

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ROOT TECHNOLOGY CO., LTD.,
Petitioner,

v.

CHIARO TECHNOLOGY LTD.,
Patent Owner.

IPR2024-00953
Patent 11,413,380 B2

Before MEREDITH C. PETRAVICK, GRACE KARAFFA OBERMANN,
and AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Unopposed Request for Leave to File a
Preliminary Reply to the Preliminary Response and
for Patent Owner to file a Preliminary Sur-Reply
37 C.F.R. §§ 42.5, 42.108(c)

Petitioner emailed the Board requesting authorization to file a three-page preliminary reply to Patent Owner's Preliminary Response (Paper 14, "Prelim. Resp")) for the purpose of "addressing the discretionary denial issues introduced in the preliminary response." Ex. 3003, 1 (email correspondence). Petitioner stated that good cause exists for briefing on this issue because of certain "new events from the district court litigation arising after the petition was filed." *Id.* Petitioner represented that "Patent Owner does not oppose this request so long as Patent Owner is similarly authorized to file a sur-reply limited to 3 pages (no new exhibits)." *Id.*

DISCUSSION

Petitioner's request for additional briefing arises, at least in part, from Patent Owner's argument in the Preliminary Response that the Board should exercise discretion to deny institution under 35 U.S.C. 314(a) in view of two parallel district court proceedings. Prelim. Resp. 43–59 (addressing the "Fintiv factors" set forth in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020)). As noted above, the request is unopposed and Petitioner refers to certain "new events from the district court litigation arising after the petition was filed." Ex. 3003, 1. Considering the above circumstances we find that Petitioner has established sufficient good cause for additional briefing for its intended purpose.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response and for Patent Owner to file a preliminary sur-reply is *granted*;

FURTHER ORDERED that neither party is authorized to file any new exhibits;

FURTHER ORDERED that, no later than five (5) business days week from the date of this order, Petitioner is authorized to file a preliminary reply of not more than three pages to address the "*Fintiv* factors" discussed in Patent Owner's Preliminary Response; and

FURTHER ORDERED that, no later than five (5) business days from the date of Petitioner's preliminary reply, Patent Owner is authorized to file a preliminary sur-reply of not more than three pages limited to addressing the issues raised in Petitioner's preliminary reply.

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