

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

Case IPR2019-00819 (Patent 7,620,810 B2)
Case IPR2019-00820 (Patent 7,937,581 B2)¹

Before KAMRAN JIVANI, JOHN D. HAMANN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5(a); 42.108(c)

¹ This Order addresses an issue pertaining to the listed cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On July 22, 2019, Petitioner sent an email requesting a call to seek authorization to file a Reply to Patent Owner's Preliminary Response. On July 31, 2019, we held the call with Judges Jivani, Hamann, and Margolies and respective counsel for the parties. During the call, the parties presented arguments as to Petitioner's request. We were unpersuaded by Petitioner's arguments, and we denied Petitioner's request on the call. This Order memorializes our decision, and provides our reasoning.

Petitioner sought a Reply to address Patent Owner's alleged mischaracterizations of the asserted art and prosecution history made in the Preliminary Response in the context of § 325(d). Petitioner argued that it could not have anticipated these alleged mischaracterizations. Petitioner argued, for example, that it could not have anticipated that Patent Owner would characterize Murakawa (which was not before the Office) as being duplicative of Ahonen (which was before the Office). Patent Owner argued that Petitioner could have anticipated Patent Owner's arguments, and that Petitioner failed to show good cause to warrant a Reply.

In requesting a Reply to a Preliminary Response, a Petitioner must show good cause. 37 C.F.R. § 42.108(c). We found that Petitioner failed to show good cause. In particular, Petitioner failed to show that it could not have anticipated Patent Owner's arguments. For example, we find it foreseeable that Patent Owner would argue that new art (Murakawa) is duplicative of art (Ahonen) that was before the Office during prosecution, especially here where Petitioner asserts that Ishiyama (which also was before the Office), combined with Murakawa, renders challenged claims unpatentable. Furthermore, at this stage of the proceeding, we are able to

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determine whether the parties have properly characterized the asserted art and prosecution history without additional briefing.

Accordingly, we *deny* Petitioner's request.

It is hereby ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is denied.

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