

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FITBIT, INC.,  
Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES, LLC  
Patent Owner.

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Case IPR2017-02012  
Patent 6,434,212 B2

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Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and  
CHRISTAP. ZADO, *Administrative Patent Judges*.

*Per Curiam.*

ORDER

*Granting Patent Owner's Request for Authorization to File Sur-Reply*  
*37 C.F.R. § 42.5*

IPR2017-02012  
Patent 6,434,212

In an e-mail dated October 11, 2018, Patent Owner (Blackbird Tech, LLC) requested the Board authorize filing of a sur-reply in IPR2018-02012 in conformance with the Trial Practice Guide Update, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (“Practice Guide”)<sup>1</sup>. In that same e-mail, Patent Owner set forth that Petitioner (FitBit, Inc.) opposed the filing of a sur-reply because Patent Owner had “failed to explain why it needed a Sur-Reply in this proceeding.” Alternatively, Petitioner requested that if a sur-reply were authorized, the Board should set a word limit of no more than 3,500 words.

Patent Owner’s request is granted. As set forth in our e-mail of October 15, 2018, we authorized Patent Owner to file a sur-reply of no more than ten pages, in accordance with the Practice Guide. We additionally set forth that the sur-reply had to be filed by October 25, 2018. We further noted Patent Owner’s sur-reply should conform with the guidance in the Practice Guide and particularly, the portions that discuss the content of sur-replies including:

The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. As noted above, a sur-reply may address the institution decision if necessary to respond to the petitioner’s reply.

Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23, except as noted above. To the extent that a reply or sur-reply “responds” to the

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<sup>1</sup> Available at [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf).

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institution decision as discussed above, “respond,” in the context of § 42.23(b), does not mean embark in a new direction with a new approach as compared to positions taken in a prior filing.

(Practice Guide, 14–15).

In consideration of the foregoing, it is hereby:

ORDERED that, in each case, Patent Owner is authorized to file a sur-reply not to exceed ten pages, in place of observations.

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