

**From:** [Trials](#)  
**To:** [Trials](#); [Walter D. Davis](#)  
**Cc:** [Doshi, Dipu](#); [Wood, Megan](#); [Wayne M. Helge](#); [Aldo Noto](#); [TomTom Blackbird](#)  
**Subject:** RE: IPR2017-02023: Request for sur-reply  
**Date:** Tuesday, October 16, 2018 5:01:41 PM

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Counsel,

I apologize, this e-mail was cut off, a apologize for any confusion. The full message is:

Patent Owner is authorized to file a sur-reply in IPR2017-02023 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,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
Direct: 571-272-5366

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**From:** Trials  
**Sent:** Tuesday, October 16, 2018 3:02 PM  
**To:** Walter D. Davis <[wdavis@davidsonberquist.com](mailto:wdavis@davidsonberquist.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Doshi, Dipu <[DDoshi@blankrome.com](mailto:DDoshi@blankrome.com)>; Wood, Megan <[MWood@blankrome.com](mailto:MWood@blankrome.com)>; Wayne M. Helge <[whelge@davidsonberquist.com](mailto:whelge@davidsonberquist.com)>; Aldo Noto <[anoto@davidsonberquist.com](mailto:anoto@davidsonberquist.com)>; TomTom Blackbird <[TomTom.Blackbird@BlankRome.com](mailto:TomTom.Blackbird@BlankRome.com)>  
**Subject:** RE: IPR2017-02023: Request for sur-reply

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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.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
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**From:** Walter D. Davis <[wdavis@dauidsonberquist.com](mailto:wdavis@dauidsonberquist.com)>

**Sent:** Thursday, October 11, 2018 4:05 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Doshi, Dipu <[DDoshi@blankrome.com](mailto:DDoshi@blankrome.com)>; Wood, Megan <[MWood@blankrome.com](mailto:MWood@blankrome.com)>; Wayne M. Helge <[whelge@dauidsonberquist.com](mailto:whelge@dauidsonberquist.com)>; Aldo Noto <[anoto@dauidsonberquist.com](mailto:anoto@dauidsonberquist.com)>; TomTom Blackbird <[TomTom.Blackbird@BlankRome.com](mailto:TomTom.Blackbird@BlankRome.com)>

**Subject:** IPR2017-02023: Request for sur-reply

To the Board,

Patent Owner received Petitioner’s reply in the subject case on October 5, 2018, and no motion to amend has been filed. Due Date 4 currently is set for October 26, 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 Petitioner’s 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 Petitioner, who stated its position as follows:

Petitioner opposes Patent Owner's request because it has not articulated any appropriate reason for authorizing a sur-reply. Petitioner's reply does not include any new evidence or expert testimony through a second declaration that could warrant a sur-reply. To the extent that the Board authorizes Patent Owner's request, Petitioner believes it should be limited in length (for example, no more than 3000 words).

Respectfully,

Walter Davis  
Counsel for Patent Owner

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