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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

IPR2020-00719 (Patent 8,739,241 B1)
IPR2020-00720 (Patent 8,601,528 B1)
IPR2020-00722 (Patent 7,747,217 B1)
IPR2020-00723 (Patent 7,747,217 B1)
IPR2020-00724 (Patent 7,769,344 B1)

Before GEORGIANNA W. BRADEN, JON M. JURGOVAN, and JOHN F. HORVATH, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

On March 21, 2020, Google, LLC ("Petitioner") filed Petitions in IPR2020-00719, IPR2020-00720, IPR2020-00722, IPR2020-00723 and IPR2020-00724 for *inter partes* reviews of U.S. Patent Nos. 8,739,241 B1, 8,601,528 B1, 7,747,217 B1, 7,747,217 B1, and 7,769,344 B1, respectively. Personalized Media Communications, LLC ("Patent Owner") filed Preliminary Responses to the Petitions in each case. By email communication dated July 27, 2020 (Ex. 3002), Petitioner requested authorization to file a reply as permitted under 37 C.F.R. §§ 42.23, 42.24(c), and 42.108(c). Patent Owner does not oppose Petitioner's request, but if granted, requests authorization to file a sur-reply. *See* Consolidated Trial Practice Guide November 2019 ("TPG") at 38, 73–75.

II. DISCUSSION

"A petitioner may seek leave to file a reply to a preliminary response in accordance with §§ 42.23 and 42.24(c)." 37 C.F.R. § 42.108(c). "Any such request must make a showing of good cause." *Id.*

We find "good cause" exists for Petitioner to file a reply to address the *Apple v. Fintiv* factors in each case. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (PTAB March 20, 2020) (precedential, designated May 5, 2020). In addition, we find good cause exists to permit Petitioner to reply to Patent Owner's "swearing behind" arguments, and claim construction arguments relating to the "coordinating . . . based on" claim limitation.

Specifically, good cause exists to brief the *Apple v. Fintiv* factors because those factors were first set forth *one day before* the Petition was filed, and the decision setting them forth was designated as precedential only *after* the Petitions were filed. Good cause exists to allow Petitioner to reply to Patent Owner's "swearing behind" arguments in IPR2020-00722 and IPR2020-00723 because Patent Owner has challenged the availability of Campbell[1] and Thonnart[2] as prior art, and it is in the interests of justice to provide Petitioner with the opportunity to rebut Patent Owner's evidence of earlier conception and diligent reduction-to-practice. Finally, good cause exists to allow Petitioner to reply to Patent Owner's constructions of "coordinating . . . based on" in IPR2020-00722 and IPR2020-00723 because neither party had identified that term as a term requiring express construction in the joint claim construction chart the parties filed in the related District Court proceeding. *See* Ex. 1109, 21–63. Therefore, Petitioner could not reasonably have foreseen that Patent Owner would determine that term requires express construction in these proceedings.

Numerous briefings and exhibits have been filed in these cases, so we find it necessary to further limit page counts beyond the normal limits that would apply in these cases. *See* 37 C.F.R. § 42.24. Specifically, any replies and sur-replies filed in these cases shall be limited to three pages to address the *Apple v. Fintiv* factors, three pages to address the "swearing behind"

[1] WO 81/02961.
[2] U.S. Patent No. 4,413,281.

arguments, and two pages to address the claim construction arguments relating to the "coordinating. . . based on" claim limitation.

In addition, given the impending deadlines for decisions on institution of *inter partes* reviews, we find it necessary to require any replies to be filed within ten calendar days of this order, i.e., by August 7, 2020, and any sur-replies to be filed within ten days after the due date for the replies, i.e., by August 17, 2020.

ORDER

It is ORDERED that Petitioner's requests to file replies, and Patent Owner's requests to file sur-replies, in each proceeding are *granted* subject to the page length and timing restrictions indicated.

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