

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01153
Patent 11,122,357 B2

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, and
JASON M. REPKO, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

ORDER
Denying Leave to File Reply to Preliminary Response
37 C.F.R. § 42.108(c)

On November 17, 2023, Sony Electronics (“Petitioner”) contacted the Board via email to seek leave to file a three-page Reply to Patent Owner’s Preliminary Response under 37 C.F.R. § 42.108(c). Ex. 3001. The same email indicates that Jawbone Innovations, LLC. (“Patent Owner”) opposed Petitioner’s request. *Id.*

According to Petitioner’s request,

Patent Owner Jawbone Innovations, LLC (“Jawbone”) has used its POPR, in part, to respond to the Board’s comment in an earlier Amazon v. Jawbone IPR (involving the same patent claims and prior art) that Figure 5.2 of Brandstein and Sony’s declarant’s explanation established disclosure of the limitation calling for “distinct virtual directional microphones with substantially similar responses to noise and substantially dissimilar responses to speech.” (IPR2023-00251, Paper No. 7 at 19.) The POPR in the present case includes extensive discussions mischaracterizing Sony’s petition, Brandstein, the accompanying declaration discussing Brandstein’s disclosure and other issues relating to the Board’s comment. (Paper No. 8, at 8-18.) As a matter of fundamental fairness, Sony requests that it be given the opportunity to respond briefly to those discussions prior to a decision on institution, given that Jawbone has already had the opportunity to do so. Sony thus maintains that good cause exists for a reply.

Id.

Petitioner’s request is denied. Although Petitioner points to Patent Owner’s alleged mischaracterizations (*id.*), it may always be the case that a Petitioner disagrees with how Patent Owner characterizes the facts and law presented in the Petition. Our rules, however, provide for a Petitioner’s Reply only when good cause exists. 37 C.F.R. § 42.108(c). We see no good cause here. The issues that Petitioner identifies in its request are related to the teachings and disclosures of the cited prior art and the relevant case law

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that could have been — but were not — addressed in the petition. *See id.* For example, the Board’s comments and discussion in the previous institution decision cited in Petitioner’s request were limited to those prior-art disclosures, rather than a new or unforeseeable issue. *Id.* Because of the expedited nature this proceeding, Petitioner is generally expected to make its case for institution in the Petition. Here, the Board does not need further briefing to assess the Petition’s arguments and evidence.

ORDER

It is

ORDERED that Petitioner’s request for leave to file a Reply to Patent Owner’s Preliminary Response under 37 C.F.R. § 42.108(c) is *denied*.

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