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Paper No. 8
Entered: September 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN SILVER STAR INTELLIGENT TECHNOLOGY CO., LTD.,
Petitioner,

v.

IROBOT CORP.,
Patent Owner.

Case IPR2018-00761 (Patent 7,155,308)
Case IPR2018-00880 (Patent 8,474,090)
Case IPR2018-00882 (Patent 9,038,233)
Case IPR2018-00897 (Patent 6,809,490)
Case IPR2018-00898 (Patent 8,600,553)

Before WILLIAM V. SAINDON, TERRENCE W. MCMILLIN, and AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

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On Friday, September 7, 2018, counsel for Petitioner contacted the Board, seeking authorization to file Replies to Patent Owner's Preliminary Responses in these proceedings, to address Patent Owner's arguments regarding 35 U.S.C. §§ 314(a) and 325(d). On September 11, 2018, the panel requested that Petitioner confer with counsel for Patent Owner to identify mutually convenient times on September 12 or 13, 2018, for a teleconference with the Board. On September 13, 2018, counsel for Petitioner proposed times on September 18 or 19, 2018, for a teleconference.

A teleconference was conducted on September 18, 2018, between Administrative Patent Judges Saindon, McMillin, and Wieker; Petitioner's counsel, Hao Tan, Shen Wang, and Matthew Ridsdale; Petitioner's representative, Logan Xie; and Patent Owner's counsel, Walter Renner and Jeremy Monaldo. For the reasons discussed below, Petitioner's request for authorization to file Replies is *denied.*

DISCUSSION

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

During the teleconference, Judge Wieker asked Mr. Ridsdale to explain why "good cause" supported Petitioner's request. Mr. Ridsdale noted that, on September 5, 2018, this panel denied institution of *inter partes* review in IPR2018-00761 ("the –761 IPR"), based on 35 U.S.C. § 314(a). Mr. Ridsdale explained that additional facts support institution of the subject proceedings, and that Petitioner should be afforded an opportunity to discuss

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those facts in Reply papers. Counsel requested that it be authorized to file five-page Replies, to be filed in two weeks.

Judge Wieker inquired as to the exact relief sought by Petitioner in the –761 IPR, given that a Decision denying institution has already been entered. *See* –761 IPR, Paper 15 (Dec. on Inst.). Mr. Ridsdale acknowledged that a Request for Rehearing would be filed in that proceeding, rather than the requested Reply, given the posture of the proceeding. Regarding IPR2018-00880 ("the –880 IPR"), IPR2018-00882 ("the –882 IPR"), IPR2018-00897 ("the –897 IPR"), and IPR2018-00898 ("the –898 IPR"), Judge Wieker inquired as to why Petitioner had not addressed 35 U.S.C. §§ 314(a) or 325(d) in its original Petitions. Mr. Ridsdale responded that Petitioner had not anticipated that 35 U.S.C. § 314(a) would arise, because these are the first Petitions filed by this Petitioner.[1]

For Patent Owner, Mr. Monaldo opposed Petitioner's request. According to Mr. Monaldo, Petitioner has not demonstrated good cause. Additionally, Mr. Monaldo argued that this request comes too late, being

[1] In a precedential decision in *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, the Board articulated a non-exhaustive list of seven factors to be considered in evaluating whether to exercise discretion, under 35 U.S.C. § 314(a), to deny a petition that challenges a patent that was previously challenged before the Board. *Gen. Plastic*, Case IPR2017-01357, Paper 19 (PTAB Sept. 6, 2017) (Section II.B.4.i designated as precedential on Oct. 17, 2017), slip op. at 16. The first such factor considers "whether the same petitioner previously filed a petition directed to the same claims of the same patent." *Id.* at 16.

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filed months after Patent Owner's Preliminary Responses were filed, and coming only after the Board entered a decision unfavorable to Petitioner in the –761 IPR.

The panel discussed the parties' arguments and Judge Wieker reported the panel's decision to deny Petitioner's request for authorization to file a Reply in these proceedings, because Petitioner failed to demonstrate good cause. Judge Wieker explained that the panel considered Petitioner's argument that it did not address § 314(a) because it did not foresee it to be an issue. However, in these cases, Petitioner's failure to foresee the applicability of § 314(a) does not demonstrate good cause. As Petitioner acknowledges, Petitioner's co-respondent in an ITC investigation previously filed petitions against the challenged patents. *See, e.g.*, –761 IPR, Paper 10 (Corr. Pet.), 2 (identifying IPR2017-02078, filed by petitioner Shenzhen Zhiyi Technology Co., Ltd., on September 8, 2017). We recognize that the Petitions filed in the –761, –880, –882, –897, and –898 IPRs are the first Petitions filed by this Petitioner. *See, e.g.*, –761 IPR, Paper 15 (Dec. on Inst.), 9–10. Although this fact is relevant to the first of the seven factors articulated in *General Plastics*, it is not dispositive. *See, e.g.*, –761, Paper 14 (Prelim. Resp.), 15–16, 24–25 (discussing previous Board decisions denying institution under 35 U.S.C. § 314(a), when the subject petitions were the first petitions filed by those petitioners). Thus, in this circumstance, given the previous proceedings challenging the same patents, Petitioner should have been aware that 35 U.S.C. §§ 314(a) and/or 325(d) may be at issue in these proceedings.

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Additionally, the panel agrees with Patent Owner that Petitioner's request comes too late. As discussed above, the Board has already rendered a Decision in the –761 IPR. Moreover, in the –882 IPR, Petitioner received Patent Owner's Preliminary Response on July 11, 2018. –882 IPR, Paper 7 (Prelim. Resp.). However, Petitioner did not request an opportunity to respond until nearly two months later, after Petitioner received the Board's decision in the –761 IPR. –761 IPR, Paper 15 (Dec. on Inst.). The statutory deadline for the Board to issue its institution decision in the –882 IPR is October 11, 2018, just over three weeks from the date Petitioner proposed for this teleconference. Thus, in the subject cases, the timing of Petitioner's request is a factor in the Board's decision.

Accordingly, for the foregoing reasons, Petitioner's request for authorization to file Reply papers is *denied.*

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