

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXTRACTIONTEK SALES LLC,
Petitioner,

v.

GENE POOL TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-01011
Patent 9,144,751 B2

Before JEFFREY N. FREDMAN, CYNTHIA M. HARDMAN, and
JAMIE T. WISZ, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion to Excuse Late Filing
37 C.F.R. § 42.5(c)(3)

Patent Owner Gene Pool Technologies, Inc. filed an authorized Motion to Excuse Late Filing of its Patent Owner Response. Paper 21 (“Mot.”). Petitioner ExtractionTek Sales LLC filed a Response, opposing Patent Owner’s motion. Paper 22 (“Resp.”). After considering the arguments and evidence of record, we grant Patent Owner’s Motion because it is in the interests of justice to consider the Patent Owner Response.

Our rules provide for excusing a late action “on a showing of good cause *or* upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3) (emphasis added). Here, Patent Owner does not appear to attempt to establish good cause for its late filing, but rather asks that we excuse the late filing “in the interests of justice.” Mot. 1; *see also id.* at 4 (arguing that “[c]onsideration on the merits of Patent Owner’s Response and Exhibits would be in the interests of justice”). Nevertheless, for completeness, we begin by explaining why Patent Owner has not established good cause for filing its Patent Owner Response one day after the deadline.

As Petitioner points out, in its Motion “Patent Owner fails to actually state why it filed its Patent Owner Response late.” Resp. 3. Patent Owner instead argues that Petitioner’s “untimely actions, lack of preparation, and recalcitrance contributed at least in part to Patent Owner’s difficulty in finalizing its Response.” Mot. 1; *see also id.* at 5. In particular, Patent Owner recounts that on December 21, 2022, it asked Petitioner to provide a date during the week of January 9–13 when Petitioner’s declarant, Mr. Chess, would be available for deposition. *Id.* at 1; *see also* Ex. 2005, 12. Petitioner responded eight days later, on December 29, 2022, indicating that Mr. Chess was generally available that entire week. Ex. 2005, 11.

Patent Owner contends that “Petitioner’s delay in providing the availability of Mr. Chess for deposition in this IPR and IPR2022-00832 left only January 13th as a date for which Patent Owner could even potentially file timely notice under 37 CFR § 42.53(d)(4).” Mot. 3. Patent Owner further argues that “forcing Patent Owner to select January 13th as the deposition date for Mr. Chess meant that [Patent Owner] had only recently received the final deposition transcript.” *Id.* Patent Owner additionally recounts the parties’ communications concerning Patent Owner’s request to stipulate to a 2-day extension of DUE DATE 1 (from January 20, 2023 to January 23, 2023), with a concomitant extension of DUE DATE 2. *Id.* at 2–3.

To the extent Patent Owner suggests that Petitioner’s actions with respect to scheduling the Chess deposition or stipulating to change DUE DATES 1 and 2 contributed to Patent Owner’s late action, we are not persuaded. Patent Owner has not persuasively established that *Petitioner’s* actions “forc[ed] Patent Owner to select January 13th as the deposition date for Mr. Chess.” *Id.* at 3. After all, Patent Owner expressly requested Mr. Chess’s availability for dates including January 13th—the very date it now claims it was “forc[ed]” to accept. *See* Ex. 2005, 12–13. Additionally, we observe that Petitioner took eight days to respond to Patent Owner’s request for Mr. Chess’s availability, while Patent Owner took seven days to respond to Petitioner’s request for Dr. Miller’s availability. *Compare* Ex. 2005, 12–13 (Mr. Emde’s Dec. 20 request for dates for Dr. Miller’s deposition) and 11–12 (Mr. Owen’s Dec. 27 response), *with id.* at 12 (Mr. Owens’s Dec. 21 request for dates for Mr. Chess’s deposition) and 11 (Mr. Emde’s Dec. 29 response). Given the parties’ similar response

times—which notably took place amidst the holidays that fall in late December—on this record Patent Owner fails to adequately explain why Petitioner’s actions were “untimely.” Mot. 1. Nor has Patent Owner adequately explained how the parties’ communications regarding the requested extension of DUE DATES 1 and 2 contributed to Patent Owner’s late action.

