

Nicholas Stephens

From: Trials <Trials@USPTO.GOV>
Sent: Friday, May 12, 2023 7:18 AM
To: Nicholas Stephens
Cc: IPR39843-0144IP1; Matthew Berkowitz; Patrick Colsher; Joy Wang; Trials
Subject: RE: IPR2023-00314 - Request for Reply to Patent Owner's Preliminary Response

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Counsel,

From the Board –

Petitioner is authorized to file, within five business days, information regarding a change in the median time-to-trial statistics in the forum of the parallel proceeding and an additional *Fintiv* stipulation, along with a three-page preliminary reply regarding the *Fintiv* factors. Patent Owner is authorized to file, within five business days of the filing of Petitioner's reply, a responsive three-page preliminary sur-reply. No additional briefing is authorized at this time.

Regards,

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

From: Nicholas Stephens <nstephens@fr.com>
Sent: Thursday, May 11, 2023 3:57 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR39843-0144IP1 <IPR39843-0144IP1@fr.com>; Matthew Berkowitz <mberkowitz@reichmanjorgensen.com>; Patrick Colsher <pcolsher@reichmanjorgensen.com>; Joy Wang <ywang@reichmanjorgensen.com>
Subject: IPR2023-00314 - Request for Reply to Patent Owner's Preliminary Response

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Dear Honorable Board,

Petitioner (Samsung Electronics Co., Ltd.) respectfully requests authorization to file a five-page reply to address the following arguments raised in Patent Owner's (CardWare Inc.'s) Preliminary Response:

- (1) Patent Owner's argument that the Board should exercise discretion to deny institution based on the *Fintiv*-factors; and

- (2) Patent Owner's argument that the prior art cited in Grounds 1A-1C lack a payment device having "a thin shaped body having no fixed payment numbers disposed thereon" as recited in claim 1.

Petitioner submits that good cause exists for briefing on *Fintiv* in light of the most recent median time-to-trial statistic in the Eastern District of Texas, which has changed since the time the Petition was filed, and in light of an updated stipulation that Petitioner served on Patent Owner in the co-pending litigation on April 18th. Petitioner previously submitted pre-institution replies to address similar developments in IPR2023-00196, IPR2023-00210, IPR2023-00211, and IPR2023-00219.

Petitioner further submits that good cause exists to address Patent Owner's argument regarding "a thin shaped body having no fixed payment numbers disposed thereon" in light of unforeseeable characterizations of the prior art in Grounds 1A-1C that overlook some of the most pertinent disclosures of these references relevant to the mappings set forth in the Petition. Briefing on this issue would further clarify the record and aid the Board in its institution decision.

If a reply is authorized, Petitioner would not oppose Patent Owner's filing of a sur-reply of corresponding length.

The parties have conferred by email and Patent Owner offers the following position:

*Patent Owner opposes the proposed reply except to the same extent previously authorized by the Board in IPR2023-00196, -00210, -00211, and -00219. Specifically, the Board previously allowed Petitioner to file a reply regarding "a change in the median time-to-trial statistics in the forum of the parallel proceeding and an additional *Fintiv* stipulation, along with a three-page preliminary reply regarding the *Fintiv* factors." The Board also gave Patent Owner five business days thereafter to file a responsive three-page preliminary sur-reply.*

Patent Owner does not oppose this same relief in the -00314 proceeding, but opposes the other requested relief.

Should the Board desire a call, the parties are available at the following times (all times Eastern):

- Monday 5/15: 11am-2pm, 4-5 pm
- Tuesday 5/16: 11am-5pm

Best Regards,
Nick Stephens

Counsel for Petitioner (Samsung)

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