Nicholas Stephens

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, May 09, 2023 7:13 AM
To: Nicholas Stephens
Cc: CardWare Samsung; Matt Berkowitz; IPR39843-0145IP1; IPR39843-0146IP1; IPR39843-0143IP1; IPR39843-0143IP2; Trials
Subject: RE: IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219 - Request for Replies to Patent Owner's Preliminary Responses

Follow Up Flag: Flag for follow up
Flag Status: Flagged

Counsel,

From the Board –

We acknowledge the receipt of the below email, and we will enter the email into the record in each case as Exhibit 3001.

Regards,

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

From: Nicholas Stephens <nstephens@fr.com>
Sent: Monday, May 1, 2023 5:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: CardWare Samsung <CardWare-Samsung@Shearman.com>; Matt Berkowitz <matt.berkowitz@shearman.com>; IPR39843-0145IP1 <IPR39843-0145IP1@fr.com>; IPR39843-0146IP1 <IPR39843-0146IP1@fr.com>; IPR39843-0143IP1 <IPR39843-0143IP1@fr.com>; IPR39843-0143IP2 <IPR39843-0143IP2@fr.com>
Subject: RE: IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219 - Request for Replies to Patent Owner's Preliminary Responses

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Dear Honorable Board:

The Parties have completed briefing in accordance with the authorization in the Board's email below. Petitioner writes to clarify an issue raised by Patent Owner's sur-replies in connection with Petitioner's updated stipulation.

Patent Owner argues in the sur-replies that Petitioner's updated stipulation "leaves Petitioner free to pursue related references that have the same (or substantially the same) disclosure but are not part of the grounds" such as "continuations and foreign counterparts." We do not agree with Patent Owner's characterization of the stipulation. Petitioner represented in its replies that the stipulation "in fact leaves only meaningfully different prior art

Exhibit 1111
Samsung v. Cardware
IPR2023-00314

available for use in the E.D. Texas litigation," thereby making clear that the stipulation would not allow for the situation that Patent Owner describes.

Nonetheless, to dispel any doubt, we confirm that Petitioner's stipulation served April 18, 2023 precludes in each specified proceeding, upon institution, pursuit of invalidity in the E.D. Texas litigation with respect to the claims challenged in the instituted proceeding based on (i) any of the same grounds in that instituted proceeding or (ii) any prior art reference that forms the basis of any ground in that instituted proceeding—including "references that have the same (or substantially the same) disclosure but are not part of the grounds" like those described in Patent Owner's sur-replies.

Petitioner notified Patent Owner by email of our intent to offer this clarification and invited Patent Owner to offer any objections beforehand. Patent Owner has not objected.

Best Regards,
Nick Stephens

Counsel for Petitioner (Samsung Electronics Co., Ltd.)

Nick Stephens :: Principal :: Fish & Richardson P.C.
612 766 2018 direct :: nstephens@fr.com :: fr.com

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, April 11, 2023 10:54 AM
To: Nicholas Stephens <nstephens@fr.com>
Cc: CardWare Samsung <CardWare-Samsung@Shearman.com>; Matt Berkowitz <matt.berkowitz@shearman.com>; IPR39843-0145IP1 <IPR39843-0145IP1@fr.com>; IPR39843-0146IP1 <IPR39843-0146IP1@fr.com>; IPR39843-0143IP1 <IPR39843-0143IP1@fr.com>; IPR39843-0143IP2 <IPR39843-0143IP2@fr.com>; Trials <Trials@USPTO.GOV>
Subject: RE: IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219 - Request for Replies to Patent Owner's Preliminary Responses

[This email originated outside of F&R.]

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: Monday, April 10, 2023 9:15 AM
To: Trials <Trials@USPTO.GOV>
Cc: CardWare Samsung <CardWare-Samsung@Shearman.com>; Matt Berkowitz <matt.berkowitz@shearman.com>; IPR39843-0145IP1 <IPR39843-0145IP1@fr.com>; IPR39843-0146IP1 <IPR39843-0146IP1@fr.com>; IPR39843-0143IP1 <IPR39843-0143IP1@fr.com>; IPR39843-0143IP2 <IPR39843-0143IP2@fr.com>
Subject: IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219 - Request for Replies to Patent Owner's Preliminary Responses

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Dear Board,

Petitioner respectfully requests authorization to file replies to Patent Owner's Preliminary Responses in each of the subject proceedings to address the following issues:

1. Patent Owner's arguments in each proceeding that the Board should exercise discretion to deny institution based on the *Fintiv* factors; and

2. The following case-specific issues:

    a. **IPR2023-00210** – Patent Owner's arguments regarding the meanings of "static" and "device" in the claim term "static device account number" in relation to Gomez and Carlson, and Patent Owner's argument that a POSITA would have lacked motivation to combine Gomez and Carlson.

    b. **IPR2023-00219** – Patent Owner's arguments that the IKCV is not specific to the device or a selected account and is not transmitted to the recipient reader device.

    c. **IPR2023-00196** – Patent Owner's arguments that Royyuru's Dynamic PAN is not provided "in place of" the real PAN, that a device manufacturer (such as Apple) would have had to generate Royyuru's IKCV in the proposed combination, and that the combination of Gomez's authentication cryptogram and the EPIC number is not provided "in place of said card issuer specified payment information."

Good cause exists for briefing on *Fintiv* at least in light of a change in the median time-to-trial statistic in the forum of the parallel proceeding (i.e., the Eastern District of Texas) since the petitions were filed. Petitioner additionally intends to submit an updated *Fintiv* stipulation in view of the changed median time-to-trial statistic that would impact application of the *Fintiv* factors. Good cause exists for briefing on the case-specific issues in view of Patent Owner's reliance on claim interpretations and characterizations of the prior art that were not reasonably foreseeable when the petitions were filed. Briefing on these issues would further clarify the record and aid the Board in its deliberations regarding institution.

Petitioner requests 8 pages for replies in each of the -00196, -00210, and -00219 proceedings and 5 pages for a reply in the -00211 proceeding, where Petitioner proposes to address only the *Fintiv* issue. Petitioner does not oppose a contingent request by Patent Owner for sur-replies of corresponding length in each proceeding if authorization is granted for the replies.

The parties have conferred by email and Patent Owner indicates that it opposes the request. The parties are available for a call with the Board between 12-3pm ET on Monday, April 10 and Tuesday, April 11. The parties can provide timeframes on additional dates should the Board desire additional options.

Best regards,
Nick Stephens

Counsel for Petitioner

Nick Stephens :: Principal :: Fish & Richardson P.C.
612 766 2018 direct :: nstephens@fr.com :: fr.com

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