

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VICOR CORPORATION,
Petitioner,

v.

DELTA ELECTRONICS, INC.,
Patent Owner.

IPR2024-00715
Patent 10,877,534 B2

Before THU A. DANG, NATHAN A. ENGELS, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

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

BACKGROUND

Petitioner e-mailed the Board to request authorization to file a preliminary reply to the Patent Owner Preliminary Response in the above case, and Patent Owner emailed the Board expressing its opposition to Petitioner's request. Ex. 3001. The Board conducted a conference call with counsel for the parties to discuss Petitioner's request and Patent Owner's opposition. A transcript of the call has been filed. Ex. 1017 ("Tr.").

DISCUSSION

Petitioner requests authorization to file a preliminary reply to Patent Owner's Preliminary Response of up to three pages to address what Petitioner characterizes as: 1) Patent Owner's argument concerning the priority date and, specifically, the assertion that the priority documents disclose a power supply apparatus having "a pin on two lateral sides of the bearing plate;" and 2) Patent Owner's argument for discretionary denial and its assertion that the petitions in the instant case and in IPR2024-00706 concern claims that are "substantially identical." Ex. 3001. According to Petitioner, good cause for additional briefing exists because "Petitioner could not have foreseen Patent Owner's arguments" regarding these issues. *Id.*

For the first issue, Patent Owner does not oppose Petitioner request, as long as it can file a sur-reply. As to the second issue, Patent Owner opposes the request, stating that Petitioner has not provided good cause for a reply. Ex. 3001. Patent Owner asserts that "Petitioner was required to provide [] detail justifying multiple petitions in its original Petition, and Petitioner

knew it was an issue because Petitioner briefed it in its notice of petition rankings.” *Id.*

During the telephone conference, Petitioner asserted that, as to the first issue, Patent Owner’s arguments related to portions of the priority documents could not have been anticipated. Tr. 30:7–31:12. Patent Owner does not oppose the request for the first issue. *Id.* at 32:4–6. For the second issue, Petitioner presented arguments as to why the claims challenged in the two respective cases are different and argued that this justifies the additional briefing. Tr. 25:22–26:21, 29:9–30:1. Patent Owner contends that “[t]hese issues should have been raised by Petitioner in th[e] notice of ranking” and Petitioner is seeking a “curative do-over.” *Id.* at 27:6–22, 31:19–32:3.

For the first issue, the request is unopposed, and we agree with Petitioner that the nature of Patent Owner’s arguments regarding portions of the priority documents were not foreseeable. As to the second issue, in Petitioner’s Notice Ranking (Paper 2), Petitioner asserted that there was “significant differences in the claim scope between claims of the two claim sets” in the two respective cases (*id.* at 3). In its Preliminary Response, Patent Owner asserted that the claims challenged in the two cases concern “substantially identical independent claim,” and that this is relevant to the issue of discretionary denial. Paper 8, 10. We agree with Petitioner that Patent Owner’s assertion, in the context of the record, was not foreseeable and the issue is relevant to the consideration of discretionary denial so additional briefing would be helpful to the Board. Accordingly, Petitioner’s request for additional briefing is granted.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may file, on or before August 20, a three-page preliminary reply to the Patent Owner's Preliminary Response, addressing the issues of: 1) Patent Owner's arguments concerning the priority documents relating to the priority date; and 2) whether the claims challenged in IPR2024-00706 and IPR2024-00715 are substantially similar and the consideration of that issue in the context of discretionary denial; and

FURTHER ORDERED that Patent Owner may file a three-page preliminary sur-reply in response to Petitioner's preliminary reply, on or before August 27.

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