

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC., D/B/A TECHTRONIC
INDUSTRIES POWER EQUIPMENT,

Petitioner,

v.

CHERVON (HK) LIMITED,

Patent Owner.

IPR2020-00884 (Patent 9,596,806 B2)
IPR2020-00886 (Patent 9,826,686 B2)
IPR2020-00887 (Patent 9,986,686 B2)
IPR2020-00888 (Patent 10,070,588 B2)

Before JAMES J. MAYBERRY and ALYSSA A. FINAMORE,
Administrative Patent Judges.

MAYBERRY, *Administrative Patent Judge.*

ORDER¹

Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.20(b)

¹ This Order addresses issues that are the same in all listed cases. We do not authorize the parties to use this style heading for any subsequent papers at this time.

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Background

We instituted trial in the four proceedings covered by this Order. *See, e.g.*, Paper 20 (instituting trial in IPR2020-00884)². Patent Owner, Chervon (HK) Ltd. (“Chervon”), filed Responses in the four proceedings (Paper 25) and Petitioner, One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment (“One World”), filed Replies (Paper 39). On June 1, 2021, we held a conference call between the parties and Judges Mayberry and Finamore. In the call, Chervon requested authorization to file a motion to strike certain arguments in the Replies for these four proceedings.

Summary of the Parties’ Positions

In the call, Chervon argued that the Replies include many instances of new arguments, including arguments directed to motivation to combine teachings in the asserted references, and directed to what the asserted references disclose. Chervon added that these arguments amount to attorney argument, with no citation to the Petition or expert declaration filed in support of the Petition. Chervon argued that the extent of the new arguments warranted briefing to assist the Board in identifying these new arguments, and that it would be prejudiced in having to reply to the arguments.

One World responded that the arguments were responsive to arguments made in the Patent Owner Responses. One World added that most of its arguments include citations to the Petition and supporting evidence of record.

² We cite to papers and exhibits for IPR2020-00884. Similar papers and exhibits have been filed in the other proceedings.

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Analysis

A petitioner may not bolster its original case-in-chief with new theories and evidence in its reply brief. To do so would violate 37 C.F.R. § 42.23(b), which forbids the introduction of new arguments on reply. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”). We determine that the panel would benefit from briefing on this issue.

“[S]triking the entirety or a portion of a party’s brief is an exceptional remedy” that we expect to grant “rarely.” Consolidated Trial Practice Guide 80 (Nov. 21, 2019) (“CTPG”)³. We determine, however, that we should give Chervon the opportunity to brief fully its allegations. We base our determination, in part, on the alleged magnitude of the issue and the fact that this issue cuts across four proceedings.

We understand that our Order requires One World to expend additional resources addressing this issue, a consideration we do not take lightly. Still, we determine that the benefits of fully briefing this issue outweigh the additional burden. These benefits include to the panel, in considering only proper arguments and evidence in assessing the challenges in these proceedings, and the public, where *inter partes* review proceedings determine the patentability of claims in issued patents and therefore affect

³ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

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the rights of the public. Also, we determine that One World is not otherwise prejudiced, as it will have the opportunity to respond to Chervon's arguments in an opposition, should it choose to file one.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a motion to strike certain portions of Petitioner's Reply in each of the above-captioned *inter partes* review proceedings, the motion not to exceed ten pages and due June 14, 2021;

FURTHER ORDERED that Petitioner is authorized to file an opposition to the motion for sanctions, the opposition not to exceed ten pages and due June 30, 2021; and

FURTHER ORDERED that no reply is authorized at this time.

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