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**From:** Trials  
**Sent:** Monday, October 15, 2018 5:06 PM  
**To:** Walter D. Davis  
**Cc:** Chris Ponder; Harper Batts; Wayne M. Helge; Aldo Noto; LegalTM-Fitbit-BB-IPRs@sheppardmullin.com; mcutler@hdp.com; drobinson@hdp.com  
**Subject:** RE: IPR2017-02012: Request for sur-reply

**Follow Up Flag:** Follow up  
**Flag Status:** Flagged

Patent Owner is authorized to file a sur-reply in IPR2017-02012 in accordance with the PTAB Trial Practice Guide Update (August 2018). This sur-reply is limited to 10 pages and must be filed by October 25th. Patent Owner's attention is directed to the PTAB Trial Practice Guide Update (August 2018) and particularly the portion that discusses the content of sur-replies including:

The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. As noted above, a sur-reply may address the institution decision if necessary to respond to the petitioner's reply.

Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23, except as noted above. To the extent that a reply or sur-reply "responds" to the institution decision as discussed above, "respond," in the context of § 42.23(b), does not mean embark in a new direction with a new approach as compared to positions taken in a prior filing.

(Trial Practice Guide Update (August 2018) 14–15).

Regards,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

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**From:** Walter D. Davis <wdavis@davidsonberquist.com>  
**Sent:** Thursday, October 11, 2018 4:23 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** Chris Ponder <CPonder@sheppardmullin.com>; Harper Batts <HBatts@sheppardmullin.com>; Wayne M. Helge <whelge@davidsonberquist.com>; Aldo Noto <anoto@davidsonberquist.com>; LegalTM-Fitbit-BB-IPRs@sheppardmullin.com; mcutler@hdp.com; drobinson@hdp.com  
**Subject:** IPR2017-02012: Request for sur-reply

To the Board,

Patent Owner received Petitioners' reply in the subject case on September 28, 2018, and no motion to amend has been filed. Due Date 4 currently is set for October 19, 2018.

Patent Owner respectfully seeks guidance on whether the Board will allow Patent Owner to file a sur-reply in the subject case on Due Date 4, to respond to arguments made in Petitioners' reply, in accordance with the 2018 Revised Trial Practice Guide.

Patent Owner requests that a sur-reply be permitted consistent with page 14 of the 2018 Revised Trial Practice Guide:

Sur-replies to principal briefs (i.e., to a reply to a patent owner response or to a reply to an opposition to a motion to amend) normally will be authorized by the scheduling order entered at institution. The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. As noted above, a sur-reply may address the institution decision if necessary to respond to the petitioner's reply. This sur-reply practice essentially replaces the previous practice of filing observations on cross-examination testimony.

Prior to sending this email, Patent Owner contacted Petitioners, who stated their position as follows:

Fitbit's position is that Blackbird has failed to explain why it needs a Sur-Reply in this proceeding. Fitbit did not submit an Expert Declaration with its Reply Brief, and secondary considerations are not at issue in this proceeding. When requested, Blackbird failed to identify any specific issue or argument from the Reply that would require a Sur-Reply. In the event that the Board is inclined to permit a Sur-Reply, Fitbit believes a word limit of no more than 3,500 words would be appropriate given no Reply Expert Declaration was submitted and secondary considerations are not an issue here.

Respectfully,

Walter Davis  
Counsel for Patent Owner

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