

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ICE CASTLES, LLC
Petitioner,

v.

JAMES YOUNGSTROM,
Patent Owner.

IPR2021-01179
Patent 10,663,204 B2

Before TIMOTHY J. GOODSON, BRENT M. DOUGAL, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER

Denying and Expunging Petitioner's Motion for Leave to File Reply
37 C.F.R. §§ 42.5(a), 42.7(a), 42.20(b)

Petitioner filed a Motion for Leave to File Reply to Patent Owner Preliminary Response. Paper 7 (“Mot.”). In the Motion, Petitioner notes that the Preliminary Response challenged the sufficiency of Petitioner’s showing that one of the asserted references, “Instructables,” qualifies as prior art. Mot. 2 (citing Paper 5, 5). The Motion “requests leave to submit additional evidence that Instructables was publicly available in 2012.” *Id.* In particular, the proposed reply would submit archived webpages, which are attached as Exhibits A and B to the Motion. Petitioner did not contact the Board before filing its Motion, and the Motion does not indicate whether Petitioner conferred with Patent Owner regarding the Motion.

The Board’s rules provide 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.” 37 C.F.R. § 42.108(c); *see also* Consolidated Trial Practice Guide, at 51–52 (Nov. 2019)¹ (“CTPG”) (same). The manner for seeking authorization to file a paper that is not pre-authorized by the Board’s rules is to contact the Board and arrange for a conference call with the Board and opposing party. CTPG at 37, 75; *see also id.* at 9–10 (setting forth the procedure for arranging a conference call with the Board). Here, Petitioner did not follow that procedure and instead simply filed a motion that attached the very material for which authorization to file is purportedly being sought. This self-help strategy frustrates the Board’s ability to manage the record of the proceeding. *See* 37 C.F.R. § 42.7.

Because the Motion was not authorized and contains the new evidence that Petitioner seeks leave to file, we expunge the Motion. *See* 37 C.F.R. § 42.7(a) (“The Board may expunge any paper directed to a proceeding . . .

¹ *Available at* www.uspto.gov/TrialPracticeGuideConsolidated.

that is not authorized . . .”), § 42.20(b) (“A motion will not be entered without Board authorization.”). If Petitioner wishes to file a reply to the Preliminary Response, Petitioner should confer with Patent Owner regarding that request, and then send an email to the Board (Trials@uspto.gov) to request a conference call. If Patent Owner opposes Petitioner’s request, Patent Owner should be prepared to explain why denying authorization would be consistent with *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential). There, the Board explained that a petitioner has limited opportunities after its petition to present new evidence regarding whether a reference qualifies as prior art, including in a reply to a preliminary response. *Id.* at 13–14.

It is hereby:

ORDERED that Petitioner’s Motion is denied without prejudice to allow Petitioner to seek the same relief after following the procedures outlined above; and

FURTHER ORDERED that Petitioner’s Motion is expunged.

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