

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONTEL PRODUCTS CORPORATION,
Petitioner,

v.

GUY A. SHAKED INVESTMENTS LTD.,
Patent Owner.

IPR2020-01703
Patent 9,578,943 B2

Before FRANCES L. IPPOLITO, TIMOTHY J. GOODSON, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER

Denying Leave to File Reply to Preliminary Response
37 C.F.R. § 42.108(c)

On February 3, 2021, the panel held a conference call with counsel for Petitioner and Patent Owner to discuss Petitioner's request for leave to file a Reply to Patent Owner's Preliminary Response. John Artz and William Hurles participated on behalf of Petitioner. Jonathan Strang participated on behalf of Patent Owner. Patent Owner arranged for a court reporter to transcribe the call, and stated that it would file the transcript as an exhibit. Given the availability of a transcript, we will omit a recitation of the parties' arguments during the call.

Petitioner seeks to file a Reply to respond to what it characterizes as misleading applications of law and mischaracterizations of the prior art in the Preliminary Response. Pursuant to 37 C.F.R. § 42.108(c), a petitioner's request for leave to file a reply to the preliminary response must be supported by a showing of good cause. After considering the record in this proceeding and the arguments presented during the conference call, we determine that Petitioner has not demonstrated good cause for filing a Reply. We agree with Patent Owner that the points Petitioner seeks to make in its proposed Reply are either subjects that Petitioner should have developed in its Petition or issues that the Board is equipped to assess without further briefing during the preliminary phase of this proceeding. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute."); *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2015-00593, Paper 11, 3 (PTAB July 1, 2016) (denying leave to file pre-institution reply to respond to

alleged misstatements of fact and law in a preliminary response, reasoning that “[i]t 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.”).

Accordingly, it is

ORDERED that Petitioner’s request for leave to file a Reply to the Preliminary Response is *denied*.

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PETITIONER:

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