

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

IPR2020-00470
Patent 7,949,752 B2

Before THOMAS L. GIANNETTI, JENNIFER MEYER CHAGNON, and
JOHN R. KENNY, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request for Additional Briefing
37 C.F.R. § 42.5; 37 C.F.R. §42.108(c)

In an email dated May 26, 2020, Petitioner requested a conference call with the Board to request authorization to file a reply to Patent Owner's Preliminary Response, in order to address the factors laid out in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). Petitioner's email indicates that Patent Owner opposes the request. The panel has considered Petitioner's request, and a conference call is not necessary at this time.

Fintiv identifies a non-exclusive list of factors the Board considers when determining whether a related, parallel district court action provides any basis for discretionary denial under 35 U.S.C. § 314(a), and particularly in view of *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). See *Fintiv*, Paper 11, at 5–6. Patent Owner addresses the *Fintiv* factors in its Preliminary Response. See Paper 7, at 8–16. *Fintiv* issued on March 20, 2020 and was designated precedential on May 5, 2020. The Petition here was filed on February 10, 2020. Given this timing, Petitioner could not have addressed the *Fintiv* factors in the Petition.

We determine that there is good cause in this instance for Petitioner to file a reply to the Preliminary Response, and that further briefing addressing the *Fintiv* factors would be helpful to the Board in deciding whether to exercise discretion to deny institution under 35 U.S.C. § 314(a). See 37 C.F.R. §42.108(c) ("A petitioner may seek leave to file a reply to the preliminary response . . . Any such request must make a showing of good cause."). We also authorize Patent Owner to file a sur-reply to address the issues raised in Petitioner's reply.

We note that Petitioner's email refers to a stipulation concerning its arguments in the co-pending district court litigation. Before considering this stipulation, the panel requests that Petitioner show it has filed the stipulation with the district court.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a preliminary reply of no more than ten (10) pages within five (5) business days after the entry of this order, addressing the *Fintiv* factors; and

FURTHER ORDERED that Patent Owner is authorized to file a preliminary sur-reply of no more than ten (10) pages within five (5) business days after Petitioner files its preliminary reply, addressing the issues raised in Petitioner's preliminary reply.

IPR2020-00470
Patent 7,949,752 B2

FOR PETITIONER:

Katherine Vidal
Louis Campbell
Michael Tomasulo
Winston & Strawn LLP
kvidal@winston.com
llcampbell@winston.com
mtomasulo@winston.com

FOR PATENT OWNER:

Byron L. Pickard
Daniel S. Block
James R. Hietala
Lestin Kenton
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
bpickard-ptab@sternekessler.com
dblock-ptab@sternekessler.com
jhietala@intven.com
lkenton-ptab@sternekessler.com