Patent Owner also suggests that the timing of Petitioner’s January 12, 2023, deposition (in IPR2022-00625) of Patent Owner’s declarant, Dr. Miller, “cut into [Dr. Miller’s] availability to assist in finalizing the Patent Owner’s Response[.]” Mot. 3. Patent Owner, however, fails to explain why it offered Dr. Miller for deposition on January 12—a date it now claims allegedly interfered with Dr. Miller’s ability to assist in this IPR. *See* Ex. 2005, 11–12 (Mr. Owens’s Dec. 27 email offering Dr. Miller for deposition on Jan. 11–13, 16, or 17). Indeed, Patent Owner offered dates (January 16, 17) even closer to January 20, 2023—the original due date for the Patent Owner Response—which further undercuts any argument that Petitioner’s actions with respect to Dr. Miller’s deposition are to blame for Patent Owner’s late filing. *See id.*

Patent Owner contends that “Petitioner is not prejudiced by the delay.” Mot. 1. Petitioner disputes this, arguing that it incurs additional legal fees in having to respond to Patent Owner’s late filings, and is prejudiced in having to follow rules that Patent Owner is permitted to violate.¹ Resp. 4–5.

¹ Petitioner requests that the Board sanction Patent Owner by expunging the Patent Owner Response, prohibiting Patent Owner from filing any additional response, and awarding Petitioner attorneys fees and costs. Resp. 4–5. We

Patent Owner does not persuade us that its delay caused Petitioner no prejudice. At a minimum, Patent Owner's delay has unilaterally shortened Petitioner's time to prepare and file its Reply. Patent Owner's delay is also contrary to the Board's efforts to secure a just, speedy, and inexpensive resolution of this proceeding, including by increasing Petitioner's fees for having to respond to Patent Owner's late actions. *See* 37 C.F.R. § 42.1(b). Petitioner, however, does not persuade us that it is prejudiced by having to follow the Board's rules, which is something it willingly ceded to in electing to petition for *inter partes* review.

Notwithstanding any prejudice to Petitioner, under the circumstances here we find that consideration of the Patent Owner Response is in the interests of justice. On balance, the prejudice to Petitioner from Patent Owner's one-day delay is relatively minimal, particularly in view of our ability to adjust the schedule, as discussed below. The prejudice to Patent Owner from striking the Patent Owner Response, on the other hand, would be significant, because Patent Owner would lose an opportunity to substantively address the patentability issues in this proceeding. Striking the Patent Owner Response may also make it more difficult for the Board to properly decide the merits of this proceeding.

decline to expunge the Patent Owner Response for the reasons discussed below. Moreover, Petitioner's Response is not the appropriate vehicle to seek sanctions. Petitioner has not requested authorization to file a motion for sanctions, nor have we authorized such a motion. *See, e.g.*, Consolidated Trial Practice Guide, 37 (regarding obtaining authorization to file a motion); 37 C.F.R. § 42.11(d)(2) (regarding a motion for sanctions); 37 C.F.R. § 42.12 (regarding sanctions).

Under the circumstances of this case, we find any prejudice to Petitioner's ability to timely prepare its Reply caused by Patent Owner's one-day delay in filing the Patent Owner Response can be remedied by modifying the Scheduling Order. Accordingly, we hereby extend DUE DATE 2 in the Scheduling Order (Paper 13), as amended by the parties' stipulation (Paper 19), from the stipulated date of April 17, 2023 to April 18, 2023. *See* 37 C.F.R. §§ 42.5(a), (c)(1). This extension strikes a balance between excusing Patent Owner's late action and restoring Petitioner's full allotment of time to prepare its Reply. We recognize that this action shortens the time originally allotted to Patent Owner to prepare its Sur-reply, but Patent Owner enjoyed an extra day to prepare its Patent Owner Response, and under the circumstances it is appropriate for Patent Owner, not Petitioner, to bear the consequences of its late action.

For the reasons above, we excuse Patent Owner's late filing in this instance because it is in the interests of justice to consider the Patent Owner Response. Patent Owner, however, is strongly cautioned to strictly comply with all remaining case deadlines, and is warned that further late action may not be excused and may result in sanctions, which may include expunging any late filings. *See* 37 C.F.R. § 42.12.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's motion to excuse the late filing of the Patent Owner Response (Paper 20) is *granted*; and

FURTHER ORDERED that DUE DATE 2 in the Scheduling Order (Paper 13), as amended by the parties' stipulation (Paper 19), is extended from the stipulated date of April 17, 2023 to April 18, 2023; and

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FURTHER ORDERED that no other dates in the Scheduling Order are extended at this time.

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