

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WILLIAM HILL U.S. HOLDCO, INC. and
BRANDYWINE BOOKMAKING LLC,
Petitioner,

v.

CG TECHNOLOGY DEVELOPMENT, LLC,
Patent Owner.

Case IPR2019-00317 (Patent 9,269,224 B2)
Case IPR2019-00319 (Patent 9,240,098 B2)
Case IPR2019-00320 (Patent 10,096,207 B2)¹

Before BARRY L. GROSSMAN, MITCHELL G. WEATHERLY, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5 & 42.108(c)

¹ This Order applies to all three proceedings. The proceedings have not been consolidated, and the parties are not authorized to use a consolidated caption unless the paper contains a footnote indicating that the identical paper has been filed in each proceeding.

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On March 19, 2019, Petitioner's counsel Mr. Keith Walter sent an e-mail communication to the Board in relation to these three proceedings, copying Patent Owner's counsel. The e-mail indicates the Preliminary Responses respectively filed in each proceeding are "almost identical" in "asking the Board to exercise its discretion and deny institution of each petition under 35 U.S.C. § 325(d)." The e-mail, further, states:

Petitioner[] respectfully request[s] the opportunity to request a Reply to Patent Owner's Preliminary Responses pursuant to 37 C.F.R. § 42.108(c), to respond to CG's misleading statements set forth in its Preliminary Response, clarify the facts about what was considered/used during original prosecution, and address the factors considered in application of 35 U.S.C. § 325(d).

Counsel for the parties met and conferred on March 19, 2019. Counsel for [Patent Owner] advised that [Patent Owner] opposes Petitioner's request for a Reply. Counsel for the parties are generally available for a teleconference with the Board

Upon consideration of the foregoing, we determine a telephone conference to discuss this issue would be an unnecessary and inefficient use of the Board's and the parties' resources. Instead, we authorize Petitioner to file a Reply to the Preliminary Response, and Patent Owner to file a Sur-Reply to the Reply, as set forth further below. *See, e.g.*, 37 C.F.R. §§ 42.5 & 42.108(c).

It is hereby:

ORDERED that, Petitioner may file a Reply to the Preliminary Response in each of these three proceedings, concerning only the argument(s) raised in the respective Preliminary Response as to whether the Board should apply 35 U.S.C. § 325(d) to deny institution, and not to exceed

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five pages in length, at or before 5:00 p.m. Eastern Time on the seventh (7th) calendar day following entry of this Order; and

FURTHER ORDERED that, Patent Owner may file a Sur-Reply to the Reply in each of these three proceedings, concerning only the argument(s) raised in the respective Replies, and not to exceed five pages in length, at or before 5:00 p.m. Eastern Time on the seventh (7th) calendar day following the filing of the respective Reply.

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