

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01117
Patent 8,321,213 B2

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

ORDER
Denying Leave to File Reply to Preliminary Response
37 C.F.R. § 42.108(c)

On November 16, 2023, Sony Electronics (“Petitioner”) contacted the Board via email to seek leave to file a three-page Reply to Patent Owner’s Preliminary Response under 37 C.F.R. § 42.108(c). Ex. 3001. As indicated in the same email, Jawbone Innovations, LLC (“Patent Owner”) opposed this request. *Id.*

Petitioner seeks leave to file a reply to respond to the Preliminary Response’s “extensive discussion” of issues in connection with the Board’s comment in an earlier *Amazon v. Jawbone* IPR involving the same patent and prior art. *Id.* (citing Paper 8, at 10–13, 14–20; IPR2023-00276, Paper 10 at 44).¹ There, the Board “invit[ed] the parties to address in the Response, Reply, and Sur-reply how the specification affects the claim construction the Board will use in the Final Written Decision when determining claim 14’s patentability.” *Id.* Petitioner asserts that good cause exists for Petitioner to respond briefly on those issues prior to a decision on institution, given that Patent Owner already had the opportunity to do so. *Id.*

Our rules provide that “[a] petitioner may seek leave to file a reply to the preliminary response” but that “[a]ny such request must make a showing of good cause.” 37 C.F.R. § 42.108(c). Having reviewed the record and after considering Petitioner’s request, we find that Petitioner has not shown that good cause exists for a reply under these circumstances. The Board’s comment in the *Amazon v. Jawbone* IPR referred to the parties providing post-trial briefing that the Board would consider in its Final Written

¹ The *Amazon v. Jawbone* IPR has since terminated due to settlement. IPR2023-00276, Paper 17.

Decision. Additional briefing on these issues is unnecessary for the Board to reach a decision on institution here.

The Board notes that, prior to contacting the Board, the parties conferred to discuss this issue, and agreed to certain briefing parameters, including requesting a sur-reply for Patent Owner, if Petitioner's request for leave was granted. We appreciate the good faith efforts of the parties to meet and confer before contacting the Board. Patent Owner's request for a sur-reply, however, was conditioned on our granting Petitioner's request and is, therefore, moot.

Accordingly, it is

ORDERED that Petitioner's request for leave to file a Reply to Patent Owner's Preliminary Response under 37 C.F.R. § 42.108(c) is *denied*.

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US Patent No. 8,321,213 B2

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