

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

IMPLICIT, LLC,
Patent Owner.

IPR2020-00585, IPR2020-00586, IPR2020-00587,
IPR2020-00590, IPR2020-00591, and IPR2020-00592¹

Before THOMAS L. GIANNETTI, BARBARA A. PARVIS,
SHEILA F. McSHANE, and NABEEL U. KHAN,
*Administrative Patent Judges.*²

PARVIS, *Administrative Patent Judge.*

ORDER

Authorizing Reply to Preliminary Response And Sur-reply
37 C.F.R. § 42.20

¹ The patents are U.S. Patent Nos. 8,694,683 B2, 9,270,790 B2, 9,591,104 B2, 10,027,780 B2, 10,033,839 B2, and 10,225,378 B2. The parties may not use this caption for any subsequent papers without prior Board authorization.

² This is not an order from an expanded panel of the Board. Administrative Patent Judges of each of the three-member panels from all the respective proceedings are listed.

IPR2020-00585 (Patent 8,694,683 B2)
IPR2020-00586 (Patent 9,270,790 B2)
IPR2020-00587 (Patent 9,591,104 B2)
IPR2020-00590 (Patent 10,027,780 B2)
IPR2020-00591 (Patent 10,033,839 B2)
IPR2020-00592 (Patent 10,225,378 B2)

BACKGROUND

The Petitions and Preliminary Responses filed in these cases addressed arguments relating to 35 U.S.C. § 325(d). *See, e.g.*, IPR2020-00585, Paper 1, 13–15; IPR2020-00585, Paper 6, 8–19. For instance, in its Preliminary Responses, Implicit, LLC, (“Patent Owner”) asserted that we should exercise our discretion and deny institution under 35 U.S.C. § 325(d). *See, e.g.*, IPR2020-00585, Paper 6, 8–19. Juniper Networks, Inc. (“Petitioner”) appeared to anticipate those arguments and, therefore, addressed § 325(d) in its Petitions. *See, e.g.*, IPR2020-00585, Paper 1, 13–15.

In an email of May 19, 2020, Petitioner requested leave to file a reply of no more than seven pages to Patent Owner’s Preliminary Response to address further the § 325(d) issues. We held a call with the parties on May 21, 2020 to consider Petitioner’s request. Patent Owner opposes Petitioner’s request as unnecessary because the Petitions sufficiently addressed the § 325(d) issue. However, Patent Owner requests authorization to file a sur-reply of the same length in each of the proceedings if Petitioner’s request is granted, with briefing limited to five pages for both Petitioner and Patent Owner.

On March 24, 2020, the Board designated *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469 (PTAB Feb. 13, 2020) (Paper 6) as precedential. Because *Advanced Bionics* changed the analytical framework applied under 35 U.S.C. § 325(d), and the Petitions were filed prior to the case being designated as precedential, we determine

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that permitting the parties to submit additional briefing on this matter would be in the interests of justice and would also be helpful to the panel. *See* 37 C.F.R. § 42.20(d). In light of the similarities of the patents and issues among these cases, Petitioner and Patent Owner are instructed to file the same paper in all proceedings, i.e., IPR2020-00585, -586, -587, -590, -591, and -592 and are required to use this Order's case caption format.

During the call, the parties also indicated that a motion to transfer was granted in the district court proceeding identified in the parties' mandatory notices. The parties are reminded of their obligations to file updated mandatory notices identifying any judicial or administrative matter that would affect, or be affected by, a decision in the instant proceedings. 37 C.F.R. § 42.8 (b)(2). The parties also are reminded of their obligation to file motions for admission *pro hac vice* for backup counsel that are not registered practitioners. *See* 37 C.F.R. § 42.10 (c).

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ORDER

Accordingly, it is hereby:

ORDERED that Petitioner is authorized to file in each of these proceedings, within 14 days of this Order, a Reply Brief of no more than seven pages limited to addressing 35 U.S.C. § 325(d) issues raised by the Preliminary Response and consistent with the foregoing instructions; and

FURTHER ORDERED that, within 14 days of Petitioner's Reply Brief, Patent Owner may file, in each of these proceedings, a Sur-reply Brief of no more than seven pages limited to arguments raised in Petitioner's Reply Brief and consistent with the foregoing instructions.

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