

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INVUE SECURITY PRODUCTS, INC.,
Petitioner,

v.

MOBILE TECH, INC.,
Patent Owner.

Case PGR2019-00019
Patent 10,026,281 B1

Before RAMA G. ELLURU, TERRENCE W. McMILLIN, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

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

On May 9, 2019, a conference call was held between counsel for the parties and Judges Elluru, McMillin, and Galligan. This teleconference was set up in response to an email received from Petitioner's counsel, David Moreland, on May 8, 2019, that said:

Recent decisions by the Board have relied on discretion solely to reject petitions based on perceived lack of specificity in the stated grounds. Petitioner InVue submits that the present PGR petition is narrowly tailored to five (5) distinct grounds. However, because Patent Owner MTI's preliminary response characterizes the grounds as being voluminous and incorporating undisclosed references, InVue requests authorization to file at most a two-page reply before Friday, May 10 to explain why such assertions are not correct. InVue submits that such a limited request will not affect the Board's ability to render a timely Institution Decision, which is due June 6.

InVue has conferred with MTI on the above. MTI objects to the submission of this reply and requests a conference call to discuss to the extent the Board is considering to allow it.

Ex. 3001. In this email, Petitioner requests authorization to file a reply to Patent Owner's Preliminary Response. The email also indicates the parties have conferred and that Patent Owner objects to the submission of the reply. These positions of the parties were confirmed during the teleconference. Argument from counsel for both parties was heard and considered.

Under 37 C.F.R. § 42.208(c), "A petitioner may seek leave to file a reply to the preliminary response in accordance with §§42.23 and 42.24(c). Any such request must make a showing of good cause." For the following reasons, Petitioner has not established good cause for filing a reply to the Preliminary Response.

The Petition was filed on November 21, 2018. The Preliminary Response was filed on March 6, 2019, which was over 2 months before Petitioner's request to file a reply was made. The statutory deadline to issue a decision on whether to institute a post-grant review in response to the Petition is June 6, 2019, which is less than 1 month from when Petitioner's request for a reply was made. 35 U.S.C. § 324(c) (a determination whether to institute a post-grant review shall be made within 3 months after a preliminary response is filed). 37 C.F.R. § 42.25 provides, "[a] party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought." Petitioner was unable to provide any satisfactory explanation as to why its request was not made earlier.

Furthermore, during the teleconference with the parties, counsel for Petitioner indicated that additional briefing is appropriate in view of recent Board decisions denying institution. However, the requirement for specificity in petitions, which is the issue Petitioner wishes to address in a reply, has been in effect since AIA post-issuance reviews began. The relevant statute provides that a determination whether to institute a post-grant review shall be made based on "the information presented in the petition." 35 U.S.C. § 324(a). In addition, 35 U.S.C. § 322(a)(3) provides that the petition identify "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 37 C.F.R. § 42.22(a)(2) provides that each petition include, "[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law,

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rules, and precedent.” *See also* 37 C.F.R. § 42.204. Thus, Petitioner did not provide any satisfactory reason why it needs a reply.

The Board considers the request for authorization to file a reply to the Preliminary Response to be untimely. Additionally, the Board considers a reply to be unnecessary. We determine that no good cause has been shown for granting Petitioner’s request.

Upon consideration thereof,

it is ORDERED that:

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

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