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Paper 32
Entered: December 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
Patent Owner.

Case IPR2018-00344
Patent 7,047,196 B2

Before JAMESON LEE, ROBERT L. KINDER, and ALEX S. YAP, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Authorizing Sur-Reply by Patent Owner
37 C.F.R. § 42.5

I. INTRODUCTION

On December 12, 2018, Patent Owner requested, by email communication, authorization to file a sur-reply to Petitioner's Reply. A copy of the email communication is entered as Exhibit 3002. Patent Owner indicates that filing of a sur-reply by Patent Owner is consistent with the Revised Patent Trial Practice Guide authorizing such sur-replies.[1] Because the request indicates that Petitioner opposes, we held a conference call on December 13, 2018. The participants were respective counsel for the parties, and Judges Lee, Kinder, and Yap. For reasons discussed below, we authorize the filing of a sur-reply by Patent Owner.

II. DISCUSSION

Trial was instituted on July 2, 2018. Paper 10. In the Scheduling Order, we did not provide for the filing of a sur-reply by the Patent Owner. Paper 11. Rather, we provided for the filing by Patent Owner, in response to Petitioner's Reply, a Motion for Observation on Cross-Examination. *Id.* Subsequent to institution of trial, notice of issuance of the Revised Patent Trial Practice Guide was published in the Federal Register on August 13, 2018. 83 Fed. Reg. 39989 (August 13, 2018). The Revised Trial Practice Guide authorizes the filing of a sur-reply by Patent Owner and states: "This sur-reply practice essentially replaces the previous practice of filing observations on cross-examination testimony." Rev. Guide, 14.

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[1] The Trial Practice Guide Update is available at https://www.uspto.gov/sites/default/files/documents/2018_Revised_Practice_Guide.pdf. Hereinafter, we refer to and cite The Trial Practice Guide Update as "Rev. Guide."

Petitioner opposes Patent Owner's request for several reasons. First, counsel for Petitioner was uncertain whether Patent Owner would file the requested sur-reply "in lieu of" the already authorized motion for observations on cross-examination. But during the conference call, counsel for Patent Owner represented that the requested sur-reply would be in lieu of a motion for observations on cross-examination. Thus, if a sur-reply is authorized, Patent Owner will not be filing a motion for observations on cross-examination.

Second, counsel for Petitioner represented that Petitioner's Reply was written with the understanding that it would be the last word on the subject matters at issue, and that Petitioner's cross-examination of Patent Owner's witnesses was also conducted on the assumption that Petitioner would get the last word on the subject matters at issue. The argument is unpersuasive. Petitioner may not assume that it necessarily would make the last substantive filing given that Patent Owner always could request the filing of a sur-reply, particularly when the Revised Patent Guide Practice Guide permitting filing of sur-replies was published on August 13, 2018.[2]

In any event, during the conference call, we asked counsel for Petitioner whether, if we authorized a sur-reply, Petitioner would want the opportunity to file a new reply to substitute for the Reply already filed, prior to Patent Owner's filing of a sur-reply. Counsel for Petitioner declined that opportunity and answered that Petitioner would not need to file such a substitute reply, because the substance of the substitute reply would be no

[2] It appears from the record that all of Patent Owner's witnesses were cross-examined subsequent to August 13, 2018.

different from its Reply. That response further undermines the argument that the Reply and the cross-examination of Patent Owner's witnesses were prepared on the assumption that Petitioner would make the last substantive filing.

Third, Petitioner argues that had Patent Owner filed a motion for observations on cross-examination, it would have had an automatic opportunity to file an opposition, whereas in the case of a sur-reply by Patent Owner, there is no such automatic opportunity. What Petitioner asserts is true. But it does not show prejudice to Petitioner by our authorizing the filing of a sur-reply by Patent Owner. After the filing of a sur-reply by Patent Owner, Petitioner may request authorization, to file a further response (*i.e.*, a sur-sur-reply) if it can justify the filing of such a further response. It is not prejudicial to Petitioner having to provide justification to be authorized a further response. For instance, if Patent Owner's sur-reply is like a motion for observations on cross-examination, then that would justify a further response in the nature of an opposition to a motion for observations on cross-examination. Further, we note that sur-replies may not be accompanied by new evidence (deposition transcripts of cross-examination are allowed, as they would have been via observations on cross-examination). The sur-reply must also be responsive to arguments made in the corresponding reply brief or the corresponding declaration testimony.

III. ORDER

It is, therefore,

ORDERED that Patent Owner is authorized to file a sur-reply that conforms to the requirements of a sur-reply as noted in the Revised Trial Practice Guide. Rev. Guide, 14–16;

FURTHER ORDERED that Patent Owner's sur-reply is due on Due Date 4; and

FURTHER ORDERED that Patent Owner shall file no motion for observations on cross-examination.

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