

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUEST USA CORP.,
Petitioner,

v.

POPSOCKETS LLC,
Patent Owner.

Case IPR2019-01067
Patent 9,958,107 B1

Before JESSICA C. KAISER and STACY B. MARGOLIES,
Administrative Patent Judges.

KAISER, *Administrative Patent Judge.*

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

A conference call in the above proceeding was held on September 5, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Kaiser and Margolies.¹ The call was requested by Petitioner to seek leave to file a reply to Patent Owner's Preliminary Response (Paper 8, "Prelim. Resp.") to address three issues: (1) Patent Owner's proposed constructions of "lock" and "secure," (2) Patent Owner's argument that the Board should exercise its discretion to deny institution under 35 U.S.C. 325(d), and (3) Patent Owner's argument that the preamble of the challenged claims is not limiting. Ex. 3001. Petitioner contends it could not reasonably have anticipated the need to address these issues in its Petition, and therefore has good cause for the requested reply. Patent Owner opposed Petitioner's request, arguing that Petitioner could have reasonably anticipated the need to address these issues in the Petition. We took the matter under advisement.

Upon further consideration and review of the materials cited by the parties, we determine that Petitioner has demonstrated good cause for a reply on the first issue, but not on the other two. *See* 37 C.F.R. § 42.108(c). We address each issue in turn.

First, Petitioner seeks to address in its reply Patent Owner's proposed constructions of the claim terms "lock" and "secure." Ex. 3001. In the Petition (Paper 2, "Pet."), Petitioner stated that the parties have fully briefed claim construction issues in a co-pending litigation, but that a hearing in the co-pending litigation was not scheduled until after the Petition was filed.

¹ A court reporter, retained by Petitioner, was present on the call. Petitioner agreed to file the transcript of the call as an exhibit in this proceeding once the transcript is available.

Pet. 23. Petitioner requested “that the plain and ordinary meaning be applied to all terms for the purposes of *inter partes* review.” *Id.* Petitioner also proposed constructions of four claim terms based on positions Patent Owner had taken in the co-pending litigation. *Id.* at 23–25 (citing Exs. 1016, 1017, 1018, 1019). The briefs from the co-pending litigation on which Petitioner relied here addressed only the four terms for which Petitioner proposed explicit constructions in the Petition, and did not address explicit constructions for “lock” and “secure.” *See* Exs. 1016, 1017, 1018, 1019.

In its Preliminary Response, Patent Owner proposed explicit constructions for “lock” and “secure,” in addition to addressing the four terms Petitioner raised in the Petition. Prelim. Resp. 7–11. In support of its proposed constructions of “lock” and “secure,” Patent Owner relies on the specification of the challenged patent as well as a dictionary definition of “secure.” *Id.* at 11 (citing Exs. 1001, 2007). Patent Owner did not point to prior positions in the co-pending litigation or other information suggesting that Petitioner should have been aware that Patent Owner would raise the construction of these terms in the Preliminary Response. *See id.*

Taking into account the arguments of the parties as well as the evidence of record, we determine Petitioner has shown good cause for us to authorize Petitioner to file a reply on the constructions of the terms “lock” and “secure.” Petitioner’s argument and evidence in its reply shall be limited to those in support of Petitioner’s proposed constructions of those terms as well as counter-arguments to Patent Owner’s proposed constructions. Petitioner may not present new argument or evidence in support of its unpatentability grounds in its reply. In other words,

Petitioner's reply on the constructions of "lock" and "secure" is not an opportunity to supplement the unpatentability grounds in the Petition, but rather an opportunity to explain further the "plain and ordinary meaning" of those terms as advocated in the Petition. *See* Pet. 23.

Second, we determine there is not good cause to authorize a reply as to Patent Owner's § 325(d) argument. Specifically, the prosecution history of the challenged patent is in the record (Ex. 1002). At this stage of the proceeding, we are able to determine whether Patent Owner has properly characterized the prior art and arguments that were previously before the Office and whether we should exercise our discretion under § 325(d) without further briefing by the parties.

Finally, on the issue of the preamble, Petitioner asserts it "wishes to note in the preliminary reply that it agrees the preamble may be treated as non-limiting for the purpose of inter partes review and the term 'expandable socket' does not require construction by the Board." Ex. 3001. We determine no briefing is necessary for a claim construction issue that is not in dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy").

For the reasons discussed above, Petitioner's request is granted-in-part and denied-in-part. During the conference call, Petitioner requested that if the authorized reply was confined to the claim construction issues, the reply be due within two weeks and be limited to ten pages. Patent Owner requested the same amount of time and pages for a sur-reply.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a reply to Patent Owner's Preliminary Response is granted-in-part and denied-in-part;

FURTHER ORDERED that Petitioner's reply shall be limited to Petitioner's proposed constructions of the claim terms "lock" and "secure," shall be filed no later than September 20, 2019, and shall not exceed ten pages; and

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply limited to the scope of Petitioner's reply, no later than October 4, 2019, and not to exceed ten pages.

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