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Paper 11 IPR2015-00593
Paper 12 IPR2015-00594
Entered: July 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XACTWARE SOLUTIONS, INC.,
Petitioners,

v.

PICTOMETRY INTERNATIONAL CORPORATION,
Patent Owner.

Cases¹
IPR2016-00593 (Patent 8,823,732), IPR2016-00594 (Patent 8,542,880)

Before HOWARD B. BLANKENSHIP, BRYAN F. MOORE,
and STACEY G. WHITE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER

Denying Authorization to File a Reply to Patent Owner Preliminary Response
37 C.F.R. §§ 42.23, 42.108

¹ This Order addresses issues that are the same each case. Therefore, we exercise our discretion to issue one Order to be filed in each case. Unless otherwise indicated, the parties are not authorized to use this style heading for any subsequent papers.

On June 13, 2016, Petitioner emailed the Board requesting “the Board’s permission to file Replies pursuant to 37 C.F.R. § 42.23 to address the foregoing issues” and requesting a conference call to discuss the request. On June 27, 2016, a conference call was held. A transcript of the call was recorded and the parties have been instructed to file that transcript on the record in these inter partes reviews (IPRs). On the call, the Board informed the parties that an order would follow the call. This is that order.

In the email and on the call, Petitioner cited to several instances in the Preliminary Responses of alleged misstatements of the facts, of Petitioner’s positions, and of the law relating to, inter alia, the public accessibility of the cited prior art, teachings of the references, and the claim language. Patent Owner argued that the rules require good cause in order to allow a Reply to a Preliminary Response. Patent Owner further argued that its Preliminary Responses essentially challenge the sufficiency of evidence cited by Petitioner in its Petitions. Patent Owner also asserted that Petitioner asks for a redo to bolster its Petitions with an omnibus filing of new substantive argument and evidence in relation to issues where Petitioner has the burden to make a threshold showing. Additionally, Patent Owner argues that, to the extent that the Replies would address misstatements in the Preliminary Responses, the Board is able to review the record and evaluate the evidence. Finally, Patent Owner stated that Petitioner has the ability to file a Rehearing Request if it believes the Board overlooked or misapprehended its arguments or evidence. *See* 37 C.F.R. § 42.71(d).

A petitioner may seek leave to file a reply to the preliminary response, but “must make a showing of good cause.” *See* 37 C.F.R. § 42.108(c) (revised April 1,

2016). Good cause may exist in certain situations such as where new evidence comes to light after the filing of a petition or a legal argument of first impression is made by the Patent Owner, we are not persuaded that sufficient good cause exists in this case. To the extent that Petitioner seeks to identify new citations or bolster arguments in the Petition, we are not required to allow Petitioner to do so. *See Hughes Network Sys., LLC v. Cal. Inst. of Tech.*, Case IPR2015-00059, slip op. at 7 (PTAB Dec. 30, 2015) (Paper 34) (“Arguments pointing to a deficiency in petitioner’s case do not impose an obligation on the part of [Patent Owner] to provide evidence supplementing that provided by [Petitioner].”). Additionally, identifying and evaluating statements or misstatements of the facts and law are well within the purview of the Panel of Judges assigned to these proceedings. It may always be the case that a Petitioner is unhappy with how Patent Owner characterizes the facts and law presented in the Petition. Our rules, however, provide for a Petitioner Reply only when good cause exists. Petitioner has not established good cause and as such, we do not authorize the filing of any Replies.

Upon review of the Patent Owner Preliminary Responses in the above cases and the arguments made by the parties, we do not authorize Petitioner to file Replies to the issues raised in the Patent Owner Preliminary Responses. Additionally, Petitioner’s substantive arguments raised in the email and/or the phone conference regarding the alleged failings of the Patent Owner Preliminary Responses will not be considered by the Board in reaching its Decisions on Institution in these cases.

ORDER

It is

ORDERED that Petitioner's request for authorization to file Replies to Patent Owner's arguments contained in the Patent Owner Preliminary Response is *denied*.

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