

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BILLERUD AKTIEBOLAG (PUBL),
Petitioner,

v.

WESTROCK MWV, LLC,
Patent Owner.

IPR2023-01206
Patent 11,293,142 B2

Before DONNA M. PRAISS, CHRISTOPHER M. KAISER, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

On July 17, 2023, Petitioner filed a Petition requesting *inter partes* review of U.S. Patent No. 11,293,142 B2. Paper 1. Among the references asserted as prior art in the Petition was a set of “Excerpts from Rautiatinen, P. (2009). *Papermaking Science and Technology Book 10: Papermaking Part 3, Finishing* (2nd ed., pp. 35–42, 79–99). Paper Engineers’ Association.” *Id.* at 70 (citing Ex. 1005). Although the Petition referred to pages 35–42 and 79–99 as making up Exhibit 1005, the exhibit as filed instead contained pages 1–85. Ex. 1005.

Petitioner contacted the Board on September 25, 2023, seeking authorization to file the remainder of Exhibit 1005, informing us that Patent Owner brought the incomplete exhibit to Petitioner’s attention and asserting that the incompleteness was the result of a clerical error. Petitioner’s email did not inform us that Patent Owner opposed the request. Accordingly, we granted the request, and Petitioner filed the remainder of Exhibit 1005, comprising pages 86–173, as Exhibit 1010. Subsequently, Patent Owner contacted the Board to state its opposition to Petitioner’s request.

We held a telephone conference on September 26, 2023, attended by counsel for Petitioner, counsel for Patent Owner, and Judges Roesel and Kaiser. During the conference, Patent Owner argued that Petitioner’s filing of additional pages of the book excerpted in Exhibit 1005 should result in the Petition receiving a new, later filing date, because Patent Owner otherwise would not have the statutorily allotted time to prepare its Preliminary Response. Patent Owner also argued that the filing of pages beyond page 99 constituted a material change to the record that warranted additional time to respond. Petitioner countered that the newly filed information did not constitute any change in the substantive arguments presented in the Petition.

During the conference, the Board reset the due date for the Patent Owner Preliminary Response, and below we reiterate the Board's findings in support of that schedule change. Given the late filing of Exhibit 1010, the fact that pages 86–99 of Exhibit 1010 were listed as part of Exhibit 1005, a prior-art reference that Petitioner asserts as a basis of unpatentability, and the fact that pages 100–173 of Exhibit 1010 were not listed as part of originally-filed Exhibit 1005, we agree with Patent Owner that the record now is substantially different than the record at the time the Petition was accorded a filing date. Thus, it would be unreasonable to hold Patent Owner to the current due date for the Preliminary Response, calculated as three months after the day on which the Petitioner was accorded a filing date.

During the conference, both parties agreed that, if Patent Owner were to be given additional time to file its Preliminary Response, the new due date should be calculated as three months from September 25, 2023, the date Petitioner filed Exhibit 1010. Thus, we adjust the due date of Patent Owner's Preliminary Response to December 25, 2023.

ORDER

Accordingly, it is

ORDERED that the due date for Patent Owner to file its Preliminary Response shall be December 25, 2023.

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