

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTON DOMESTIC OPERATING COMPANY, INC.,
Petitioner,

v.

R2 SOLUTIONS LLC,
Patent Owner.

IPR2023-00689
Patent 8,190,610 B2

Before ST. JOHN COURTENAY III, JOHN A. HUDALLA, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authorizing Additional Briefing
37 C.F.R. § 42.20(d)

In its Preliminary Response (Paper 9, “Prelim. Resp.”), Patent Owner puts forth arguments regarding discretionary denial under 35 U.S.C. § 325(d). Prelim. Resp. 60–66. In particular, Patent Owner cites the first part of the framework in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential), and argues that “[t]he prior art asserted by Petitioner is substantially the same as art previously presented to the Office.” Prelim. Resp. 61–65. To more fully develop the record, and because the panel feels it would be helpful, we authorize, *sua sponte*, additional briefing regarding Patent Owner’s arguments about the first part of the *Advanced Bionics* framework as set forth below. See 37 C.F.R. § 42.20(d) (“The Board may order briefing on any issue involved in the trial.”).

It is hereby

ORDERED that Petitioner is authorized to file a Preliminary Reply limited to addressing Patent Owner’s arguments regarding the first part of the *Advanced Bionics* framework;

FURTHER ORDERED that, if Petitioner files a Preliminary Reply, the Preliminary Reply is limited to three pages and shall be filed no later than August 9, 2023;

FURTHER ORDERED that Patent Owner is authorized to file a Preliminary Sur-reply limited to addressing the arguments in Petitioner’s Preliminary Reply;

FURTHER ORDERED that, if Patent Owner files a Preliminary Sur-reply, the Preliminary Sur-reply is limited to three pages and shall be filed no later than August 16, 2023;

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FURTHER ORDERED that any discussion regarding the second part of the *Advanced Bionics* framework is not authorized and may lead to a party's brief not being considered; and

FURTHER ORDERED that Petitioner and Patent Owner shall not file any additional evidence with their briefs.

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