

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAYLOR MADE GOLF COMPANY, INC.,
Petitioner,

v.

PARSONS XTREME GOLF, LLC,
Patent Owner.

Case IPR2018-00675 (Patent 9,199,143 B1)¹
Case IPR2018-00702 (Patent 8,961,336 B1)

Before NEIL T. POWELL, TIMOTHY J. GOODSON, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Granting Motions to Excuse Late Filings
37 C.F.R. § 42.5

¹ This Decision applies to each of the listed cases. We exercise our discretion to issue one Decision to be docketed in each case. The parties are not authorized to use a multi-proceeding caption.

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Patent Owner has filed motions in IPR2018-00675 and IPR2018-00702 to excuse its late filing of the Preliminary Responses and supporting exhibits in those proceedings. *See generally* IPR2018-00675, Paper 6 (“’675 Mot.”); IPR2018-00702, Paper 11 (“’702 Mot.”). Petitioner Taylor Made Golf Company, Inc., opposes Patent Owner’s motions. IPR2018-00675, Paper 15 (“’675 Opp.”); IPR2018-00702, Paper 13 (“’702 Opp.”). Our Rules provide that a “late action will be excused upon a showing of good cause or upon a Board decision that consideration of the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

Patent Owner represents in its Motion that it did not attempt to begin filing its Preliminary Response and related papers in IPR2018-00675 until 11:20 PM on June 12, 2018, and that it did not actually begin uploading these documents until 11:36 PM—only 24 minutes before the midnight filing deadline. ’675 Mot. 1–2. Patent Owner filed its Preliminary Response and 13 of the supporting exhibits prior to midnight, but supporting exhibits 2014 and 2015 were not filed until 12:13 AM on June 13, 2018, which is after the filing deadline. *Id.* at 2. Patent Owner represents that the Preliminary Response and all supporting exhibits were served on counsel for Petitioner not later than 12:44 AM on June 13, 2018. *Id.*

Patent Owner represents that the Preliminary Response in IPR2018-00702 was not ready to file until approximately 11:57 PM on June 12, 2018. ’702 Mot. 2. Patent Owner filed its Preliminary Response at 12:01 AM on June 13, 2018, and did not complete filing the supporting exhibits until 12:36 AM. *Id.* Patent Owner represents that its Preliminary Response and supporting exhibits all were served on Petitioner not later than 12:54 AM on June 13, 2018. *Id.*

Petitioner argues in response that Patent Owner cannot demonstrate good cause sufficient to excuse its late filings because the delays were caused by “miscalculations” on the part of Patent Owner’s counsel, and not by factors outside of Patent Owner’s control. *See* ’675 Opp. 2–3; ’702 Opp. 2–3. Petitioner argues that Patent Owner cannot demonstrate that permitting its late filings would be in the interests of justice because the filing of preliminary responses is optional, and Patent Owner will have the opportunity to raise its arguments after institution in its Patent Owner Responses. *See* ’675 Opp. 3; ’702 Opp. 3. Petitioner also alleges that it was prejudiced by having to communicate with Patent Owner’s counsel regarding late filings, being required to engage in a conference call with the Board, and needing to brief this issue. ’675 Opp. 4, ’702 Opp. 4. Petitioner further alleges that Patent Owner’s motion violates the formatting requirements of 37 C.F.R. § 42.6(a)(2)(iii), and that Patent Owner’s motions would have exceeded the 5-page limit had Patent Owner complied with these formatting requirements. ’675 Opp. 5; ’702 Opp. 5.

We agree with Petitioner that Patent Owner cannot establish good cause for its late filings. Patent Owner had three months of time within which to prepare its Preliminary Responses and supporting exhibits, and yet did not finish drafting its Preliminary Responses until less than 30 minutes before the filing deadline. Patent Owner has not offered any sufficient justification for this delay.

On this record, however, we find that Petitioner suffered no prejudice resulting from Patent Owner’s late filing. It is undisputed that the Preliminary Responses and all supporting exhibits were served on Petitioner within one hour of the filing deadline. The prejudice Petitioner alleges resulted from Petitioner’s

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decision to contest Patent Owner's late filings, and not from the late filings themselves.

Under the facts and circumstances present here, we determine that it would be in the interests of justice to consider Patent Owner's Preliminary Responses and supporting exhibits in our decisions on institution. Institution decisions that consider Patent Owner's arguments will benefit both parties by providing clarity as to the Board's view of the evidence and arguments.

The parties are cautioned, however, that the Board expects compliance in the future with all deadlines, page limits, word limits, and formatting requirements.

Accordingly, it is:

ORDERED that Patent Owner's motions to excuse its late filings (IPR2018-00675, Paper 13; IPR2018-00702, Paper 11) are *granted* pursuant to 37 C.F.R. § 42.5(c)(3), and the Board will treat Patent Owner's Preliminary Responses and supporting exhibits in IPR2018-00675 and IPR2018-00702 as if they had been timely filed.

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