

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,
Petitioner,

v.

ALIPHCOM, INC. D/B/A JAWBONE,
Patent Owner.

Case IPR2016-00607
Patent 8,529,811 B2

Before CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judge*.

DECISION

Granting Motion to Accept Email Submission of Preliminary Response
37 C.F.R. § 42.6(b)(2)(i)

Petitioner, Fitbit, Inc., commenced this preliminary *inter partes* review proceeding by filing a Petition on February 10, 2016. Paper 2. The Board issued a Notice of Filing Date Accorded to Petition on February 17, 2016. Paper 3. By regulation, Patent Owner AliphCom, Inc. d/b/a Jawbone

(“Jawbone”) had three months—until May 17, 2016—to file a preliminary response to the Petition, if desired. 37 C.F.R. § 42.107(b).

On the evening of May 17, at approximately 8:17 pm Eastern time, counsel for Jawbone contacted the Board via email, noting that the Board’s Patent Review Processing System (“PRPS”) incorrectly listed Jawbone’s counsel as counsel for *petitioner*. As such, Jawbone was unable to file documents through PRPS on behalf of Jawbone as *patent owner*. Jawbone requested email filing of its Preliminary Response, attached to the email, and also submitted a Motion to Accept the Submission of the Preliminary Response.

The following day, Board staff corrected the designation of counsel in PRPS and instructed Jawbone to file its Preliminary Response electronically. That filing, however, is beyond the three-month filing period set by regulation. *See* Paper 10.

The Board’s Rules state that a party should file electronically over the Internet, but permit filing by other means if accompanied by a motion requesting acceptance of the submission. 37 C.F.R. § 42.6(b). The Board’s Web site explains that if PRPS is unavailable, documents may be submitted to the Board via email. *See* FAQ A2, <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>.

Jawbone’s Motion to Accept Submission of the Preliminary Response states that because of the incorrect designation of counsel, PRPS was “unavailable” to Jawbone at the time the filing was attempted. Paper 11, 2. Jawbone also submits a screenshot from PRPS showing the incorrectly

designated counsel (Ex. 2003), as well as email correspondence with counsel for Fitbit conveying Jawbone's intent to file via email (Ex. 2004). Fitbit has informed the Board that it does not oppose the grant of Jawbone's Motion.

Upon review of the facts, we agree that, under the circumstances of this case, PRPS was unavailable to Jawbone at the time its Preliminary Response was due on May 17, 2016. As such, filing via email was proper under the Board's Rules. The Preliminary Response filed via email is hereby accepted, and will be accorded a filing date of May 17, 2016.

For the foregoing reasons, it is

ORDERED that the Motion to Accept Submission (Paper 11) is *granted*; and

FURTHER ORDERED that Patent Owner's Preliminary Response to the Petition (Paper 10) is accorded a filing date of May 17, 2016.

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