

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DYNATEMP INTERNATIONAL, INC. and FLUOROFUSION
SPECIALTY CHEMICALS, INC.,
Petitioner,

v.

R421A LLC d/b/a CHOICE REFRIGERANTS,
Patent Owner.

IPR2020-01660
Patent 9,982,179 B2

Before GRACE KARAFFA OBERMANN, MICHELLE N. ANKENBRAND,
and MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge*.

ORDER

Authorizing Petitioner to File a Reply and
Authorizing Patent Owner to File a Sur-Reply
37 C.F.R. §§ 42.5; 42.108(c)

On March 3, 2021, Petitioner submitted an email requesting authorization to: (1) file a Reply to Patent Owner's Preliminary Response (Paper 9) to the Petition (Paper 1) and (2) withdraw Grounds 4, 5, and 7 of the Petition from consideration. *See generally* Ex. 3001 (copies of email correspondence, including email from Petitioner, emails from Patent Owner, and responsive emails from the Board). Petitioner averred that it met and conferred with Patent Owner about each of the above requests, which Patent Owner opposed. *Id.* at 2, 7. This Order memorializes responses previously provided by the Board to the parties.^{1, 2}

Regarding the purpose of the Reply, Petitioner states that "Patent Owner's Preliminary Response suggests cyclopentane is a refrigerant gas" and "Petitioner seeks leave to file a Reply to Patent Owner's Preliminary Response to show that cyclopentane is neither a refrigerant nor a gas." Ex. 3001, 7.

The Board did not hold a telephonic conference call, but instead advised the parties that the panel, having considered Petitioner's request to file a Reply to Patent Owner's Preliminary Response, "determined that

¹ On March 4, 2021, Patent Owner submitted an email objecting to Petitioner's request to file a Reply to Patent Owner's Preliminary Response for failure to show good cause, and requesting that the Board vacate the decision authorizing Petitioner to file a Reply and Patent Owner to file a Sur-Reply. Ex. 3001, 5–6. The Board responded to Patent Owner's objection and request for the Board to vacate the decision authorizing Petitioner to file a Reply in an email to the parties on March 5, 2021. *Id.* at 4.

² On March 5, 2021, Patent Owner submitted an email objecting to Petitioner's request to withdraw Grounds 4, 5, and 7 of the Petition from consideration. Ex. 3001, 1. The Board responded to Patent Owner's objection to Petitioner's request to withdraw Grounds 4, 5, and 7 of the Petition from consideration in an email to the parties on March 10, 2021. *Id.*

additional briefing may be helpful to the Board” and, on that basis, authorized Petitioner’s request. *Id.* at 4, 6. We mitigated any concerns of fairness or prejudice by providing Patent Owner an opportunity to file a Sur-Reply commensurate in scope and length with the Reply. *Id.*

We instructed the parties that the Reply shall be strictly limited to responding to the issue of whether cyclopentane is a refrigerant gas raised in the Preliminary Response identified above and set forth in Exhibit 3001, and that the Sur-Reply shall be limited to responding to issues raised in the Reply. Ex. 3001, 6. We also instructed the parties that no new evidence shall be filed in support of the Reply or Sur-Reply. *Id.*

In subsequent correspondence, we informed the parties that the Board took Petitioner’s request to withdraw Grounds 4, 5, and 7 of the Petition from consideration (as set forth in Petitioner’s March 3rd email) and Patent Owner’s objection to that request (as set forth in Patent Owner’s March 5 email) under advisement, and that we would address them in due course. *Id.* at 1.

It is

ORDERED that we grant Petitioner’s request for authorization to file a Reply to Patent Owner’s Preliminary Response to the Petition;³

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply pursuant to the above authorization;

³ Petitioner filed the Reply to Patent Owner’s Preliminary Response to the Petition on March 8, 2021. Paper 12.

FURTHER ORDERED that, should Patent Owner elect to file a Sur-Reply pursuant to this grant of authorization, the Sur-Reply must be filed within 3 business days of the filing of the Reply, may be up to 2 pages in length, and must be limited to responding to issues raised in the Reply;

FURTHER ORDERED that no new evidence shall accompany the Reply and Sur-Reply; and

FURTHER ORDERED that no other briefing or relief is authorized at this time.

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