

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01090
Patent No. 10,725,581 B1

Before BARBARA A. BENOIT, NATHAN A. ENGELS, and
SHARON FENICK, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

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

In an e-mail to the Board, Petitioner requested authorization to a three-page preliminary reply to Patent Owner’s Preliminary Response to address the claim terms “when” and “based on the detected usage where.” Ex. 3001, 1. Petitioner’s e-mail states, among other things, that “good cause for further briefing on these issues exists, at least because briefing would clarify the record and aid the Board in deliberations on issues that are potentially dispositive to institution.” *Id.* Further, Petitioner’s e-mail states as one example of the need for additional briefing, “although the Petition preemptively addresses aspects of the [Patent Owner Preliminary Response]’s arguments, Petitioner could not have reasonably anticipated Patent Owner’s assertion that the distinct claim terms ‘when’ and ‘in response to’ should be interpreted as having equivalent meanings.” *Id.*

The Board held a conference call with the parties to discuss Petitioner’s request for additional briefing. During the call, Petitioner reiterated the positions presented in its e-mail and stated that the timing of its e-mail request—sent on December 2, 2024, more than five weeks after Patent Owner filed its Preliminary Response on October 23, 2024—stemmed from the relatively large number of *inter partes* review proceedings pending between the parties, and from coordination with the parties’ district-court litigation.

In response, Patent Owner stated that it opposes Petitioner request for additional briefing because, among other things, the Petition already addresses the claim language referenced in Petitioner’s e-mail. According to Patent Owner, the lack of good cause for additional briefing is evident from the fact that the Petition already addresses the claim terms, demonstrating

that Petitioner could have, and did, anticipate these issues, and thus that they were not unforeseeable.

Our rules permit a petitioner to request authorization to file a reply to a preliminary response upon a showing of good cause. 37 C.F.R.

§ 42.108(c) (2023). Here, we agree with Patent Owner that Petitioner has not shown good cause for additional briefing, given that the Petition already addresses the claim terms that Petitioner intends to address with additional briefing. The delay between Patent Owner's Preliminary Response and Petitioner's e-mail requesting additional briefing also weighs against Petitioner's purported showing of good cause in this case.

Accordingly, we deny Petitioner's request for additional briefing.

V. ORDER

In view of the foregoing, it is hereby:

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

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