

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDUSTRIAL REVOLUTION, INC.,
Petitioner,

v.

HUMANGEAR, INC.,
Patent Owner.

IPR2023-01174
Patent 10,555,629 B2

Before ROBERT J. SILVERMAN and BRENT M. DOUGAL,
Administrative Patent Judges.

SILVERMAN, *Administrative Patent Judge.*

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

On October 4, 2023, Petitioner (by electronic mail) requested authorization to file a Reply to Patent Owner's Preliminary Response (dated September 25, 2023), in order to address the issue (raised in the Preliminary Response) of the Board's discretion to deny the Petition under 35 U.S.C. § 325(d).

Petitioner submits that good cause exists for authorizing such a Reply, stating, in part:

Petitioner could not have been reasonably expected to anticipate Patent Owner's arguments regarding the alleged cumulative nature of the prior art relied upon in the Petition relative to the 200+ prior art citations listed on the face of challenged U.S. Patent No. 10,555,629, nor could Petitioner reasonably anticipate Patent Owner's arguments regarding the alleged lack of material error by the Office in view of the same.

Petitioner's communication also indicates that Patent Owner "has provided its consent" to the filing of a Reply, subject to the following statement provided by Patent Owner's counsel:

We wish at all times to extend a professional courtesy to leave to file various documents. As long as your reply conforms to the requirements of 37 CFR 42.23, we have no objection. However, we would not consent to a reply which adds new argument to what was in the original Petition, on matters the Petition did not originally address.

The Petitioner provided dates and times when the parties would be available for a conference with the Board.

We understand Patent Owner to assent to Petitioner's request to file a Reply limited to the issue of 35 U.S.C. § 325(d). Moreover, although the Petition does not examine the potential applicability of § 325(d), Petitioner's argument is persuasive, and permitting such a Reply would be of assistance to the Board.

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In view of the foregoing, the Board authorizes Petitioner to file a Reply limited to the issue of 35 U.S.C. § 325(d).

Accordingly, it is:

ORDERED that Petitioner may file a Reply to Patent Owner's Preliminary Response, limited to the issue of the applicability of 35 U.S.C. § 325(d). Such Reply shall be filed on or before October 27, 2023.

For PETITIONER:

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