

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and NOKIA OF AMERICA CORPORATION,
Petitioner,

v.

ACTIVE WIRELESS TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00986
Patent 10,785,764 B2

Before MONICA S. ULLAGADDI, DAVID COTTA, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Request to File a Preliminary Reply to the
Preliminary Response
37 C.F.R. §§ 42.5, 42.108(c)

I. SUMMARY

Petitioner emailed the Board requesting a conference call to discuss authorization to file a ten-page preliminary reply to Patent Owner's Preliminary Response (Paper 8) to address "(1) Patent Owner's arguments that Fujishiro^[1] is not prior art to the [challenged patent] and (2) Patent Owner's mischaracterization of the arguments set forth in the Petition regarding an alleged failure to disclose: (i) the use of two different DCI^[2] formats, (ii) two different periods, and (iii) reasons to combine Xu^[3] with other references." *See* Ex. 3001 (Petitioner's email to the Board). Patent Owner opposes this request. *Id.* Judges Ullagaddi, Cotta, and Repko held a conference call with counsel for the parties.

We deny Petitioner's request for a preliminary reply. Our reasoning follows.

II. ANALYSIS

A petitioner must show good cause to file a reply to a preliminary response. 37 C.F.R. § 42.108(c).

During the conference call, Petitioner argued that there is good cause to file a Reply because Patent Owner's arguments were unforeseeable. For example, Petitioner argued that it was unforeseeable that Patent Owner would mischaracterize the Petition's arguments about the prior art. Petitioner also argued that good cause exists because Petitioner's proposed reply would

¹ U.S. Patent Application Publication No. 2019/0182632 A1 to Fujishiro et al. Ex. 1011.

² Downlink Control Information. Ex. 1001, 2:61.

³ U.S. Patent No. 10,785,752 B2 to Xu et al. Ex. 1006.

bring to the Board's attention relevant case law on the issue of whether Fujishiro is prior art to the challenged patent.

Patent Owner disagreed that good cause exists for Petitioner's proposed briefing. Patent Owner asserted its belief that Petitioner merely seeks an additional opportunity to present its arguments. In Patent Owner's view, Petitioner had the opportunity in its Petition to address whether Fujishiro is prior art.

Petitioner has not shown good cause to file its proposed preliminary reply. During the conference call, Petitioner acknowledged that there were no developments in the parallel district-court proceeding that support a request for a preliminary reply here. Rather, the sole basis for Petitioner's request is a desire to respond to Patent Owner's arguments in the Preliminary Response. The Board is capable of reviewing and applying the relevant case law to determine whether Fujishiro is prior art without further briefing from Petitioner. Also, the Board needs no further briefing to determine whether the arguments in Patent Owner's Preliminary Response mischaracterize the Petition. Thus, Petitioner has not established good cause under 37 C.F.R. § 42.108(c), and Petitioner's request for leave to file a preliminary reply is denied.

III. ORDER

It is ORDERED that Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response is *denied*.

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