

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELITE PERFORMANCE FOOTWEAR, LLC,
Petitioner,

v.

REEBOK INTERNATIONAL LIMITED,
Patent Owner.

IPR2018-00354 (Patent 8,641,525 B2)
IPR2018-00355 (Patent 9,352,229 B2)
IPR2018-00356 (Patent 9,089,770 B2)¹

Before PHILLIP J. KAUFFMAN and MEREDITH C. PETRAVICK,
Administrative Patent Judges.

PETRAVICK, *Administrative Patent Judge.*

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

¹ This Order addresses the same or similar issue in the proceedings listed above. We issue one Order to be filed in each proceeding. The parties are not authorized to use this style of filing.

IPR2018-00354 (Patent 8,641,525 B2)

IPR2018-00355 (Patent 9,352,229 B2)

IPR2018-00356 (Patent 9,089,770 B2)

A conference call was held on April 11, 2018 between counsel for the parties and Judges Kauffman and Petravick. Petitioner requested the call to seek authorization to file replies to the Patent Owner's Preliminary Responses. In particular, Petitioner seeks to file replies to address Patent Owner's arguments concerning 35 U.S.C. § 314(a) and/or the claim construction of "inherently resilient and flexible." Patent Owner opposed the request.

For IPR2018-00354 and IPR2018-00356, Petitioner seeks to respond to Patent Owner's arguments concerning § 314(a) and applying the factors set forth in *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, (PTAB Sept. 6, 2017) (Paper 19) (precedential-in-part). The Petitions were filed after entry and precedential designation of the Board's decision in *General Plastic*. *General Plastic* sets forth a non-exhaustive list of factors considered by the Board when evaluating whether to exercise discretion to deny a petition under § 314(a) when the petition challenges a patent that was the subject of one or more earlier petitions. The patent at issue in IPR2018-00354 was at issue in earlier proceedings, IPR2016-00948 and IPR2017-00136, and the patent at issue in IPR2018-00356 is at issue in earlier proceedings, IPR2016-00949 and IPR2017-00137.

Petitioner argued that it could not have foreseen that Patent Owner would raise § 314(a) because the circumstances here are unlike circumstances of other proceedings in which petitions were denied based upon an application of the *General Plastic* factors. Petitioner here was not a party to any of IPR2016-00948, IPR2016-00949, IPR2017-00136, and

IPR2018-00354 (Patent 8,641,525 B2)
IPR2018-00355 (Patent 9,352,229 B2)
IPR2018-00356 (Patent 9,089,770 B2)

IPR2017-00137, and was not a party to the related district court proceeding when the earlier petitions were filed. Petitioner pointed to *Pfizer, Inc. v. Biogen, Inc.*, Case IPR2018-00176, (PTAB Apr. 4, 2018) (Paper 11) as an example of the Board granting a request to file a reply under similar circumstances.

Patent Owner responded that Petitioner should have foreseen that Patent Owner would raise § 314(a) and *General Plastic*. Patent Owner pointed to *Instrumentation Lab. Co. v. Hemosonics LLC*, Case IPR2018-00264, (PTAB Mar. 9, 2018) (Paper 7), as an example of the Board denying a request to file a reply after *General Plastic*.

Based on the information received during the call, we determine that Petitioner has shown good cause to file a reply to respond to Patent Owner's arguments concerning § 314(a). *See* 37 C.F.R. § 42.108(c) (providing that a petitioner may seek leave to file a reply to the preliminary response for good cause). Like in *Pfizer*, Petitioner was not a party to the earlier proceedings and was not a party to the related district court proceedings when earlier petitions were filed. Given these circumstances, we are persuaded that Petitioner could not have reasonably foreseen the need to address § 314(a) and the *General Plastic* factors in the Petitions. Further, information provided by both parties indicates that a reply would be helpful to the Board, for example, in evaluating the timing of certain events cited in Patent Owner's arguments.

We are not persuaded by Patent Owner that the circumstances here are sufficiently similar to the circumstances in *Instrumentation Lab. Co.* such that Petitioner's request should be denied. In *Instrumentation Lab. Co.*, the

IPR2018-00354 (Patent 8,641,525 B2)
IPR2018-00355 (Patent 9,352,229 B2)
IPR2018-00356 (Patent 9,089,770 B2)

petitioner was a party to the earlier proceeding and admitted that its choice not to address the *General Plastic* factors in its petition “was a strategic decision based on, *inter alia*, timing issues and space considerations.”
Instrumentation Lab. Co., Paper 7, 3.

For IPR2018-00354 and IPR2018-00355, Petitioner seeks to respond to Patent Owner’s arguments concerning the construction of “inherently resilient and flexible.” Patent Owner acknowledged that it was aware of the Board’s construction in earlier proceedings, and that the Petitions do not include an explicit construction of “inherently resilient and flexible.” Petitioner, however, alleges that the Patent Owner’s Preliminary Response applies a construction that varies slightly from that of earlier proceedings. Petitioner alleges that the Patent Owner’s Preliminary Response applies a construction from the Institution Decision of related proceeding, IPR2017-01928. IPR2017-01928’s Institution Decision was entered on February 8, 2018, after the filing of the Petitions here. Petitioner requested authorization to address the allegedly inconsistent construction of “inherently resilient and flexible.”

Patent Owner responded that Patent Owner should have included its arguments in the Petition, given earlier proceedings.

Based on the information received during the call, we determine that Petitioner has shown good cause to file a reply to address the allegedly inconsistent construction of “inherently resilient and flexible” between the Patent Owner’s Preliminary Response and earlier proceedings. *See* 37 C.F.R. § 42.108(c). The Institution Decision of related IPR2017-01928 was not entered until after the filing of the Petitions here.

IPR2018-00354 (Patent 8,641,525 B2)
IPR2018-00355 (Patent 9,352,229 B2)
IPR2018-00356 (Patent 9,089,770 B2)

It is:

ORDERED that, in IPR2018-00354, Petitioner may file a reply to the Patent Owner's Preliminary Response, limited to 2000 words, no later than April 24, 2018; the reply is limited to responding to Patent Owner's arguments concerning 35 U.S.C. § 314(a) and the construction of "inherently resilient and flexible;"

FURTHER ORDERED that, in IPR2018-00355, Petitioner may file a reply to the Patent Owner's Preliminary Response, limited to 1000 words, no later than April 24, 2018; the reply is limited to addressing Patent Owner's the construction of "inherently resilient and flexible;" and

FURTHER ORDERED that, in IPR2018-00356, Petitioner may file a reply to the Patent Owner's Preliminary Response, limited to 1000 words, no later than April 24, 2018; the reply is limited to addressing Patent Owner's arguments concerning 35 U.S.C. § 314(a).

PETITIONER:

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