

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIOT GAMES, INC.
Petitioner,

v.

PALTALK HOLDINGS, INC.,
Patent Owner.

Cases IPR2018-00129 & IPR2018-00130
(Patent 5,822,523)
Cases IPR2018-00131 & IPR2018-00132
(Patent 6,226,686 B1)¹

Before KARL D. EASTHOM, THU A. DANG, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Granting Authorization to File Preliminary Reply and Sur-Reply
37 C.F.R. § 42.108(c)

¹ This Order will be filed in each case based on the common issues argued. The parties must seek prior authorization to employ this joint heading and filing style.

Cases IPR2018-00129 & IPR2018-00130 (Patent 5,822,523)
Cases IPR2018-00131 & IPR2018-00132 (Patent 6,226,686 B1)

I. INTRODUCTION

On March 26, 2018, Judges Easthom, Dang, and Fitzpatrick held a teleconference with Scott M. Border and Samuel A. Dillon, counsel for Riot Games, Inc. (“Petitioner”), and Gregory M. Howison, Keith D. Harden, and Brian D. Walker, counsel for Paltalk Holdings, Inc. (“Patent Owner”). Petitioner requested the teleconference via email to seek leave to file a reply to respond to Patent Owner’s claim constructions of three terms (“aggregated message,” “aggregated payload,” and “payload portion”), which Patent Owner construed in its Preliminary Response (Paper 6).²

II. ANALYSIS

During the teleconference, Petitioner contended that good cause exists for Petitioner to file a Preliminary Reply because Patent Owner construed the above three terms in its Preliminary Response in a different manner than Patent Owner construed them in prior district court litigation. Patent Owner did not dispute Petitioner’s characterization of a shift in its claim constructions of the three terms. Rather, Patent Owner argued that the Petition (Paper 1) should have provided a construction for the three claim terms in any event, noting also that the Petition states that the “precise scope” of any claim term “is irrelevant to this proceeding.” *See* Pet. 6.

The Petition generally implies the claim terms should be construed “under any interpretation consistent with their plain and ordinary meaning in the context of the [challenged patent].”³ Accordingly, where Patent Owner shifted its stance from claim constructions advanced in prior litigation,

² Citations refer to IPR2018-00129, but the parties filed similar papers in each proceeding.

³ Both patents expired and include a common specification.

Cases IPR2018-00129 & IPR2018-00130 (Patent 5,822,523)

Cases IPR2018-00131 & IPR2018-00132 (Patent 6,226,686 B1)

Petitioner shows good cause to file a Preliminary Reply not to exceed five pages on or before March 30, 2018.

During the teleconference, Patent Owner expressed a concern that a Preliminary Reply effectively would grant Petitioner extra pages to its Petition and also expressed the related concern that the Preliminary Reply may raise new issues. Petitioner's email indicates it "seeks to reply to Patent Owner's construction and application of the claim terms" noted above, and Petitioner made a similar request during the teleconference.

Nevertheless, Petitioner did not show good cause to file briefing to reply to the "application of the claim terms." Therefore, Petitioner must confine its Preliminary Reply to the claim construction of the three terms above (i.e., Petitioner must not address the application of the claim constructions to the asserted prior art). This confinement to claim construction should ameliorate Patent Owner's stated concern regarding surprise and a sufficient number of pages to respond to the Preliminary Reply. Accordingly, sufficient cause exists for Patent Owner to file a Preliminary Sur-Reply (which responds to the Preliminary Reply) not to exceed five pages due on or before April 6, 2018.

Cases IPR2018-00129 & IPR2018-00130 (Patent 5,822,523)
Cases IPR2018-00131 & IPR2018-00132 (Patent 6,226,686 B1)

III. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Petitioner's request for authorization to file a
Preliminary Reply, not to exceed five pages, and due on or before March 30,
2018, is *granted* as outlined above, and

FURTHER ORDERED that, in response to the Preliminary Reply,
Patent Owner is authorized to file a Preliminary Sur-Reply not to exceed
five pages, due on or before April 6, 2018.

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