

From: [Trials](#)
To: [Baird, John M.](#); [Trials](#)
Cc: [Togail_Counsel@b-clg.com](#); [McPherson, Patrick D.](#); [Candelori, Nicole](#); [Brett Cooper](#); [Robert Auchter](#); [Roshan Mansinghani](#); [Michelle Aspen](#)
Subject: RE: Unified Patents v. Togail (IPR2023-00338) - Request for a Petitioner Reply
Date: Friday, July 7, 2023 8:30:32 AM

Counsel,

From the Board –

As per the conference on July 6, 2023, between the panel and attorneys for both parties, the parties agreed that this proceeding is the first IPR filed against the challenged patent. Based on the preceding, the parties further agreed that, at present, there is no serial petition issue under *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (precedential) (“*General Plastics*”). Accordingly, no additional briefing directed to *General Plastics* is necessary and none is authorized.

Patent Owner Togail raised the issue as to whether Apple Inc. is a real-party-in-interest with Petitioner Unified Patents. See Prelim. Resp. 5 (citing *Unified Patents, LLC v. Memoryweb LLC*, IPR2021-01413, Paper 56 (PTAB March 8, 2023) (“*Memoryweb*”). As was discussed during the call, the panel is aware that the *Memoryweb* decision has been vacated by the Director. That the *Memoryweb* decision of PTAB has been vacated will also be made of record in any Institution Decision for this IPR. Petitioner gave no additional reason why it needs to file a preliminary reply. Accordingly, no preliminary reply is authorized.

This email thread will be made of record as Exhibit 3001 in this proceeding.

Regards,

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

From: Baird, John M. <JMBaird@duanemorris.com>
Sent: Friday, June 30, 2023 2:56 PM
To: Trials <Trials@USPTO.GOV>
Cc: Togail_Counsel@b-clg.com; McPherson, Patrick D. <PDMcPherson@duanemorris.com>; Candelori, Nicole <NCandelori@duanemorris.com>; Brett Cooper <bcooper@bc-lawgroup.com>; Robert Auchter <robert@auchterlaw.com>; Roshan Mansinghani <roshan@unifiedpatents.com>; Michelle Aspen <michelle@unifiedpatents.com>
Subject: Unified Patents v. Togail (IPR2023-00338) - Request for a Petitioner Reply

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Dear Honorable Members of the Board:

Petitioner requests authorization to file a preliminary reply to respond to the first 11 pages of the Patent Owner Preliminary Response in which Patent Owner asks for a discretionary denial under a *General Plastics* analysis that could not have been anticipated, including:

1. Discretionary denial under *General Plastics* of the first IPR filed against the challenged patent.
2. Discretionary denial based on argument and reliance on a Board decision vacated by the director, and the applicability of *SharkNinja*.

Petitioner requests authorization to file a reply not longer than 10 pages, with evidence if necessary, and within 10 business days of the Board's authorization.

Patent Owner opposes Petitioner's request. The parties are available for a conference with the Board at the following times, should the Board want to have such a call:

- Wednesday from 3 pm to 5 pm,
- Thursday from 10 am to 5 pm, or
- Friday from 10 am to 1:30 pm (all times Eastern).

Very respectfully,

John M. Baird
Partner

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