

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURITY FIRST INNOVATIONS, LLC,
Patent Owner.

IPR2024-00214 (Patent 11,068,609 B2)
IPR2024-00215 (Patent 10,452,854 B2)¹

Before THOMAS L. GIANNETTI, JASON M. REPKO, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order is being entered in IPR2024-00214 and IPR2024-00215 because it addresses issues common to both proceedings. The parties are not authorized to use this style heading in any subsequent papers.

I. SUMMARY

On March 14, 2024, Petitioner sent an email to the Board seeking a conference call to request authorization to file a 6-page Reply to Patent Owner's Preliminary Response ("Preliminary Response") to address alleged "mischaracterizations of fact and law." Ex. 3001 (emails dated March 14, 2024 from Petitioner and Patent Owner). Contrary to our rules and procedures, the email contained extensive argument of counsel directed to the alleged "mischaracterizations."

On March 21, 2024, the panel held a conference call with respective counsel for the parties. A court reporter was present on the call, and Petitioner has filed a transcript of the call as Exhibit 1069 ("Tr.").

Filing a reply to a Patent Owner's preliminary response is normally not authorized under our rules. Under 37 C.F.R. § 42.108(c), a petitioner may seek leave to file a reply to the preliminary response, but is required to make a showing of good cause. Here, after considering the record before us and the presentations of counsel during the conference call, we determine that Petitioner has not made a sufficient showing of good cause. Thus, we deny Petitioner's request. Our reasoning follows.

II. PETITIONER'S ARGUMENTS

Petitioner contends that good cause for a reply exists because Patent Owner's arguments "mischaracterized facts or the law in unforeseeable ways that [Petitioner] wouldn't have predicted before filing [the] petitions." Tr. 6:13–18. According to Petitioner, "Patent Owner went beyond simply disagreeing with [Petitioner's] analysis," by "flatly contradicting what the clear law is and not citing to those cases that contradict the various

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statements that Patent Owner made and leaving out cases by omission,” for example. *Id.* at 6:21–24, 9:3–9.

Petitioner requests a reply that addresses Patent Owner’s alleged mischaracterization of the prior art cited in the Petition (*id.* at 15:5–16:16), whether Petitioner can rely on a corroborating reference as evidence of the knowledge of a person of ordinary skill in the art (*id.* at 16:23–17:4), and whether the Board can rely on Patent Owner’s claim constructions that were presented as alternatives in the Petition even if Petitioner has not acquiesced to them (*id.* at 13:14–14:18).

III. PATENT OWNER’S ARGUMENTS

Patent Owner argued that the disagreements between the parties amount to “common garden variety disagreements about facts and law,” which does not satisfy the good-cause standard. *Id.* at 12:15–21. As for the prior art, Patent Owner argues that its citation to paragraph 8 of Foster (Ex. 1006) was a clear typographical error because the argument quoted from paragraph 37. *Id.* at 20:22–21:5. As for the argument about corroborating evidence, Patent Owner argued that Petitioner mischaracterizes the argument in its Response. *Id.* at 21:10–13. In Patent Owner’s view, the Response does not say that corroborating evidence could never be used. *Id.* Lastly, Patent Owner argued that issues related to the characterization of the prior art and claim construction were foreseeable and should have been addressed in the Petition. *Id.* at 19:2–19, 21:23–22:22.

IV. ANALYSIS

Petitioner’s request is denied. Our rules provide for a reply only when good cause exists. 37 C.F.R. § 42.108(c). We are not persuaded that Patent

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Owner's alleged mischaracterizations here provide good cause for a reply. The Board routinely determines whether an argument mischaracterizes the prior art without additional briefing before issuing its decision on institution. Petitioner has not persuaded us that this case is any different. Rather, Petitioner merely disagrees with how Patent Owner characterizes the Petition's analysis. To the extent that the disagreement regarding Foster was, at least in part, the result of a typographical error, the Board will take that into account. *See* Tr. 20:22–21:21:5.

We also see no reason to order briefing on the case law cited in the Preliminary Response. Petitioner acknowledged that the reply will not address any intervening cases that have issued since the Petition was filed and that the relevant “law has been black letter law for several years.” Tr. 10:4–8. The Board is aware of controlling precedent on the issues raised in the Preliminary Response and is able to evaluate the legal arguments without additional briefing.

Generally, petitioners are expected to make the case for institution in the petition. Here, the Board will evaluate the Petition's analysis of the prior art without considering the substantive arguments made in Petitioner's email to the Board. *See* Ex. 3001. The parties are directed to refrain from including substantive arguments in emails to the Board. An email requesting a conference with the Board should contain a short statement of the subject to be discussed and no further argument or elaboration.

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V. ORDER

It is

ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is *denied*.

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