

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING COMPANY, INC.,
Petitioner,

v.

MHL CUSTOM, INC.,
Patent Owner.

IPR2024-00085 (Patent 9,586,659 B2)
IPR2024-00086 (Patent 9,359,044 B2)¹

Before BART A. GERSTENBLITH, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

ORDER
Sua Sponte Authorizing Additional Briefing
37 C.F.R. § 42.20(d)

¹ This Order applies to both proceedings. The parties are not authorized to use this heading without express permission from the Board.

IPR2024-00085 (Patent 9,586,659 B2)

IPR2024-00086 (Patent 9,359,044 B2)

In its Preliminary Responses, Patent Owner argues that the Board should deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), in light of related district court litigation, *Custom, Inc. v. Foil Boarding Company, Inc., d/b/a Foil, f/k/a Get Foil*, No. 3:22-cv-21258 (N.D. Fla.) (“Related Litigation”). See Paper 6, 3 (citing *Fintiv*).²

In order to fully address Patent Owner’s *Fintiv* arguments, we *sua sponte* authorize Petitioner to file a reply to Patent Owner’s arguments specifically limited to this issue, as set forth below. See 37 C.F.R. § 42.20(d) (“The Board may order briefing on any issue involved in the trial.”). If Petitioner files a reply, Petitioner should address each of the *Fintiv* factors, including whether Petitioner stipulates that it will not pursue grounds in the Related Litigation as in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

We also authorize Patent Owner to file a sur-reply in response to the reply, if filed, as also set forth below.

Accordingly, it is:

ORDERED that Petitioner is authorized to file a reply to Patent Owner’s Preliminary Response, limited to addressing Patent Owner’s *Fintiv* arguments (see Paper 6, 3–5);

FURTHER ORDERED that any reply filed by Petitioner shall be five pages or less and is due by April 8, 2024; and

² Similar papers were filed in each proceeding. For simplicity, we cite to the papers filed in IPR2024-00085.

IPR2024-00085 (Patent 9,586,659 B2)

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FURTHER ORDERED that Patent Owner may file a sur-reply in response to the reply, if filed, and such sur-reply shall be five pages or less and is due by April 12, 2024.

IPR2024-00085 (Patent 9,586,659 B2)

IPR2024-00086 (Patent 9,359,044 B2)

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