

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

R.J. REYNOLDS VAPOR COMPANY,

Petitioner.

v.

FONTEM HOLDINGS 1 B.V.,

Patent Owner.

Case IPR2018-00631 (Patent 9,339,062 B2)

Case IPR2018-00632 (Patent 9,326,550 B2)

Case IPR2018-00633 (Patent 9,326,551 B2)

Case IPR2018-00634 (Patent 9,456,632 B2)¹

Before GRACE KARAFFA OBERMANN, DONNA M. PRAISS,
JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and KIMBERLY
McGRAW, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Request for Authorization to File a Reply
37 C.F.R. § 42.23(a), § 42.100–108

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in each case. The parties are authorized to use this style heading when filing an identical paper in multiple proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

IPR2018-00631 (Patent 9,339,062 B2)
IPR2018-00632 (Patent 9,326,550 B2)
IPR2018-00633 (Patent 9,326,551 B2)
IPR2018-00634 (Patent 9,456,632 B2)

By email dated July 26, 2018, Petitioner requested authorization to file a Reply to the Preliminary Response in each proceeding. *See* Ex. 3001 (copy of email correspondence in IPR2018-00631²). A telephone conference was conducted on August 2, 2018, to discuss Petitioner's request. Judges Obermann, Praiss, Kokoski, Kalan, and McGraw, as well as Mr. Mallin (counsel for Petitioner) and Mr. Hamilton (counsel for Patent Owner), participated in the teleconference. Patent Owner retained a court reporter and agreed to file a copy of the transcript of the call as an exhibit in each proceeding. The transcript shall serve as the record of the call.

The parties shall refrain from submitting email correspondence to the Board that includes inappropriate legal or factual arguments. The emails submitted by Petitioner, in this instance, contain extensive attorney argument, and include case law as an attachment, which goes to the merits of the issues sought to be briefed. *See, e.g.,* Ex. 3001 (copy of email correspondence in IPR2018-00631). The emails go beyond the issue at hand; that is, whether "good cause" exists for authorizing a Reply. *Id.* Petitioner, in essence, submits an unauthorized brief in the form of an email, effectively obviating our requirement that a party must seek prior Board authorization for such a submission. *Id.* During the call, Petitioner agreed to refrain from presenting improper argument in any future emails submitted to the Board.

² Similar emails were submitted in each proceeding. Ex. 3001 is representative.

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We pointed out that, pursuant to our rules, Petitioner is not authorized to file a Reply as of right to the Preliminary Response. 37 C.F.R. §§ 42.100–108 (providing for filing of a Petition and a Preliminary Response, but no Reply, during the pre-institution stage of an *inter partes* review). Petitioner averred that the Preliminary Response raises issues that could not have been anticipated at the time of filing the Petition and, on that basis, argued that “good cause” exists for granting the unusual remedy of additional briefing at the preliminary stage of these proceedings.

Patent Owner, for its part, indicated that it does not oppose entry of the text of the email into the record of each proceeding. Further, Patent Owner twice confirmed that it would not seek an opportunity to present counter briefing, in the event that the text of the email is entered into the record. After conferring, the Board ruled that a copy of the email (Ex. 3001) shall be entered as an exhibit in each proceeding.

In light the above facts and circumstances, Petitioner’s request to file a Reply is *denied*.

It is

ORDERED that the parties shall refrain from including improper legal or factual arguments in emails to the Board;

FURTHER ORDERED that a copy of the representative email correspondence submitted in support of Petitioner’s request for authorization to file a Reply in IPR2018-00631 shall be entered into the record of each proceeding as Exhibit 3001;

IPR2018-00631 (Patent 9,339,062 B2)
IPR2018-00632 (Patent 9,326,550 B2)
IPR2018-00633 (Patent 9,326,551 B2)
IPR2018-00634 (Patent 9,456,632 B2)

FURTHER ORDERED that Petitioner's request to file a Reply is
denied in each proceeding; and

FURTHER ORDERED that no additional briefing is authorized at this
time.

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