

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC.
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

IPR2024-01224
Patent 7,623,439 B2

Before JAMESON LEE, LARRY J. HUME, and AMBERL. HAGY,
Administrative Patent Judges.

HUME, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Denying Authorization for Petitioner's Reply
to the Patent Owner Preliminary Response
37 C.F.R. § 42.5

I. BACKGROUND

Lenovo (United States) Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review (“IPR”) of claims 1–3, 7–11, 13–16, and 18 (“the challenged claims”) of U.S. Patent No. 7,623,439 B2 (Ex. 1001, “the ’439 patent”). Intellectual Ventures I LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

In the Petition, Petitioner acknowledged the ’439 patent was the subject of a previously filed *inter partes* proceeding — *Zebra Technologies, Corporation v. Intellectual Ventures I LLC*, Case No. IPR2024-00883 (“the Zebra IPR”), which was filed on May 1, 2024 — and that we (“the Board”) had not, as of the filing date of the Petition, yet ruled on whether to institute the Zebra IPR. Pet. 1. As in the Zebra IPR, Petitioner relies upon a particular reference (“Dammann”, Ex. 1005) in support of each of the grounds of unpatentability.

Petitioner further asserted “[s]hould the Board institute the Zebra IPR, Petitioner will file a Motion for Joinder no later than one month after the institution date of the Zebra IPR (37 C.F.R. § 42.122(b)), requesting joinder with the aforementioned Zebra IPR proceeding as the present petition is substantially identical to the Zebra IPR (Ex. 1018); both seek *inter partes* review of the same claims of the same patent on the same grounds.” Pet. 1.

We subsequently denied institution of *inter partes* review of the ’439 patent in the Zebra IPR on November 20, 2024, based on Petitioner in that case failing to establish sufficiently that Dammann qualifies as a publicly available printed publication in accordance with our precedent. IPR2024-00883, Paper 10.

On November 27, 2024, Petitioner requested (Ex. 3002) and Patent Owner Opposed (Ex. 3003) authorization to file a preliminary reply to the Patent Owner's preliminary response. On December 3, 2024, the Board authorized Petitioner to file a Motion for Leave for Authorization to File a Preliminary Reply, and also authorized Patent Owner to file an Opposition to Petitioner's Motion. Ex. 3004. Petitioner's Motion for Leave (Paper 8) ("Mot." or "Motion") and Patent Owner's Opposition (Paper 9) ("Opp," or "Opposition") were timely filed.

For the reasons below, we *deny* Petitioner's Motion.

II. DISCUSSION

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). This burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

The rules of *inter partes* review do not automatically authorize a petitioner to file a reply to a patent owner preliminary response; instead, a petitioner seeking to file a reply prior to institution must make a showing of "good cause." *See* 37 C.F.R. § 42.108(c) (2019) ("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.").

In the Motion, Petitioner stated its reply would include “a supporting declaration from a research librarian that confirms that Ex. 1005 was publicly available before the critical date of the ’439 patent” (Mot. 1), “to show public accessibility of [] Ex. 1005, many of which can be accessed on the hyperlinks of the exhibits already of record.” *Id.* Petitioner relies upon our precedential *Hulu* case, cited below, to support its contention that submission of additional information after filing of the Petition to support that a reference qualifies as a printed publication is authorized, if such a submission is challenged by Patent Owner. Mot. 1–2.

Consistent with 35 U.S.C. § 312(a)(3), *Hulu* holds, “at the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential) (“*Hulu*”). However, *Hulu* provides for qualified exceptions to the particularity of evidence requirement by also holding that “[i]f the patent owner files a preliminary response, *for good cause*, the petitioner may seek leave to file a reply with further evidence.” *Hulu*, Paper 29 at 2 (citing 37 C.F.R. § 42.108(c)) (emphasis added).

We determine that Petitioner’s reliance upon *Hulu* is unavailing. In *Hulu*, a reference bearing a copyright date, a printing date, and an ISBN date, as well as an indication that it was from an established publisher and “well-known book series,” supported a finding of a *reasonable likelihood* that the reference was a printed publication. *Hulu*, Paper 29 at 19–20. In other words, *Hulu* merely considered whether a petitioner had met its

institution burden for public accessibility. *Id.* Petitioner points to no comparable indicia of this kind here.

Petitioner’s justification for requesting entry of new evidence after filing the Petition is that “Petitioner is not a party to the ’883 IPR and was not able to file a motion in the ’883 IPR. As the filer of a ‘copycat’, Petitioner signaled its *intention* to file a motion for joinder and assume a ‘passive understudy role,’ were the ’883 IPR to be instituted.” Pet. 3 (italics added). Petitioner further contends that filing a motion to introduce declaration evidence in this IPR before a decision to institute in the Zebra IPR had been made “would not have been consistent with Petitioner’s representation that it would assume a passive understudy role. Indeed, the grant of such a motion would have undermined Petitioner’s ability to file a motion for joinder of the ’883 IPR, by introducing issues in this IPR that were not considered by the Board in the ’883 IPR.” *Id.*

As pointed out by Patent Owner (Opp. 4–5), we note that Petitioner does not directly address the required showing of “good cause” under 37 C.F.R. § 42.108(c). In particular, Patent Owner argues:

Petitioner has been aware (or should have been aware) of the PO’s argument that Dammann has not been adequately shown to be a printed publication for over three months. Rather than promptly raising the issue, Petitioner waited until after PO filed its Preliminary Response in this IPR on November 18, 2024 and the Board denied the institution in the ’883 IPR on November 20, 2024 before raising the issue.

