

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

IPR2020-01139 (Patent 8,382,186 B2)
IPR2020-01142 (Patent 8,833,834 B2)¹

Before MITCHELL G. WEATHERLY, MICHAEL L. WOODS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

ORDER

Authorizing Reply to Preliminary Response by Petitioner
And Sur-reply by Patent Owner
37 C.F.R. § 42.20

¹ This Order applies to both proceedings. The parties are not authorized to use this heading without express permission from the Board.

IPR2020-01139 (Patent 8,382,186 B2)
IPR2020-01142 (Patent 8,833,834 B2)

BACKGROUND

The Board has not yet rendered a decision on whether to institute review in these proceedings.

On November 13, 2020, and at the panel's request, a conference call was held with the parties to discuss further briefing in *related* proceedings IPR2020-01139 and IPR2020-01142.

During the call, Petitioner requested permission to address arguments raised by Patent Owner in Patent Owner's preliminary response. In particular, Petitioner requested permission to address Patent Owner's 35 U.S.C. § 325(d) argument and Patent Owner's characterization of Yung (Ex. 1006).

Patent Owner opposed Petitioner's request, arguing that insufficient cause exists to permit additional briefing.

Having considered Petitioner's and Patent Owner's positions, we find that sufficient cause exists, and authorize Petitioner to file a reply brief to address Patent Owner's 35 U.S.C. § 325(d) argument and Patent Owner's characterization of Yung. 37 C.F.R. § 42.20(d). We also authorize Patent Owner to file a sur-reply brief.

IPR2020-01139 (Patent 8,382,186 B2)

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ORDER

Accordingly, it is hereby:

ORDERED that, in each proceeding, Petitioner is authorized to file a reply brief of no more than five (5) pages, if filed on or before November 20, 2020, to address Patent Owner's 35 U.S.C. § 325(d) argument and Patent Owner's characterization of Yung (Ex. 1006);

FURTHER ORDERED that, in each proceeding, Patent Owner may file a sur-reply brief of no more than five (5) pages, if filed on or before November 30, 2020, and if limited to arguments raised in the reply brief;

FURTHER ORDERED that neither party is authorized to file additional evidence with their respective briefs; and

FURTHER ORDERED that Petitioner shall seasonably file the transcript of the conference call as a paper in both proceedings when it becomes available.

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IPR2020-01142 (Patent 8,833,834 B2)

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