

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HESAI TECHNOLOGY CO., LTD.,
Petitioner,

v.

OUSTER, INC.,
Patent Owner.

IPR2023-01422
Patent 11,287,515 B2

Before MEREDITH C. PETRAVICK, KEVIN W. CHERRY, and
JON M. JURGOVAN, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

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

On February 6, 2024, Patent Owner contacted the Board via email to request authorization to file additional briefing and information in this case. A conference call was held on February 9, 2024 between respective counsel for the parties and Judges Cherry and Jurgovan to discuss Patent Owner's request.

1. Background

Patent Owner indicated that challenged Patent 11,287,515 B2 ("the '515 patent") (Ex. 1001) had a mistake in its claim of priority. According to Patent Owner, U.S. Provisional Application No. 62/596,018 ("the '018 provisional") was inadvertently omitted on an Application Data Sheet that was submitted in U.S. Application Serial No. 17/323,987 ("the '987 application"), which issued as the '515 patent. Patent Owner indicated that the '018 provisional was included in the '987 application specification's recitation of priority claim.

Patent Owner also indicated that, on October 9, 2023, Patent Owner filed a Petition to Accept an Unintentionally Delayed Claim Pursuant to 37 C.F.R. § 1.78(e) along with a Request for Certificate of Correction Under 37 C.F.R. § 1.323 in the '987 application. On October 31, 2023, Patent Owner filed an updated Mandatory Notice (Paper 6) in this proceeding informing the Board of same. Patent Owner further indicated that its Petition was granted by the USPTO in a decision mailed January 5, 2024.

2. Request to Submit Additional Briefing

Patent Owner requested authorization to file a five-page brief addressing the priority issue, and arguing that Pacala-2017 (U.S. Patent Appl. No. 2017/0289524 A1, published Oct. 5, 2017) (Ex. 1013) does not qualify as prior art in light of the corrected priority date of the '515 patent.

Patent Owner argues that it has established good cause for the request. According to Patent Owner, it could not have argued the issue in its Preliminary Response because Patent Owner's petition to the USPTO to correct the priority claim had not been decided as of the due date for the Preliminary Response.

Petitioner opposed the request for additional briefing. Petitioner indicated that it did not object to Patent Owner arguing the issue at trial, but did object to Patent Owner briefing the issue before the institution decision. Petitioner also argued that the priority issue does not impact the Board's decision whether to institute trial because the issue only affects grounds 8 and 9, which are the only grounds that rely on *Pacala-2017*.

After hearing the parties' respective positions, Judge Jurgovan explained that granting Patent Owner's request for additional briefing would place a burden on the Board because the institution decision is due March 21, 2024. Granting the parties an additional round of briefing at this stage in the proceeding would entail the parties submitting additional briefs in February and March, leaving the Board with only about two weeks to review the additional briefs before issuing an institution decision. Accordingly, Judge Jurgovan indicated that the request for additional briefing would not be granted.

3. Authorization to Submit Additional Information

To enable the Board to consider the priority issue in the institution decision, if the issue is reached, the Board authorized Patent Owner to file the following documents as exhibits in this proceeding:

1. The USPTO's decision in the '987 application, mailed January 5, 2024, on Patent Owner's Petition to Accept an Unintentionally Delayed Claim Pursuant to 37 C.F.R. 1.78(e).
2. A copy of the originally filed specification and drawings of the '018 provisional.
3. A copy of the originally filed specification and drawings of U.S. Application Serial No. 16/209,875 (parent of the '987 continuation application).

Petitioner indicated that it does not object to Patent Owner filing the documents listed above, and Judge Jurgovan indicated that Patent Owner would be authorized to file those documents as separate exhibits.

ORDER

Accordingly, it is:

ORDERED that Patent Owner shall file the following documents as separate exhibits in this proceeding within five (5) business days:

1. The USPTO's decision in U.S. Application Serial No. 17/323,987, mailed January 5, 2024, on Patent Owner's Petition to Accept an unintentionally Delayed Claim Pursuant to 37 C.F.R. 1.78(e).
2. A copy of the originally filed specification and drawings of U.S. Provisional Application No. 62/596,018.
3. A copy of the originally filed specification and drawings of U.S. Application Serial No. 16/209,875.

FURTHER ORDERED that Patent Owner's request for additional briefing is *denied*.

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