

From: [Alemanni, John](#)
To: [Dutta, Sanjeet K](#); [Trials](#)
Cc: [Sanders, Carl](#); [Morlock, Michael](#); [Dabbieri, Courtney](#); [Adkins, Robin](#); [Kline, Douglas J](#); [Reddy, Srikanth K](#); [Birbach, Naomi](#); [Larochelle, Christie](#); [Woo, Darryl M](#)
Subject: RE: IPR2023-00199, 00220, 00221, and 00254
Date: Thursday, April 6, 2023 8:14:45 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)

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Dear Trials:

Petitioner's argumentative email is improper and omits several relevant facts. Most importantly and contrary to the assertions in Petitioner's email, there are no factual misstatements in the POPRs.

As the Petition acknowledges, Samsung SDS is a Real Party in Interest ("RPI") of Petitioners. Thus, while Patent Owner produced the emails, Petitioner was aware or should have been aware of its own RPI's correspondence with Patent Owner. Further, the correspondence in the exhibits evidences that Petitioner's RPI, Samsung SDS, praised Patent Owner's inventions in emails to the inventor. Petitioner should have addressed this objective evidence of non-obviousness in the Petition.

Should the Board wish to convene a conference call, Patent Owner will confer with Petitioner regarding this request and to find mutually-available dates and times. Further, should the Board consider Petitioner's request, Patent Owner would request a sur-reply of equal length.

Sincerely,
John Alemanni
Lead Counsel for Patent Owner

John Alemanni
Kilpatrick Townsend & Stockton LLP
Suite 1400 | 4208 Six Forks Road | Raleigh, NC 27609
office 919 420 1724 | cell 336 580 5448 | fax 919 420 1800
jalemanni@kilpatricktownsend.com | [My Profile](#) | [vCard](#)

From: Dutta, Sanjeet K <SDutta@goodwinlaw.com>
Sent: Thursday, April 6, 2023 6:13 PM
To: Trials <Trials@USPTO.GOV>
Cc: Sanders, Carl <csanders@kilpatricktownsend.com>; Morlock, Michael <MMorlock@kilpatricktownsend.com>; Dabbieri, Courtney <CDabbieri@kilpatricktownsend.com>;

Adkins, Robin <RAdkins@kilpatricktownsend.com>; Kline, Douglas J <DKline@goodwinlaw.com>; Reddy, Srikanth K <SReddy@goodwinlaw.com>; Birbach, Naomi <NBirbach@goodwinlaw.com>; Larochelle, Christie <CLarochelle@goodwinlaw.com>; Woo, Darryl M <DWoo@goodwinlaw.com>; Alemanni, John <jalemanni@kilpatricktownsend.com>

Subject: IPR2023-00199, 00220, 00221, and 00254

Dear Board,

We write on behalf of Petitioners in IPR2023-00199, 00220, 00221, and 00254. Patent Owner filed its preliminary responses in each of these matters. Petitioner hereby requests a conference call with the panel and patent owner to request additional briefing (5 pages) to reply to factual misstatements in the Patent Owner's preliminary responses.

Patent Owner states that "while Petitioners alleged they were not aware of any secondary considerations ..., Petitioners have produced evidence under a protective order in the parallel ITC proceeding demonstrating Petitioners at least knew of evidence of industry praise directly tied to the claimed invention and had the evidence in their possession before filing...." See '595 POPR, p. 13 and '322 POPR, p. 12. MRI makes similar statements at the following pages:

- '595 POPR, pp. 1-2, 7 and 15
- '322 POPR, pp. 1-2, 7 and 15
- '142 POPR, pp. 1 and 18,19, and
- '740 POPR, pp. 1 and 17-18.

In each of these POPRs, MRI cites to two emails sent from Romulus Stoain of Samsung SDS America to Bill Dunn of MRI in April and May of 2020. Bates Nos. MRI-ITC-1331_0000435123-24, and MRI-ITC-1331_0000435125-127. Patent Owner produced these documents two months after the filing of the petitions -- Petitioners did not produce these documents. Further, Mr. Stoain was employed by Samsung SDS America and has never been an employee of the Petitioners. MRI has not cited any evidence that Petitioners were aware of these documents prior to their production by MRI on January 20, 2023.

On March 29, 2023 Petitioner communicated with Patent Owner requesting that they correct these misstatements. Patent Owner declined to do so, stating "there are no factual errors in the POPRs" on March 30, 2023. Petitioners request 5 pages of additional briefing to address these misstatements and clarify the record for the panel. Petitioners are available at any date/time that is convenient for the panel to conduct the conference call.

Regards,

Sanjeet K. Dutta
Partner



Goodwin Procter LLP
601 Marshall Street
Redwood City, CA 94063
o +1 650 752 3260
m +1 408 644 4064
f +1 650 471 6056
SDutta@goodwinlaw.com



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