

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

CONSTELLATION DESIGNS, LLC,
Patent Owner.

IPR2023-00228, Patent 10,693,700 B2
IPR2023-00229, Patent 11,019,509 B2
IPR2023-00319, Patent 10,693,700 B2
IPR2023-00320, Patent 11,019,509 B2¹

Before MIRIAM L. QUINN and MICHAEL T. CYGAN,
Administrative Patent Judges.

CYGAN, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Motion for Reply to Patent Owner's Preliminary
Response

37 C.F.R. § 42.108(c)

¹ The parties are not authorized to use this caption format.

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On May 30, 2023, Petitioner requested, via email, authorization to file in each case a Reply to Patent Owner's Preliminary Response, filed on April 17, 2013. Ex. 3001. Patent Owner supplied objections to this request. *Id.* On June 1, 2023, we held a conference call to permit Petitioner to argue in favor of such authorization, and for Patent Owner to set forth its objections. After hearing both parties, we determined that good cause for further briefing had not been shown, and informed the parties of that determination. This Order memorializes that determination, and further sets forth the reasons for denial of Petitioner's request.

We begin with Petitioner's arguments for IPR2023-00228 and IPR2023-00229. Petitioner argues that good cause for additional briefing in IPR2023-00228 exists because Petitioner "could not have reasonably anticipated that Patent Owner would rely on testimony of Dr. Guillen i Fabregas that is inconsistent with the DeGaudenzi reference." Ex. 3001. Similarly, Petitioner argues that good cause for additional briefing in IPR2023-00229 exists because Petitioner "could not have reasonably anticipated that Patent Owner would rely on testimony of Dr. Bauch that is inconsistent with Dr. Bauch's other paper (Ex2017) introduced by Patent Owner." *Id.* Petitioner argues that such additional briefing would assist the Board in evaluating the "merits of the arguments and evidence presented by both sides." During the conference, Petitioner clarified that no further exhibits were sought to be entered through the additional briefing. Further, Petitioner clarified that its proposed briefing would address arguments that the Bauch testimony was inconsistent with the entirety of the record, and is not limited to comparison of that testimony with Exhibit 2017.

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Patent Owner argued that for a showing of good cause, it is not sufficient that Petitioner could not have anticipated the particular testimony or declarant used to support a Preliminary Response, because that would always be true in every case in which a Preliminary Response is supported by evidence. Patent Owner further argued that, because the Board has the underlying exhibits, the Board “can easily discern” the veracity of the testimony. Ex. 3001. Patent Owner argues that mere allegations of “mischaracterization” have been found insufficient to show sufficient cause for additional briefing. *Id.* (citing *Dell Inc. v. Neo Wireless LLC*, IPR2021-01468, Paper 10, 3 (Jan. 27, 2022) (“The Board routinely determines whether a party mischaracterizes the asserted references or the other party’s arguments without the need for additional briefing.”)).

Based upon the arguments presented by the parties, we determine that Petitioner has not shown good cause for additional briefing for IPR2023-00228 and IPR2023-00229. Petitioner’s arguments focus on a perceived discrepancy between the testimony of Drs. Bauch and Fabregas and Petitioner’s characterization of the record. The decision whether to institute trial will determine whether such testimony is supported by the record, and whether Petitioner’s characterization is supported by the record. We note that the disputed documents are not unreasonably long so as to require further guideposts. *See* IPR2023-00228, Ex. 2002 (Fabregas Declaration, 16 pages); IPR2023-00229, Exs. 2002 (Bauch Declaration, 21 pages), 2017 (6 pages). To the extent that any discrepancy exists, such will be apparent from the record. We further note that because Petitioner’s request for additional briefing was filed over a month after the Preliminary Response, limited time

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for additional briefing remains before the decision on institution is due. Although Petitioner argues that its briefing would assist the Board in its evaluation of the testimony, such assistance does not provide good cause for additional substantive briefing at this time.

With respect to IPR2023-00319 and IPR2023-00320, Petitioner argues that good cause for additional briefing exists “because it was not possible for Petitioner to foresee how Patent Owner would mischaracterize the 777 Patent disclosure (particularly 12:11-37) and to address Patent Owner’s conflation of the obviousness and written description requirements.” Ex. 3001. During the conference, Petitioner pointed to certain annotations to Figures that had been made in the Preliminary Response. Petitioner admitted that such annotations were clearly marked and that Petitioner was not alleging that the Board would be confused as to which portions of the Figures were added by Patent Owner.

Patent Owner argued that Petitioner has “ample opportunity to provide its characterization of the challenged patents’ disclosure,” and pointed to “22 pages of each Petition” in which Petitioner characterized the challenged patents. Patent Owner argued that in light of the treatment in the Petition and the presence of the underlying exhibits in the record, no further briefing is required.

Based upon the arguments presented by the parties, we determine that Petitioner has not shown good cause for additional briefing for IPR2023-00319 and IPR2023-00320. Petitioner seeks only to correct alleged “mischaracterizations” of the disclosure of the challenged patents, and alleged conflation of written description and obviousness requirements.

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However, Petitioner's had the opportunity to present its arguments that the challenged claims were not entitled to an earlier priority date, including by characterizing the disclosure of the earlier documents in the priority chain, and took advantage of that opportunity through its lengthy analysis. *See* IPR2023-00320, Paper 3, 2–20. To the extent that Petitioner argues that Patent Owner mischaracterizes the disclosure of the '777 patent, which is an earlier document in the chain of priority of the '509 patent, both documents have been made of record such that the Board may evaluate their disclosures. To the extent that Petitioner argues that Patent Owner has conflated obviousness and written description requirements, the Board performs evaluation of arguments according to the applicable laws as a matter of its determination whether to institute trial. Although Petitioner argues that its briefing would assist the Board in its evaluation of the Patent Owner's arguments, such assistance does not provide good cause for additional substantive briefing at this time.

For the foregoing reasons, we determine that Petitioner has not shown good cause to authorize further briefing on the requested matters.

Consequently, it is

ORDERED that Petitioner's request for authorization is **denied**.

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