

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2020-00407 (Patent 6,748,317 B2)
IPR2020-00408 (Patent 6,430,498 B1)
IPR2020-00409 (Patent 6,580,999 B2)¹

Before LYNNE E. PETTIGREW, MINN CHUNG, JOHN A. HUDALLA,
and JASON W. MELVIN, *Administrative Patent Judges*.²

PETTIGREW, *Administrative Patent Judge*.

ORDER

Authorizing Reply and Sur-reply
37 C.F.R. §§ 42.5(a), 42.20(d), 42.108(c)

¹ This order will be entered in each case. The parties are not authorized to use this caption.

² This is not an order from an expanded panel of the Board. Administrative Patent Judges comprising the three-judge panels in all three proceedings are listed.

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On May 27, 2020, a conference call was held among counsel for Apple Inc. (Petitioner), counsel for Maxell, Ltd. (Patent Owner), and Judges Pettigrew, Chung, and Melvin. This order memorializes the rulings made on the call. The purpose of the call was to address Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response in each of these proceedings. Petitioner seeks leave to address two issues in a reply: (1) the Board's discretion under 35 U.S.C. § 314(a), and (2) the public accessibility of the Abowd reference. We address these issues in turn.

Discretion Under 35 U.S.C. § 314(a)

Petitioner seeks a 10-page reply in each of these proceedings to address factors considered by the Board in determining whether to exercise its discretion to deny institution under 35 U.S.C. § 314(a) when there is a related, parallel district court action involving the challenged patent. These factors are set forth in a recent precedential Board order, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv*”). Petitioner also requests authorization for Patent Owner to file a 10-page sur-reply addressing the *Fintiv* factors. Patent Owner does not oppose Petitioner's request for supplemental briefing by the parties to address the *Fintiv* factors.

We authorize the requested supplemental briefing by the parties to address the *Fintiv* factors. The briefing may be accompanied by documentary evidence in support of any facts asserted in the supplemental briefing but may not be accompanied by declaratory evidence.

Public Accessibility of Abowd

In the Preliminary Response in each of these proceedings, Patent Owner argues that a “DO NOT CIRCULATE” stamp on the sleeve of a

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book containing a copy of Abowd, one of Petitioner's asserted references, indicates the reference was not publicly accessible. *See, e.g.*, IPR2020-00407, Paper 6 at 47 (citing Ex. 1009, 38 (Munford Decl.)). Petitioner seeks leave to file a one-page supplemental declaration from its library expert, Mr. Jacob Munford, addressing the meaning of the "DO NOT CIRCULATE" stamp. Petitioner also seeks leave to include one additional page in its reply directed to this issue.

Petitioner asserted on the conference call that Patent Owner's argument in the Preliminary Response was unforeseeable because the "DO NOT CIRCULATE" stamp has no bearing on the public accessibility of Abowd, and therefore Mr. Munford's Declaration (Ex. 1009) did not address the issue. Accordingly, Petitioner argued there is good cause to grant its request to address this issue in its reply. In response, Patent Owner argued, among other things, that Petitioner failed to meet its burden in the Petition to show with particularity that the reference was a publicly accessible printed publication.

After considering both parties' positions, we determine that good cause exists to authorize Petitioner's request for one additional page in its reply to respond to Patent Owner's argument regarding the "DO NOT CIRCULATE" stamp. *See* 37 C.F.R. § 42.108(c). We also authorize Petitioner to submit a one-page supplemental declaration from Mr. Munford directed to this narrow issue. *See* 37 C.F.R. § 42.5(a). Patent Owner is authorized to include one additional page in its sur-reply to respond to the arguments in Petitioner's reply.

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Accordingly, it is

ORDERED that Petitioner is authorized to file a reply to Patent Owner's Preliminary Response in each of these proceedings, due by June 4, 2020;

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply to Petitioner's reply in each of these proceedings, due by June 12, 2020;

FURTHER ORDERED that Petitioner's reply in each proceeding may include up to 10 pages addressing the *Fintiv* factors relating to discretionary denial under 35 U.S.C. § 314(a);

FURTHER ORDERED that Patent Owner's sur-reply in each proceeding may include up to 10 pages addressing the *Fintiv* factors;

FURTHER ORDERED that the reply and sur-reply in each proceeding may be accompanied by documentary evidence in support of any facts asserted with regard to the *Fintiv* factors;

FURTHER ORDERED that Petitioner's reply in each proceeding may include up to one page addressing the relevance of the "DO NOT CIRCULATE" stamp on the sleeve of a book containing a copy of the Abowd reference in Exhibit 1009, and Petitioner's reply may be accompanied by a one-page declaration from Mr. Munford addressing this issue; and

FURTHER ORDERED that Patent Owner's sur-reply in each proceeding may include up to one page responding to Petitioner's reply arguments and evidence on the relevance of the "DO NOT CIRCULATE" stamp.

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