

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOLBY LABORATORIES, INC.,
Petitioner,

v.

INTERTRUST TECHNOLOGIES CORPORATION,
Patent Owner.

IPR2020-00660 (Patent 6,785,815 B2)
IPR2020-00661 (Patent 8,191,158 B2)
IPR2020-00662 (Patent 6,640,304 B2)

Before MICHAEL R. ZECHER, KIMBERLY McGRAW, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

ORDER

Conduct of the Proceedings

*Authorizing Petitioner to File Reply Brief to Patent Owner Preliminary
Response and Authorizing Patent Owner to File Sur-Reply Brief
37 C.F.R. § 42.5(a)*

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On July 28, 2020, Petitioner sent an email to the Board requesting authorization to file a 10 page reply brief to address the “*Finitiv*” factors outlined in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv*”). *See* Ex. 3001, 1–2. Petitioner also stated it was unwilling to agree to Patent Owner’s request to file a 10 page sur-reply “given the significant briefing already provided on this topic from the Patent Owner” in the already filed Patent Owner Preliminary Responses. *See id.*

On July 29, 2020, Patent Owner sent an email to the Board stating that it does not oppose Petitioner’s request so long as Patent Owner is authorized to file a 10 page sur-reply to respond to arguments and evidence raised in Petitioner’s reply. *See id.* at 1.

Fintiv identifies a non-exclusive list of factors parties may consider addressing when considering whether a related, parallel district court case provides any basis for discretionary denial under *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”), as well as a number of other cases dealing with discretionary denial under § 314(a). *Fintiv* at 5–16. Those factors include the following:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

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6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 5–6.

It is appropriate to provide Petitioner an opportunity to address the *Fintiv* factors, which issued after Petitioner filed its petitions. We therefore authorize Petitioner to file a 10-page Reply narrowly tailored to address the *Fintiv* factors. We recognize Patent Owner already was able to address the *Fintiv* factors in its Preliminary Responses and, thus, has provided some briefing on this issue. Nonetheless, it is also appropriate to provide Patent Owner the opportunity to respond to specific arguments presented by Petitioner in its Reply. We therefore authorize Patent Owner to file a 10-page Sur-reply.

In the briefing, the parties are requested, specifically, to address *Fintiv* factor 5 (i.e., whether the petitioner and defendant in the parallel proceeding are the same party) with respect to the Texas district court litigations.

Additionally, until we issue our decisions on whether to institute trial in the above-identified proceedings, we instruct the parties to notify the Board of any order in any of the parallel proceedings that significantly impacts the litigation schedule in the parallel proceedings. The parties must jointly file such notice in each above-identified proceedings within three business days of the issuance of the order.

Accordingly, it is:

ORDERED that Petitioner's request for leave to file a reply is *granted*;

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FURTHER ORDERED that Patent Owner's request to file a sur-reply is *granted*;

FURTHER ORDERED that the reply shall be filed within seven calendar days of this Order, the sur-reply shall be filed within seven days thereafter, and neither the reply nor the sur-reply shall exceed 10 pages.

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