

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

PLAYVUU, INC.,
Patent Owner.

IPR2023-00848
Patent 10,931,911 B2

Before KEN B. BARRETT, BARBARA A. PARVIS, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. § 42.5

On September 29, 2023, Snap Inc. (“Petitioner”) sent an e-mail seeking leave to file a reply to the Patent Owner Preliminary Response. Petitioner requested briefing on three issues including (1) whether we should deny the Petition under 35 U.S.C. § 325(d), (2) whether we should deny the Petition under 35 U.S.C. § 314(a) based on application of factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20,

2020) (precedential) (“*Fintiv*”), and (3) whether we should determine that the Petition does not demonstrate a reasonable likelihood of prevailing based on certain characterizations by Patent Owner. Petitioner indicated that Patent Owner opposed Petitioner’s request. On October 10, 2023, a call was conducted with Judges Barrett, Parvis, and McMillin and counsel for the parties.

As an initial matter, Patent Owner’s Preliminary Response was filed on September 15, 2023, three months and one day after the Notice of Filing Date Accorded to Petition. *See* Papers 3, 7. “The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date.” 37 C.F.R. § 42.107(b). During the call, counsel for Patent Owner indicated he was unaware of the late filing, but he assumed it was an inadvertent error. Petitioner does not object to Patent Owner’s late filing of its Preliminary Response. We determine that consideration of Patent Owner’s Preliminary Response is in the interest of justice. *See* 37 C.F.R. § 42.5(c)(3) (A “late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.”). We, therefore, waive strict application of the timing requirement for Patent Owner’s filing of its Preliminary Response and excuse Patent Owner’s filing its Preliminary Response one day late. *Id.*; *see also* 37 C.F.R. § 42.5(b) (“The Board may waive or suspend a requirement of parts 1, 41, and 42.”).

We turn to Petitioner’s request for leave to file a reply to the Patent Owner Preliminary Response and the three issues identified by Petitioner, that is whether we should deny the Petition under 35 U.S.C. § 325(d), whether we should deny the Petition under 35 U.S.C. § 314(a) based on

application of the *Fintiv* factors, and whether we should determine that the Petition does not demonstrate a reasonable likelihood of prevailing based on certain characterizations by Patent Owner. Under 37 C.F.R. § 42.108(c), Petitioner “may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c),” but “[a]ny such request must make a showing of good cause.” With respect to the first issue, Petitioner has shown good cause to file a preliminary reply to address Patent Owner’s arguments that the secondary references are cumulative to art considered by the Examiner. With respect to the second issue, Petitioner has shown good cause to file a preliminary reply to address Patent Owner’s arguments in light of the updated status in the related matter, that is *Playvuu, Inc. v. Snap Inc.*, No. 2:22-cv-06019-GW-PD (C.D. Cal.), filed August 24, 2022. Further, Patent Owner does not oppose additional briefing on the second issue. With respect to the third issue, Petitioner has not shown good cause for additional briefing to respond to characterizations by Patent Owner that the Petition does not demonstrate a reasonable likelihood of prevailing. Petitioner has not explained persuasively why good cause exists for this additional briefing relating to, for example, whether the Petition has articulated a rationale to combine the asserted prior art. Petitioner’s arguments relating to the third issue are not tied to the updated status in the related District Court matter.

We, therefore, grant Petitioner’s request for leave to file a preliminary reply to Patent Owner’s Preliminary Response limited to six (6) pages and limited to Patent Owner’s discussion of whether we should deny the Petition under 35 U.S.C. § 325(d) and whether we should deny the Petition under 35 U.S.C. § 314(a) based on application of the *Fintiv* factors. Petitioner’s preliminary reply is due Friday October 13, 2023. Patent Owner is

authorized to file a preliminary sur-reply, limited to six (6) pages and to the assertions in Petitioner's preliminary reply. Patent Owner's preliminary sur-reply is due October 20, 2023.

Petitioner also seeks leave to file the Final Claim Construction Order and its Amended Answer entered in the related District Court matter. We grant Petitioner's request to file the Final Claim Construction in the related District Court matter. *See Consolidated Trial Practice Guide* ("Consolidated Practice Guide")¹ at 47 ("Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available."); *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). We determine Petitioner has not shown good cause for filing its Amended Answer in the related District Court matter and we, therefore, deny that request.

ORDER

Accordingly, it is:

ORDERED that strict application of the timing requirement for filing Patent Owner's Preliminary Response is waived and Patent Owner's late filing of its Preliminary Response on September 15, 2023 is excused;

FURTHER ORDERED the Petitioner is authorized to file a preliminary reply, limited to six (6) pages and to Patent Owner's discussion of discretionary denial under 35 U.S.C. § 325(d) and under 35 U.S.C. § 314(a) based on *Fintiv* factors;

FURTHER ORDERED that Patent Owner is authorized to file a preliminary sur-reply, limited to six (6) pages and to the assertions in Petitioner's preliminary reply;

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

FURTHER ORDERED that Petitioner is authorized to file as an Exhibit in this proceeding the Final District Court Claim Construction Order in the related District Court proceeding;

FURTHER ORDERED that no party is authorized to file any additional evidence; and

FURTHER ORDERED that Petitioner's preliminary reply is due Friday, October 13, 2023, and Patent Owner's preliminary sur-reply is due Friday, October 20, 2023.

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