

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

FG SRC LLC,
Patent Owner.

Case No. IPR2020-01449
Patent 7,149,867

Before KALYAN K. DESHPANDE, GREGG I. ANDERSON, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

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

IPR2020-01449
Patent 7,149,867

On December 14, 2020, Petitioner requested authorization to file a 7-page Reply to Patent Owner's Preliminary Response to address the factors set out in *Apple v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2002), Patent Owner's testimonial evidence, and Patent Owner's arguments on secondary considerations of non-obviousness. Ex. 3002. Petitioner indicated that Patent Owner opposed the request, but if granted, requested to file a Sur-reply. *Id.*

On December 21, 2020, a conference call was held between respective counsel for the parties and Judges Szpondowski, Deshpande, and Anderson. During the call, Petitioner raised for the first time that Patent Owner filed its Preliminary Response late – on December 5, 2020, rather than on December 4, 2020. Petitioner indicated that it objects to the consideration of the late filing, but requested briefing if the Board considers Patent Owner's Preliminary Response. Specifically, Petitioner requested authorization to file a 7-page Reply, and identified four issues it seeks to address: (1) response to Patent Owner's arguments on the *Fintiv* factors; (2) response to certain arguments made by Patent Owner that certain references are not printed publications; (3) response to Patent Owner's characterization of the invention and the prior art; and (4) response to Patent Owner's arguments on secondary considerations. Petitioner argued that good cause is present either because Patent Owner's arguments could not have been anticipated, or intervening facts have occurred since the Petition was filed, such as changes in case law or schedule. Petitioner did not oppose a Sur-reply by Patent Owner.

Patent Owner opposed the Reply for several reasons. Patent Owner argued that: (1) Petitioner's request is inconsistent with its argument

IPR2020-01449
Patent 7,149,867

opposing Patent Owner's previous request for an extension of time to file its Preliminary Response due to the delay; (2) Petitioner is merely attempting to reargue arguments that could have been made in the Petition; and (3) Petitioner could have reasonably anticipated or foreseen the arguments that it now seeks to address. Patent Owner also expressed concern that Petitioner may file hundreds of pages of Declarations or additional evidence in connection with the Reply. Patent Owner requested to file a Sur-reply if Petitioner's request is authorized. With regard to the timeliness of the Preliminary Response, Patent Owner stated there were some issues that occurred during the filing that caused some of the papers, including the Preliminary Response, to be filed after midnight.

As an initial matter, we had extended Patent Owner's due date for its preliminary response to December 4, 2020. *See* 37 C.F.R. § 42.107(c); 37 C.F.R. § 42.5(c)(1). We acknowledge Patent Owner's good faith attempt to file its preliminary response on its due date, but incurred difficulties. Accordingly, we are going to consider Patent Owner's Preliminary Response.

We are persuaded that good cause justifies the filing of a reply directed to the four aforementioned issues. 37 C.F.R. § 42.108(c). Accordingly, we authorize Petitioner to file a Reply to Patent Owner's Preliminary Response limited to addressing the four aforementioned issues that were identified during the conference. Petitioner is also authorized to submit additional evidence limited to the *Fintiv* issue. Petitioner's Reply is not to exceed seven (7) pages and must be filed on or before Monday, January 4, 2020.

IPR2020-01449
Patent 7,149,867

We, likewise, authorize Patent Owner to file, on or before Wednesday, January 13, 2020, a Sur-reply addressing the arguments advanced by Petitioner in the Reply. Patent Owner's Sur-reply is not to exceed seven (7) pages and Patent Owner is not authorized to file additional evidence with the Sur-reply.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that Petitioner's Reply is limited to the four issues listed above; that Petitioner is authorized to file additional evidence limited to the *Fintiv* issue; that Petitioner's Reply is not to exceed seven (7) pages; and that Petitioner's Reply shall be filed on or before January 4, 2020; and

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply to Petitioner's Reply that is limited to responding to arguments Petitioner raises in its Reply; that Patent Owner's Sur-reply is not to exceed seven (7) pages; that Patent Owner is not authorized to file additional evidence; and that Patent Owner's Sur-reply shall be filed on or before January 13, 2020.

IPR2020-01449
Patent 7,149,867

For PETITIONER:

Brian Nash
Evan Finkel
Matthew Hindman
PILLSBURY WINTHROP SHAW PITTMAN LLP
Brian.nash@pillsburylaw.com
Evan.finkel@pillsburylaw.com
Matthew.hindman@pillsburylaw.com

For PATENT OWNER:

Jay Kesan
DiMURO GINSBERG PC
jay@jaykesan.com

Ari Rafilson
SHORE CHAN DEPUMPO LLP
arafilson@shorechan.com