

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUMA NORTH AMERICA, INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

Case IPR2019-01042
Patent 9,314,065 B2

Before MITCHELL G. WEATHERLY, AMANDA F. WIEKER, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Petitioner Puma North America, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6 of U.S. Patent No. 9,314,065 B2 (“the ’065 patent”). Paper 1 (“Pet.”). Nike, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). In its Preliminary Response, Patent Owner argues, *inter alia*, that the Board should exercise its discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a) and 35 U.S.C. § 325(d). Prelim. Resp. 26–41.

In this instance, the panel has determined that it would be helpful for the parties to provide additional briefing on the applicability of 35 U.S.C. § 314(a) and 35 U.S.C. § 325(d) to this case. Accordingly, Petitioner is authorized to file a five-page Reply, responding to Patent Owner’s arguments regarding 35 U.S.C. § 314(a) and 35 U.S.C. § 325(d), as set forth in pages 26–41 of the Preliminary Response. If Petitioner elects to file a Reply, it shall be filed no later than 5:00 PM Eastern Time, one week from the date of this Order.

In the event that Petitioner files a Reply, Patent Owner is authorized to file a five-page Sur-Reply, responding solely to Petitioner’s Reply arguments. If Patent Owner elects to file a Sur-Reply, it shall be filed no later than 5:00 PM Eastern Time, one week from the date of Petitioner’s Reply.

No additional briefing is authorized. Any portion of this briefing that is not responsive to arguments made regarding 35 U.S.C. §§ 314(a), 325(d) will not be considered. Additionally, no new evidence is permitted, without prior authorization, which may be sought by email to the Board, no later than two business days prior to the paper’s filing.

ORDER

Accordingly, in consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a Reply of no more than five pages, addressing Patent Owner's arguments regarding 35 U.S.C. §§ 314(a), 325(d);

FURTHER ORDERED that Petitioner shall file any such Reply by 5:00 PM Eastern Time, one week from the date of this Order;

FURTHER ORDERED that, if Petitioner files a Reply, Patent Owner is authorized to file a Sur-Reply of no more than five pages in length, addressing Petitioner's Reply arguments;

FURTHER ORDERED that Patent Owner shall file any such Sur-Reply by 5:00 PM Eastern Time, one week from the date of the Reply; and

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

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PETITIONER:

Vincent Rubino
Timothy Rousseau
Jacob Ostling
Mark Leonardo
Michael Vongaramvilai
vrubino@brownrudnick.com
trousseau@brownrudnick.com
jostling@brownrudnick.com
mleonardo@brownrudnick.com
mvongaramvilai@brownrudnick.com

PATENT OWNER:

Christopher Renk
Michael Harris
Janice Mitrius
Matthew Becker
Kurt Riester
Kevin Dam
crenk@bannerwitcoff.com
mharris@bannerwitcoff.com
jmitrius@bannerwitcoff.com
mbecker@bannerwitcoff.com
kriester@bannerwitcoff.com
kdam@bannerwitcoff.com