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Paper 9
Entered: September 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMAXTEC INC. and
SMAXTEC ANIMAL CARE GmBH,
Petitioner,

v.

ST REPRODUCTIVE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00875 (Patent 9,844,206 B2)
IPR2024-00885 (Patent 8,823,515 B2)[1]

Before SHARON FENICK, JAMIE T. WISZ, and
ANDREAS BALTATZIS, *Administrative Patent Judges*.

PER CURIAM.

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

[1] The combined caption is for administrative convenience only and does not indicate that the above-listed proceedings have been joined. The parties are not authorized to use this caption without express permission from the Board.

INTRODUCTION

On September 13, 2024, Petitioner requested a conference call seeking permission to file a three-page preliminary reply to Patent Owner's Preliminary Response in each of the above-listed proceedings. Ex. 3001. Petitioner requested authorization to file a preliminary reply to address Patent Owner's arguments and declaration testimony regarding the public accessibility of Trevarthen (Ex. 1005) and the construction of the term "implanted" in the challenged patents. Ex. 3001. Patent Owner opposed Petitioner's request. *Id.*

We conducted a conference call with counsel for the parties to discuss Petitioner's request and Patent Owner's opposition on September 18, 2024. No court reporter was present. For the reasons given below, we grant Petitioner's request to file a preliminary reply in each of the above-listed proceedings.

DISCUSSION

During the conference call, Petitioner first argued that good cause exists for a preliminary reply to address the public accessibility of Trevarthen because the information Patent Owner submitted in its Preliminary Responses was not foreseeable, and the Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019) ("CTPG"))[2] states that "[s]ubmission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence." *See* CTPG 51–52. Petitioner argued that the additional

[2] *Available at* www.uspto.gov/TrialPracticeGuideConsolidated.

information it seeks to submit would be helpful to the Board in determining whether to grant institution.

Patent Owner responded that Petitioner's request should be denied because Patent Owner's arguments regarding public accessibility were foreseeable as it is Petitioner's burden to show that its references were publicly accessible. Patent Owner argued further that the Board does not need any additional briefing from the parties because the Board can make credibility determinations about declaration testimony and can review the two sets of briefs from the parties.

As to its second issue, Petitioner argued that good cause exists for a preliminary reply to address the meaning of "implanted" because Patent Owner's construction of "implanted" in its Preliminary Responses was not foreseeable and does not take into account the meaning of the term in the challenged patents.

Patent Owner disagreed that good cause exists for a preliminary reply because its construction of "implanted" was foreseeable based on certain of Patent Owner's filings in a related district court litigation. Patent Owner argued further that both parties contend that the plain and ordinary meaning of the term should apply, and the Board has what it needs to assess the prior art.

After considering the parties' contentions made during the conference, we determine that good cause exists to allow Petitioner to reply to Patent Owner's testimonial evidence regarding the public accessibility of Trevarthen. *See* CTPG 51–52; 37 C.F.R. § 42.108(c) ("A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good

cause.”). We also determine that allowing the parties to brief the claim construction issue regarding “implanted” would be helpful to the Board and promotes efficiencies for the parties and the Board. Accordingly, Petitioner’s request for additional briefing is *granted*.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for leave to file a three-page preliminary reply in each of the above-listed proceedings is granted, and that the reply in each proceeding shall be filed on or before September 26, 2024; and

FURTHER ORDERED that Patent Owner may file a three-page preliminary sur-reply to Petitioner’s preliminary reply in each of the above-listed proceedings, and that the sur-reply in each proceeding shall be filed on or before October 3, 2024.

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