

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TP-LINK CORPORATION LIMITED,
Petitioner,

v.

NETGEAR, INC.,
Patent Owner.

IPR2023-01393
Patent 7,936,714 B1

Before LYNNE H. BROWNE, SHEILA F. MCSHANE, and
JASON M. REPKO, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Request for Additional Briefing
37 C.F.R. § 42.5

I. INTRODUCTION

On September 7, 2023, TP-Link Corporation Limited (“Petitioner”) filed a Petition (Paper 2) requesting *inter partes* review of claims 1–32 of U.S. Patent No. 7,936,714 B1. On December 13, 2023, Netgear, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7). On January 11, 2024, Petitioner emailed the Board to request additional briefing in this proceeding and Patent Owner emailed the Board to request that Petitioner’s request be denied. Ex. 3001; Ex. 3002. On January 19, 2024, a conference call with counsel for the parties was held to discuss Petitioner’s request and Patent Owner’s response thereto. A copy of the transcript of this conference call has been entered as Exhibit 1032. For the reasons below, we *deny* Petitioner’s request.

II. BASIS FOR PETITIONER’S REQUEST

During the conference call, Petitioner requested additional briefing for three reasons:

1) *Claim Construction*: Petitioner argued that Patent Owner’s Preliminary Response relies on a claim construction to avoid the prior art that Petitioner could not have foreseen. Ex. 1032, 4:21–5:13.

2) *Deposition Testimony*: Petitioner argued that testimony from Dr. Haas submitted in Exhibit 2001 and cited in the Preliminary Response conflicts in material respects with deposition testimony of Patent Owners’ technical expert in the co-pending International Trade Commission litigation, Dr. Wicker. Ex. 1032, 7:14–19.

3) *Patent Owner’s Characterizations of Morikawa and Serizawa*: Petitioner argues that the Preliminary Response mischaracterizes the disclosure of the Morikawa and Serizawa references and Petitioner should

be permitted to address Patent Owner’s mischaracterizations. Ex. 1032, 7:15–19, 13:7–9.

III. DISCUSSION

Our rules provide for a petitioner’s reply to a preliminary response only when good cause exists. 37 C.F.R. § 42.108(c). For the reasons discussed in the conference call and summarized below, Petitioner has not shown good cause here.

With respect to the first issue, Petitioner asserted that the Preliminary Response presents an “implicit dispute over what is necessary to show a base station, which can transmit and receive at the same time.” Ex. 1032, 5:10–13. Petitioner argued this implicit dispute could benefit from additional briefing. *Id.* Patent Owner argued that this is not a claim construction dispute at all (*id.* at 5:22–23), but that “[n]evertheless, claim construction and claim interpretation is a routine function of the Board, and not something that requires further briefing.” (*id.* at 6:11–14).

We stated that “[c]laim construction is within our purview, and we are capable of determining what the claim construction should be.” *Id.* at 6:17–19. Because of the expedited nature this proceeding, Petitioner is generally expected to make its case for institution in the Petition. Here, Petitioner could have, but did not, present this construction in the Petition. We were not persuaded that this was an unforeseeable issue simply because the term was not in dispute in the parallel ITC litigation. *See id.* at 4:19–5:9. Patent Owner is not limited here to the same arguments that were made in the ITC proceeding. Thus, Petitioner has not demonstrated good cause to permit a reply to introduce its claim construction. We informed the parties

that we will not be allowing further briefing on claim construction at this stage of the proceeding. *Id.* at 6:16–17.

With respect to the second issue, Petitioner asserted that Dr. Wicker’s deposition testimony in the co-pending ITC litigation demonstrates “clearly inconsistent testimony between Dr. Wicker and Dr. Haas in how they characterized the teachings of Morikawa and Serizawa,” “[a]nd in particular, how they characterized those teachings as it relates to the limitation occur at the same time.” *Id.* at 7:15–19. Petitioner argued that it “should have an opportunity to submit Dr. Wicker’s testimony for the Board’s consideration and to explain how it conflicts with Dr. Haas’s declaration in material aspects.” Ex. 3001, 1, 2.

Petitioner acknowledged that Dr. Wicker’s testimony is subject to a protective order in the International Trade Commission, but asserted that Petitioner intends to only submit portions of the transcript not subject to the protective order. Ex. 1032, 6:25–7:6. Patent Owner asserted that Dr. Wicker’s entire transcript is believed to be designated as Confidential Business Information under the protective order, and that the parties have not come to an agreement, or even discussed, how testimony from the transcript could be admitted before the Board in this case, given the provisions of the protective order in the International Trade Commission. *Id.* at 8:3–7.

Based on the Parties’ statements, at this time, we decline to require the filing of a document covered by an International Trade Commission protective order. We therefore denied Petitioner’s request to submit Dr.

Wicker's testimony or any additional briefing related to Dr. Wicker's testimony at this time. Ex. 1032, 12:12–17.¹

With respect to the third issue, Petitioner asserted that Morikawa and Serizawa have been mischaracterized by Dr. Haas and that Petitioner would like to have an opportunity to clarify its positions relative to Dr. Haas' positions. Ex. 1032, 13:7–11. Petitioner argued it would be best to address the issue now, given the lack of opportunity to appeal if institution is denied. *Id.* at 13:18–20.

Patent Owner argued that Petitioner simply disagrees with Patent Owner's characterization of the prior art. Ex. 1032, 14:5–6. Patent Owner further argued that interpretation of the prior art and determination of disputes of such interpretation is well within the purview of the Board, and represents a routine function of the Board without further briefing. *Id.* at 14:9–13.

We stated that we agree with Patent Owner that it is within our purview to consider the evidence, including whether or not the party has mischaracterized that evidence. Ex. 1032, 15:1–4. As Patent Owner argued in the call, it may often be the case that a petitioner disagrees with how a patent owner characterizes the facts and law presented in the petition. *See* Ex. 1032, 14:4–15. But a petitioner must make a showing of good cause in its request for a reply to a preliminary response. 37 C.F.R. § 42.108(c). Petitioner did not do so here. Thus, we declined to authorize additional briefing on this issue. Ex. 1032, 15:1–6.

¹ If Petitioner seeks to submit this testimony at a future time, to the extent that the parties cannot agree to confidentiality issues concerning this testimony under the ITC protective order, the parties shall seek the assistance of the ITC to resolve any issues.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated good cause to file additional briefing. Accordingly, we deny Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for additional briefing is *denied*.

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