

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMMY JOHN, INC.,
Petitioner,

v.

PACKAGE APPAREL, INC.,
Patent Owner.

IPR2024-01163
Patent 10,834,974 B2

Before BARRY L. GROSSMAN, JAMES A. TARTAL, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION
Conduct of the Proceedings
37 C.F.R. § 42.5

On November 5, 2024 (by electronic mail) Petitioner indicated that the parties had conferred and requested: (1) authorization for Petitioner to file a Preliminary Reply to Patent Owner's Preliminary Response; and (2) authorization for Patent Owner to file a Sur-reply, stating:

Pursuant to 37 C.F.R. §§ 42.108(c) and 42.23, Petitioner . . . respectfully requests leave to file a preliminary reply of no more than five pages to address Patent Owner's arguments in its Preliminary Response regarding:

1. Whether discretionary denial is appropriate under 35 U.S.C. § 325(d) and *Advanced Bionics*; and
2. Whether discretionary denial is appropriate under *Fintiv* and § 314([a]).

Petitioner submits that good cause exists for such a preliminary reply in order to, for example, address Patent Owner's statements regarding the prosecution history and comparisons of prior art used in rejections during prosecution to the references used in the Petition, and Patent Owner's arguments regarding the state of the parallel district court case and any potential overlap in grounds presented in this Petition and grounds that may be litigated in the district court case.

Petitioner and Patent Owner have conferred regarding Petitioner's request, and Patent Owner indicated it does not oppose a five page preliminary reply by Petitioner on the issues of § 325(d) and *Fintiv*, provided Petitioner agrees to a subsequent five page sur-reply by Patent Owner due within ten business days of Petitioner's preliminary reply. Petitioner does not oppose Patent Owner's requested five page sur-reply. If helpful to the Board, the parties are available to discuss this request.

Ex. 3001.

Although the Petition does not examine the potential applicability of 35 U.S.C. §§ 314(a) and 325(d), Petitioner's argument is persuasive, and

permitting such a Preliminary Reply (from Petitioner) and a Sur-reply (from Patent Owner) would be of assistance to the Board.

In view of the foregoing, the Board authorizes Petitioner to file a Preliminary Reply and for Patent Owner to file a Sur-reply, in response thereto, wherein both the Preliminary Reply and the Sur-reply would be limited to the issues of 35 U.S.C. §§ 314(a) and 325(d).

Accordingly, it is:

ORDERED that Petitioner may file a Preliminary Reply of no more than five pages, limited to the issues of the applicability of 35 U.S.C. §§ 314(a) and 325(d). Such Preliminary Reply shall be filed on or before November 12, 2024; and

FURTHER ORDERED that Patent Owner may file a Sur-reply of no more than five pages, limited to the issues of the applicability of 35 U.S.C. §§ 314(a) and 325(d). Such Sur-reply shall be filed on or before November 19, 2024.

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