

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00115
Patent 8,407,609 B2

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. §§ 42.5, 42.108(c)

Petitioner filed its Petition on October 31, 2019 (Paper 1), and Patent Owner filed its Preliminary Response on February 10, 2020 (Paper 6). On the evening of March 18, 2020, Petitioner requested a conference call to request permission to file a reply to Patent Owner's Preliminary Response.

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A conference call was held on March 19, 2020, and the participants included Judges Boudreau, Galligan, and Dirba and respective counsel for the parties.

Petitioner seeks leave to file a reply to address Patent Owner's argument that the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a). *See* Prelim. Resp. 10–13 (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential)). Petitioner contends that the record does not accurately reflect the relationship between a parallel district court litigation and the present *inter partes* review proceeding. Specifically, Petitioner submits that dependent claims 2 and 3 are not presently asserted in the district court litigation, and Petitioner argues that the schedule of the district court litigation is likely to be impacted by the present COVID-19 pandemic.

Patent Owner opposes Petitioner's request and argues Petitioner has not shown good cause. Patent Owner submits that Petitioner failed to address the district court litigation in its Petition, despite the fact that the pending district court case is nearing trial. Patent Owner contends that the arguments made in the Preliminary Response were reasonably foreseeable. With respect to COVID-19, Patent Owner argues that Petitioner is using the uncertainties of the situation to attempt to show good cause, and that the Board has been advised of the situation, so further briefing is unnecessary.

The rules governing *inter partes* review do not provide petitioners a right to file a reply to a preliminary response. *See* 37 C.F.R. § 42.108(c). Thus, the filing of a reply must be based on a showing of good cause. *Id.* We determine that Petitioner has not shown good cause.

The Board's Trial Practice Guide identifies considerations that will be taken into account by the Board in determining whether to exercise

discretion to decline to institute review. The July 2019 update to the Trial Practice Guide, available when the Petition was filed, states that “events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC” may favor discretionary denial, and it invites parties “to address in their submissions whether any other such reasons exist in their case . . . and whether and how such factors should be considered.” July 2019 Office Trial Practice Guide Update (“July 2019 TPG”), 25–26, available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>; see 84 Fed. Reg. 33,925 (July 16, 2019) (providing notice and link).¹ The July 2019 TPG cites to the Board’s precedential decision in *NHK Spring*, Paper 8 at 19–20, as an example.

Petitioner did not address the status of the parallel district court litigation in its Petition, and Patent Owner’s arguments relying on *NHK Spring* were reasonably foreseeable in view of the guidance provided by the July 2019 TPG several months before the Petition was filed. As a result, Petitioner does not show good cause to respond to these arguments or to address the parties’ respective positions in the district court litigation.

The COVID-19 pandemic itself was unforeseeable at the time the Petition was filed, but we are not persuaded that it provides Petitioner with good cause for its requested reply. Petitioner contends that COVID-19 is relevant because: (1) Patent Owner moved to extend discovery deadlines by two months in the district court litigation and (2) it is likely that the district

¹ The Trial Practice Guide has since been further updated; the current version also includes this guidance. Consolidated Trial Practice Guide (Nov. 2019), 58, available at <https://www.uspto.gov/TrialPracticeGuide/Consolidated>.

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court trial will be delayed. Thus, the salient question is not whether a reply is justified in light of COVID-19, but rather whether a reply is justified in light of these potential changes to the schedule. We determine that it is not. First, at this point, we can only speculate whether the schedule will change—indeed, Petitioner has opposed Patent Owner’s requested extension (which decreases the likelihood of a delay). Second, even if Patent Owner’s request results in a two month delay to the schedule, we do not perceive such a modest change to the schedule to be sufficiently material as to warrant a reply brief in this case.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s request to file a reply is *denied*.

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