Opp. 3. Patent Owner also argues that good cause only exists by either new evidence coming to light, or a legal argument of first impression being made by Patent Owner. Opp. 4 (citation omitted). “The only thing ‘new’ is the Board’s decision in the ’883 IPR, which is not ‘good cause’ for the ‘do-over’ that Petitioner seeks.” Opp. 4.

We note that, because there was no time bar at issue under 35 U.S.C. § 315(b) pertinent to the filing of the Petition, Petitioner was not *required* to avail themselves of the potential benefits and pitfalls of joinder under 35 U.S.C. 315(c). In this case, we determine that the pitfall of a deficient Petition in the Zebra IPR based upon the undated non-patent Dammann reference was reasonably foreseeable by Petitioner when it signaled its *intention* to file a motion for joinder and assume a “passive understudy role.” Our caselaw supports this determination. *Samsung Electronics Co. Ltd. v. Huwaei Techs. Co. Ltd.*, IPR2017-01465, Paper 11 at 2 (PTAB Oct. 12, 2017) (denying authorization for reply to preliminary response regarding the public availability of the cited references.

“Petitioner knew or should have known when it filed its petition[] that it bore the burden of proving the art relied on was prior art. Petitioner has not shown that any issue raised in Patent Owner’s preliminary response[] was not reasonably foreseeable, such that it could not have been addressed in its petitions when filed.”); *Equistar Chemicals, LP v. Exxonmobile Chemical Patents Inc.*, IPR2017-01534, Paper 13 (PTAB Oct. 20, 2017) (denying authorization for Petitioner to file reply to preliminary response to address arguments directed to whether cited reference qualified as a printed publication.

“Petitioner knew or should have known when it filed its Petition that it bears the burden of demonstrating that Exhibit 1012 is prior art to the ’709 patent. Petitioner does not persuade us that Patent Owner’s evidence and arguments concerning the prior art status of Exhibit 1012 were reasonably unforeseeable.”); *BMW of North America, LLC v. Intellectual Ventures II LLC*, IPR2017-01558. Paper 8 (PTAB Oct. 25, 2017) (denying

authorization for Petitioner to file reply to preliminary response addressing whether asserted reference qualified as a printed publication.

“To the extent Petitioner now seeks to bolster its arguments regarding the Rynite Design Guide, we expect that Petitioner has already put forth in the Petition its best case to meet the ‘reasonable likelihood’ standard for institution. That Patent Owner would challenge the sufficiency of Petitioner's showing is an entirely foreseeable circumstance. The panel is capable of evaluating the parties’ respective positions on this issue.”); and *United Patents, Inc. v. Sound View Innovations, LLC*. IPR2018-00096, Paper 10 at 2–3 (PTAB Feb. 16, 2018) (denying Petitioner’s request to file a reply to the POPR to address alleged deficiencies in a prior art reference. “[W]e will consider the evidence of record, as submitted by the parties. We are not persuaded that Petitioner has shown good cause to warrant additional briefing to address the sufficiency of the evidence it chose to submit.”).

Patent Owner would be prejudiced by allowing Petitioner’s requested Reply to enter new evidence, given the fact that Petitioner said nothing for three months after the filing of Patent Owner’s Preliminary Response in the Zebra IPR. Patent Owner states: “Had the present Petition stated that it planned to advance its own positions if institution was denied in the ‘883 IPR, PO would have taken a different tact.” Paper 6, 4. Indeed, Petitioner said nothing until after the Board issued its decision denying institution in the Zebra IPR, which highlighted the deficiencies in the evidentiary record as to Dammann’s status as a printed publication.

As a potential understudy in the Zebra IPR, Petitioner was certainly on notice at that early date that the Dammann reference’s status as a printed publication was in question, and Petitioner’s initial *intention* of filing a motion for joinder with the Zebra IPR did not constitute a firm requirement

placed upon Petitioner to maintain understudy status in light of the new circumstances of Patent Owner's questioning Dammann's status as a printed publication. In short, Petitioner could have requested earlier consideration of this issue prior to Patent Owner filing a POPR in this IPR, and waived its intended understudy status if the risk of denial of petition on the basis of Dammann not being adequately shown as prior art was too great. Instead, Petitioner waited and now seeks to benefit from using the Board's decision denying institution in the Zebra IPR as a roadmap to attempt to correct the petitioner's deficiencies therein in demonstrating that Dammann is a printed publication. The Board's rejection of the petitioner's showing in the Zebra IPR does not provide good cause for Petitioner here to try to remedy that showing here. Petitioner cannot have it both ways, be an understudy or not be an understudy, depending on the institution decision in the '883 IPR.

Having considered the respective positions of the parties, and on the particular facts here, Petitioner reasonably should have foreseen that Patent Owner would challenge Petitioner's reliance on Exhibits 1014 through 1016 as support for the alleged status of Dammann as a printed publication. Because Petitioner has not demonstrated good cause to file a pre-institution reply to address Patent Owner's arguments as to the status of Dammann, we deny Petitioner's request.

III. ORDER

Accordingly, it is hereby:

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

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