

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C., DISH TECHNOLOGIES L.L.C.,
and SLING TV L.L.C.,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

IPR2020-01276
Patent 6,757,796 B1

Before DEBRA K. STEPHENS, JOHN A. HUDALLA, and
KAMRAN JIVANI, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.108

On December 7, 2020, Petitioner emailed the Board requesting authorization to file a four-page reply to address certain arguments in Patent Owner's Preliminary Response (Paper 8, "Prelim. Resp.") related to IPR2020-00969. In particular, Patent Owner puts forth arguments based on collateral estoppel and 35 U.S.C. § 325(d) that are related to the Board's Decision Denying Institution of *Inter Partes* Review in IPR2020-00969.

Prelim. Resp. 26–31. Petitioner contends good cause exists to grant Petitioner’s request because the Decision Denying Institution in IPR2020-00969 issued between the filing of the Petition and the Preliminary Response in this case.

Patent Owner wrote a separate email on December 7, 2020, to indicate that it does not believe good cause exists to authorize a reply. Nevertheless, Patent Owner indicated that it would not oppose Petitioner’s request provided that (1) Patent Owner is authorized to file a sur-reply; and (2) the reply and sur-reply are limited to four pages and to the issues of collateral estoppel and § 325(d).

37 C.F.R. § 42.108(c) states that a petitioner “may seek leave to file a reply to the preliminary response” and that “[a]ny such request must make a showing of good cause.” In view of § 42.108(c), we may authorize a reply under our authority to “enter non-final orders to administer the proceeding.” 37 C.F.R. § 42.5(a). The panel believes it will be helpful for the parties to further address the impact, if any, of the Decision Denying Institution in IPR2020-00969. Given the potentially dispositive nature of the issues raised by Patent Owner, we find that Petitioner has established good cause for further briefing.

Therefore, we authorize Petitioner to file a reply limited to addressing Patent Owner’s arguments based on collateral estoppel and § 325(d) in the Preliminary Response. We also authorize Patent Owner to file a sur-reply limited to responding to Petitioner’s reply. The reply and sur-reply will each be limited to four pages. The deadlines for filing the reply and sur-reply are set forth in the Order below.

ORDER

It is

ORDERED the Petitioner is authorized to file a reply of no more than four pages limited to addressing Patent Owner's arguments based on collateral estoppel and 35 U.S.C. § 325(d) in the Preliminary Response;

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply of no more than four pages limited to addressing the arguments and assertions in Petitioner's reply; and

FURTHER ORDERED that Petitioner's reply is due one week from the date of this Order, and Patent Owner's sur-reply is due one week from the filing of Petitioner's reply.

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