

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.; INSTAGRAM, INC.; WHATSAPP LLC;
META PLATFORMS TECHNOLOGIES, LLC; AND GIPHY, INC.,
Petitioner,

v.

VL COLLECTIVE IP E LLC,
Patent Owner.

IPR2022-00923
Patent 7,266,682 B2

Before EASTHOM, KARL D., SMITH, JEFFREY S., and
MCKONE, DAVID C., *Administrative Patent Judges*

SMITH, *Administrative Patent Judge*.

ORDER
Authorizing Petitioner Reply and Patent Owner Sur-reply
37 C.F.R. § 42.5

INTRODUCTION

On September 28, 2023, the Board held a conference call with the parties to discuss Petitioner's request to file a three-page Reply to respond to arguments raised in Patent Owner's Preliminary Response (Paper 11), and Petitioner's request to submit supplemental evidence including a supplemental declaration from Dr. Henry Houh, two supplemental declarations from Dr. Sylvia Hall-Ellis, and a declaration from a named author of the Handley reference (Ex. 1005).

For the reasons discussed in this Order, we authorize Petitioner to file a three-page Reply limited to addressing arguments in the Preliminary Response regarding whether the Petition sufficiently show that Exhibits 1005 and 1007 qualify as printed publications. We also authorize Patent Owner to file a three-page Sur-Reply. We deny Petitioner's request to submit supplemental information.

DISCUSSION

"[Although] the petitioner must submit evidence sufficient to meet the reasonable likelihood standard, some limited opportunities exist for the petitioner to present new evidence later, including . . . in a reply to a patent owner preliminary response." *Hulu LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 14 (PTAB Dec. 20, 2019) (precedential) (citing 37 C.F.R. §§ 42.108(c), 42.23, 42.123). "For example, if the patent owner challenges a reference's status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication." *Id.* at 15 (citing 37 C.F.R. §§ 42.2 (affidavit), 42.23). A petitioner's request for leave to file a reply to the preliminary response must be supported by "a showing of good cause." 37 C.F.R. § 42.108(c.).

Petitioner argued that *Hulu* expressly recognizes that Petitioner has the opportunity to provide the requested Reply. Petitioner argued that it does not seek to change the positions taken in the Petition, but rather respond to Patent Owner's arguments about the status of Exhibits 1005 and 1007 as printed publications. Patent Owner responded that this is not a case where Patent Owner responded with arguments that were unforeseeable. Patent Owner argued that Petitioner should have known that status of Exhibits 1005 and 1007 as printed publications would be at issue.

After considering the record and the arguments presented in the conference call, we grant Petitioner's request to submit a Reply limited to addressing arguments in the Preliminary Response regarding whether the Petition sufficiently show that Exhibits 1005 and 1007 qualify as printed publications. At this stage, the Board would benefit from additional briefing on this issue to determine whether to institute trial. We, however, agree with Patent Owner that no good cause exists for submitting supplemental evidence. This is not a case where Patent Owner has presented evidence or arguments that Petitioner could not have reasonably foreseen. Thus, we deny Petitioner's request to file supplemental evidence.

ORDER

It is

ORDERED that Petitioner is authorized to file a three-page Reply to Patent Owner's Preliminary Response;

FURTHER ORDERED that Petitioner's Reply must be filed no later than five business days of this order;

FURTHER ORDERED that Petitioner's Reply is limited to the issue of whether the Petition sufficiently shows that Exhibits 1005 and 1007 are printed publications;

FURTHER ORDERED that Patent Owner is authorized to file a three-page Sur-reply;

FURTHER ORDERED that Patent Owner's Sur-reply must be filed no later than five business days of Petitioner's Reply; and

FURTHER ORDERED that Patent Owner's Sur-reply may only respond to arguments raised in the Reply.

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