the same two parties in a different proceeding (IPR2022-00682), counsel for Patent Owner emailed Petitioners’ counsel asking whether Petitioners would oppose a request to file its Sur-reply after the August 2nd deadline, offering no explanation or justification. Petitioners responded within 10 minutes opposing Patent Owner’s request. Patent Owner then waited two days before emailing the Board with its request on August 11th—nine days since the Board’s authorized deadline.

Section 37 C.F.R. 42.5(c)(3) states that “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” Patent Owner has not adequately satisfied either requirement. The only “good cause” Patent Owner alleges is inadvertence. Paper 13 at 1. Mr. Ray’s declaration states that he “did not forward the email to put the filing deadline on our calendar” and was subsequently “on a family trip

overseas from July 26 to August 3.”¹ Ex. 2031 at ¶¶ 2-3. But 42 C.F.R. § 42.10(a) requires a party to designate, in addition to lead counsel, “at least one back-up counsel who can conduct business on behalf of the lead counsel,” to account for situations where lead counsel is unavailable. Patent Owner provides no explanation for why backup counsel, who was CC’d on all correspondence with Petitioners as well as the Board, (*see* Ex. 3001, Ex. 3002), did not respond on behalf of Patent Owner or, at minimum, request an extension of time to file its Sur-reply. Nor does Patent Owner provide any explanation for why it took two days to contact the Board to make the request after learning of Petitioners’ opposition.

Mistakes happen, which Petitioners can appreciate. But these proceedings are governed by rules and procedures designed to ensure an efficient and timely process. An institution decision is now due in less than one month. *See* Paper No. 6 (Notice of Accord mailed March 17, 2023). Patent Owner’s motion and supporting declaration pay only lip service to the requirements of “good cause” and “interest of justice.” Patent Owner’s delay prejudices Petitioners by limiting the amount of time the Board has to evaluate the Petition in light of Patent Owner’s new arguments. In effect, the delay prejudices the Board itself, for having to

¹ Mr. Ray appears to have been working and in the country when he received the Board’s email.

consider new information at the eleventh hour as it prepares its institution decision.

In the interests of fairness to the Board and to Petitioners, the record should be deemed complete, and Patent Owner's Sur-reply waived. The Board should deny Patent Owner's Motion for Leave to Submit its Sur-reply Out of Time.

Respectfully submitted,

Dated: August 21, 2023

/David Conrad/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 21, 2023, a complete and entire copy of this Petitioners' Opposition to Patent Owner's Motion for Leave to Submit Sur-Reply Out of Time was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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