

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDEN PARK ILLUMINATION, INC.,
LARSON ELECTRONICS LLC, FAR UV TECHNOLOGIES, INC., and
USHIO AMERICA, INC.,
Petitioner,

v.

S. EDWARD NEISTER,
Patent Owner.

IPR2023-00695
Patent 11,246,951 B2

Before JEFFREY W. ABRAHAM and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Leave to Submit Sur-reply Out of Time
37 C.F.R. § 42.5(c)

Patent Owner filed its Corrected Patent Owner Preliminary Response (Paper 11) on July 19, 2023. Petitioner sought leave to file a five-page reply in response to Patent Owner's argument for discretionary denial under 35 U.S.C. § 325(d), and did not oppose filing of a five-page sur-reply by Patent Owner, should the Board grant Petitioner's request. Ex. 3001. We granted both requests by e-mail on July 13 and authorized filing of supplemental briefs by Petitioner and Patent Owner on July 24 and August 2, respectively. *Id.* Petitioner timely filed its reply. Paper 12. Patent Owner did not file a sur-reply by August 2, and with our authorization, Patent Owner on August 14 filed a Motion for Leave to Submit Sur-reply Out of Time. Paper 13. Petitioner opposes. Paper 14.

Patent Owner argues good cause exists to permit late filing of its sur-reply because Patent Owner's counsel's failure to file the sur-reply on time was inadvertent. Paper 13. Mr. Ray, Patent Owner's counsel, submits a declaration stating that the Board's e-mail granting leave to file a sur-reply was not sent to his firm's docketing department, and Patent Owner's counsel did not calendar the filing deadline for the sur-reply. Ex. 2031 ¶ 2. Mr. Ray further states he was on a family trip overseas from July 26 to August 3. *Id.* ¶ 3.

The Board's rules excuse a late action only "on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." 37 C.F.R. § 42.5(c)(3). We determine that Patent Owner has not adequately satisfied either requirement. Patent Owner's counsel's inadvertence in not calendaring the sur-reply deadline does not constitute good cause. Further, Patent Owner does not explain why its

backup counsel, who was copied on the Board's e-mail, also failed to file a sur-reply or timely request an extension.

Petitioner's argument that Patent Owner's delay is prejudicial because it limits the Board's time to evaluate the Petition (*see* Paper 14, 2) is also persuasive. The Board's institution decision is due in less than one month, and if Patent Owner submitted its sur-reply at this late date, the Board would need to consider new information very close to the due date for the institution decision.

Patent Owner does not argue that filing its sur-reply out of time would be in the interests of justice (*see* Paper 13). Under these circumstances, we determine that allowing Patent Owner to file its sur-reply out of time would not be in the interests of justice.

ORDER

In consideration of the foregoing, it is

ORDERED that Patent Owner's Motion for Leave to Submit Sur-reply Out of Time is denied.

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