

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01177
Patent 8,326,611 B2

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *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. The same email indicates that Jawbone Innovations, LLC. (“Patent Owner”) opposed Petitioner’s request. *Id.*

According to Petitioner’s request,

Patent Owner Jawbone Innovations, LLC (“Jawbone”) has used its POPR, in part, to respond to the Board’s comment in an earlier *Amazon v. Jawbone* IPR (involving the same patent and prior art) “in vit[ing] 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 1’s patentability.” (IPR2023-00286, Paper No. 10 at 42.) The POPR in the present case includes an extensive discussion of those issues. (Paper No. 8, at 9-12, 14-20.) As a matter of fundamental fairness, Sony requests that it be given the opportunity to respond briefly on those issues prior to a decision on institution, given that Jawbone has already had the opportunity to do so. Sony thus maintains that good cause exists for a reply.

Ex. 3001.

Petitioner’s request is denied. Our rules provide for a Petitioner’s Reply when good cause exists. 37 C.F.R. § 42.108(c). Good cause has not been demonstrated here. The issues that Petitioner identifies in its request could have been—but were not—addressed in the petition. The issues that Petitioner refers to were known, rather than a new or unforeseeable issue. Because of the expedited nature this proceeding, Petitioner is generally expected to make its case for institution in the Petition. Here, the Board does not need further briefing to assess the Petition’s arguments and evidence.

ORDER

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*.

For PETITIONER

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