

From: [McKeever, Patrick J. \(SDO\)](#)
To: [Trials](#); [Eagle Robinson](#)
Cc: [*Service IPR Super Lighting-GE Current](#); [Bombach, Miguel J. \(SDO\)](#); [Bernstein, Matthew C. \(SDO\)](#); [Day, Evan S. \(SDO\)](#); [Chen, Han-Wei \(Harvey\) \(PAO\)](#); [Yuan, Wei \(SDO\)](#); [Art Licygiewicz](#); [Garza, Cat](#); [Valerie Barker](#)
Subject: RE: Request for Preliminary Reply & Sur-Reply | IPR2023-00269, 00270, 00271, 00272
Date: Wednesday, June 14, 2023 1:02:47 PM

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Dear Honorable Board,

Pursuant to the Board's email, I write on behalf of Patent Owner regarding my pre-planned travel that Petitioner mentioned in its email. I am lead counsel for Patent Owner in all four cases: IPR2023-00269, 00270, 00271, 00272 and I have a family vacation scheduled for the entire week of Mon., June 26. Patent Owner understands the Board's need to receive these briefs sufficiently in advance of the deadline for the Board's decisions regarding institution. Since the proposed Monday, July 10 deadline for the sur-replies is too late, Patent Owner respectfully requests a deadline in the second half of the week of July 3 if possible. Regardless, Patent Owner will comply with whatever deadline the Board sets.

Best,
Patrick

Patrick McKeever | Perkins Coie LLP

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From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, June 13, 2023 9:52 AM
To: Eagle Robinson <eagle.robinson@nortonrosefulbright.com>; Trials <Trials@USPTO.GOV>
Cc: *Service IPR Super Lighting-GE Current <IPRSuperLighting-GECurrent@perkinscoie.com>; McKeever, Patrick J. (SDO) <PMcKeever@perkinscoie.com>; Bombach, Miguel J. (SDO) <MBombach@perkinscoie.com>; Bernstein, Matthew C. (SDO) <MBernstein@perkinscoie.com>; Day, Evan S. (SDO) <EDay@perkinscoie.com>; Chen, Han-Wei (Harvey) (PAO) <HarveyChen@perkinscoie.com>; Yuan, Wei (SDO) <WYuan@perkinscoie.com>; Art Licygiewicz <art.licygiewicz@nortonrosefulbright.com>; Garza, Cat <cat.garza@nortonrosefulbright.com>; Valerie Barker <valerie.barker@nortonrosefulbright.com>
Subject: RE: Request for Preliminary Reply & Sur-Reply | IPR2023-00269, 00270, 00271, 00272

Counsel,

From the Board –

The requested pre-institution briefing is authorized. Petitioner is authorized to file a 5-page preliminary reply in each of IPR2023-00269, -00270, -00271, and -00272, which may only respond to the discretionary denial arguments presented by Patent Owner in the corresponding proceeding.

Patent Owner is also authorized to file a 5-page preliminary sur-reply in each proceeding that is limited to responding to Petitioner's reply.

Given the mid-August deadline for the Board's decisions on institution, the panel does not grant the parties' requested briefing schedule. Instead, Petitioner's preliminary reply will be due on or before Wednesday, June 21, 2023. The email references "pre-planned travel by PO's counsel," and Patent Owner may provide additional detail to be considered by the panel before the panel sets the deadline for Patent Owner's preliminary sur-reply. Any such information shall be provided on or before Thursday, June 15, 2023, in a reply to this email that copies Petitioner's counsel.

An order authorizing briefing and providing the deadlines for the preliminary reply and sur-reply will issue in due course.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Eagle Robinson <eagle.robinson@nortonrosefulbright.com>

Sent: Tuesday, June 13, 2023 12:10 AM

To: Trials <Trials@USPTO.GOV>

Cc: Service IPR Super Lighting-GE Current <IPRSuperLighting-GECurrent@perkinscoie.com>; McKeever, Patrick J. (SDO) <PMcKeever@perkinscoie.com>; Bombach, Miguel J. (SDO) <MBombach@perkinscoie.com>; Bernstein, Matthew C. (SDO) <MBernstein@perkinscoie.com>; Day, Evan S. (SDO) <EDay@perkinscoie.com>; Chen, Han-Wei (Harvey) (PAO) <HarveyChen@perkinscoie.com>; Yuan, Wei (SDO) <WYuan@perkinscoie.com>; Art Licygiewicz <art.lycygiewicz@nortonrosefulbright.com>; Cat Garza <cat.garza@nortonrosefulbright.com>; Eagle Robinson <eagle.robinson@nortonrosefulbright.com>; Valerie Barker <valerie.barker@nortonrosefulbright.com>

Subject: Request for Preliminary Reply & Sur-Reply | IPR2023-00269

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Dear Board,

Petitioner respectfully requests authorization to file a Preliminary Reply to the POPR in IPR2023-00269 to address PO's discretionary denial arguments (POPR at 2-17, 37-42).

There is good cause to support Petitioner's request, given at least that PO's arguments were

unforeseeable, in particular:

1. PO's *Taylor* argument (POPR at 2-17), which alleges a defendant in a prior litigation is a real party-in-interest or is in privity; and
2. PO's *Fintiv* argument (POPR at 37-42), which Petitioner believes mischaracterizes Petitioner's stipulation as well as the merits of the Petition; and

Petitioner promptly contacted PO's counsel and the parties have been conferring to reach agreement.

PO does not object to a Preliminary Reply limited to 5 pages, and requests a PO Sur-Reply limited to 5 pages (which Petitioner does not oppose).

The parties request that a Preliminary Reply be due by Monday, 6/26; and a Preliminary Sur-Reply be due by Monday, 7/10, to accommodate pre-planned travel by PO's counsel.

Respectfully submitted,

Eagle Robinson
Reg No. 61,361
Lead Counsel for Petitioner

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