

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELEBRANDS CORP.,
Petitioner,

v.

TINNUS ENTERPRISES, LLC,
Patent Owner.

Case PGR2017-00040
Patent 9,682,789 B2

Before MICHAEL W. KIM, FRANCES L. IPPOLITO, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

I. DISCUSSION

A conference call in the above proceeding was held on December 11, 2017 between the parties' counsels and Judges Kim, Ippolito, and Cherry.¹ On the call, Petitioner, Telebrands Corporation, requested authorization to file a reply to the Patent Owner's Preliminary Response. Petitioner argued that good cause exists to grant its request because, among other things, it seeks to address whether the Board should exercise its discretion under 35 U.S.C. §325(d) based on informative decisions that were designated informative after the filing of the Petition. *See Unified Patents, Inc. v. Berman*, Case IPR2016-01571 (PTAB Dec. 14, 2016) (Paper 10); *Hospira, Inc. v. Genentech, Inc.*, Case IPR2017-00739 (PTAB July 27, 2017) (Paper 16); and *Cultec, Inc. v. Stormtech LLC*, Case IPR2017-00777 (PTAB Aug. 22, 2017) (Paper 7). More specifically, in its requested reply, Petitioner explained that it seeks to address whether a certain reference relied upon in the Petition is cumulative of references reviewed by the Examiner during prosecution of U.S. Patent 9,682,789 B2. Patent Owner opposed Petitioner's request.

We determined on the call that, under the circumstances of this case, Petitioner has not shown good cause for its request. *See* 37 C.F.R. §42.208(c). As discussed, Petitioner has already addressed §325(d) in the Petition, on pages 88–89, in a section titled “This Petition Contains New Arguments Not Previously Presented to the USPTO.” Furthermore, Petitioner has now made of record their position that a certain reference relied upon in the Petition is not cumulative of references reviewed by the

¹ A full transcript of the conference call will be filed by the parties as an exhibit. Ex. 2023.

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Examiner during prosecution, a position we will take into consideration.

Thus, to the extent that the parties dispute whether the Board should exercise its discretion under §325(d), these respective positions have been briefed by the parties and entered in the record. Pet. 88–89; *see* Prelim. Resp. 2–6.

Accordingly, we deny Petitioner’s request.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for authorization to file a reply to Patent Owner’s Preliminary Response is *denied*.

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