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Paper No. 9
Entered: January 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

WHEREVERTV, INC.,
Patent Owner.

Cases IPR2019-01482 and IPR2019-01483
Patent 8,656,431 B2

Before KRISTEN L. DROESCH, BARABARA A. PARVIS, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on January 7, 2020, between counsel for the parties and Judge Droesch, Judge Parvis, and Judge Sawert. Counsel for Petitioner requested the conference call to seek authorization to file a reply to Patent Owner's Preliminary Response.

Specifically, Petitioner seeks authorization to file a reply to address three issues. First, Petitioner seeks to address Patent Owner's constructions of several claim terms and phrases in the Preliminary Response, which Petitioner asserts are inconsistent with Patent Owner's positions in a related district court litigation. Patent Owner opposes Petitioner's request, and asserts that Petitioner had the opportunity to present its own claim constructions of these claim terms and phrases in its Petition but elected not to do so.

Second, Petitioner seeks to address Patent Owner's Preliminary Response argument that the Petition does not comply with 37 C.F.R. § 104(b)(3)-(4) because the Petitioner did not analyze patentability based on claim constructions Petitioner believed were correct. Petitioner asserts that Patent Owner's argument was unforeseeable. Patent Owner opposes Petitioner's request, and directs attention to the Joint Claim Construction Statement filed in the related district court litigation (IPR2019-01482, Ex. 2008), noting that that the Petition provided constructions for only two claim terms or phrases.

Lastly, Petitioner seeks to address Patent Owner's arguments in the Preliminary Response that the Board should exercise its discretion to decline institution based on the anticipated completion of proceedings in the related district court litigation. Patent Owner also opposes the request on this basis.

A petitioner seeking leave to file a reply to a preliminary response must show good cause for filing a reply. *See* 37 C.F.R. § 42.108(c). Petitioner's request for authorization to file a reply to the Preliminary Response to address Patent Owner's claim constructions and arguments that the Petition does not comply with 37 C.F.R. § 104(b)(3)-(4) is denied. Petitioner could have, but did not, address the constructions of several claim terms and phrases in its Petition. Because Petitioner could have foreseen the relevance of these claim construction issues at the outset of this case, we are not persuaded that Petitioner should be given an additional opportunity to address them now. Thus, we determine that Petitioner has failed to show good cause to file a reply to address these matters.

However, due to the relatively recent precedential designation of *NHK Spring Co., Ltd v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (Institution Decision) (designated May 7, 2019), Petitioner is authorized to file a 3-page reply to address only whether the Board should exercise discretion to deny the petitions based on the anticipated completion of proceedings in the related district court litigation. Petitioner also is requested to file, as exhibits, documents identifying the most recent updates to the scheduled proceedings in the related district court litigation. Patent Owner is authorized to file a 2-page sur-reply.

ORDER

Accordingly, it is:

ORDERED that Petitioner's request to file a reply to Patent Owner's Preliminary Response is granted, due no later than three business days from the date of this Order;

FURTHER ORDERED that Petitioner's reply is limited to 3 pages and must address only whether the Board should exercise discretion to deny the petitions based on the anticipated completion of the proceedings in the related district court litigation; and

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply due no later than three business days from the date of Petitioner's reply.

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