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Paper 17
Date: July 1, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLUIDMASTER, INC.,
Petitioner,

v.

DANCO, INC.,
Patent Owner.

IPR2024-00633 (Patent 9,139,993 B1)
IPR2024-00634 (Patent 9,103,105 B1)
IPR2024-00635 (Patent 10,934,698 B1)[1]

Before MEREDITH C. PETRAVICK, JAMES A. TARTAL, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

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

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[1] The combined caption is for administrative convenience only and does not indicate that IPR2024-00633, IPR2024-00634, and IPR2024-00635 have been joined. The parties are not authorized to use this caption without express Board permission.

Counsel for the parties and Judges Petravick, Tartal, and Silverman held a conference call on June 26, 2024. This order memorializes the conference call.

Petitioner initiated the call to request authorization to correct clerical errors in each Petition in each of the above-referenced proceedings, or to file motions to correct the clerical errors. Petitioner requested to correct clerical errors in each Petition or to file motions to correct the clerical errors because the Petitions contain figures from which annotations/labels were inadvertently omitted when the Petitions were converted from Microsoft Word format to Adobe PDF format. Petitioner contends its expert declarations filed and served with the Petitions contain the versions of the figures with the correct annotations/labels. Petitioner also contends it first learned of the errors while reviewing Patent Owner's Preliminary Responses filed on June 13, 2024.

Petitioner also requested authorization to file a reply to Patent Owner's Preliminary Responses in each of the above-referenced proceedings. Petitioner requested replies to address (1) Patent Owner's characterization of the prior art as the same or substantially the same as prior art that was before the Patent Office during prosecution in each proceeding; (2) Patent Owner's arguments regarding the claimed priority dates in IPR2024-00633 and IPR2024-00634; and (3) Patent Owner's arguments against institution based on the annotations/labels Petitioner contends were inadvertently omitted from the figures in the Petitions but are correct in the

declarations for each of IPR2024-00633, IPR2024-00634, and IPR2024-00635.

Patent Owner opposed each of the requests.

Under 37 C.F.R. § 42.108(c), "[a] petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause." Based on the information received from the parties, during the call, we granted Petitioner's request to the extent explained below. We determined that replies would be helpful to us in evaluating whether to institute trial and that good cause exists to allow Petitioner to file replies.

During the call, we authorized Petitioner to file replies no later than July 8, 2024. We authorized Petitioner to file eight pages in each proceeding limited to addressing (1) Patent Owner's characterization of the prior art as the same or substantially the same as prior art that was before the Patent Office during prosecution in each proceeding; (2) Patent Owner's arguments regarding the claimed priority dates in IPR2024-00633 and IPR2024-00634; and (3) Patent Owner's arguments against institution based on the annotations/labels Petitioner contends were inadvertently omitted from the figures in the Petitions but are correct in the declarations for each of IPR2024-00633, IPR2024-00634, and IPR2024-00635.

We also authorized Patent Owner to file sur-replies, with corresponding page limitations, no later than July 18, 2024.

Because we granted Petitioner's request to file a reply in each proceeding, we denied as unnecessary at this time Petitioner's request for authorization to file a motion to correct clerical errors in each Petition.

IPR2024-00633 (Patent 9,139,993 B1)
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IPR2024-00635 (Patent 10,934,698 B1)

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