

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLASTERS, INC,
Petitioner,

v.

WATERBLASTING, LLC,
Patent Owner.

Case IPR2018-00504
Patent 7,255,116 B2

Before JEFFREY W. ABRAHAM, MICHAEL L. WOODS and
JOHN R. KENNY, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

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

In an e-mail to the Board dated February 15, 2019 (Ex. 3001), Patent Owner requested permission to file a "Motion for Attention to New Material and Argument" in response to Petitioner's Reply. Paper 17. Patent Owner argued that this motion should be due on February 22, 2019, the due date for a motion for observation regarding cross-examination. Patent Owner's counsel further indicated Petitioner's counsel was contacted but the parties did not reach a stipulation. According to Patent Owner, counsel for both parties are available for a teleconference.

We, however, see no need for a teleconference, nor do we see a reason to authorize the requested motion in light of the Board's updated policy regarding sur-replies. In particular, on August 13, 2018, the Board revised its Trial Practice Guide to allow patent owners to file a sur-reply in response to a petitioner's reply in lieu of a motion for observation on cross-examination. *See* Office Patent Trial Practice Guide, August 2018 Update, at 14, 83 Fed. Reg. 39989 (August 13, 2018), available at <https://go.usa.gov/xU7GP> ("Trial Practice Guide Update"). Patent Owner can address the arguments that it planned to make in its requested motion in a sur-reply (assuming those arguments satisfy the requirements for a sur-reply).

Therefore, we do not authorize Patent Owner's requested motion, but we do authorize the Patent Owner to file a sur-reply by February 22, 2019. If Patent Owner chooses to file that sur-reply, it must comply with the provisions set forth in the Trial Practice Guide Update, specifically:

The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony,

or point to cross-examination testimony. . . . [A] sur-reply may address the institution decision if necessary to respond to the petitioner's reply.

Trial Practice Guide Update, 14. The sur-reply is subject to the same word limit as Petitioner's Reply. *Id.* at 6; *see* 37 C.F.R. § 42.24(c)(1). Further, if filed, the sur-reply will take the place of a motion for observation on cross-examination testimony.

It is hereby:

ORDERED that Patent Owner may file a sur-reply in accordance with the Board's Trial Practice Guide Update and in response to Petitioner's Reply. Patent Owner's sur-reply, if Patent Owner chooses to file it, is due by February 22, 2019.

IPR2018-00504
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