

Zhang, Xirui

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, May 18, 2023 1:01 PM
To: Specht, Kara; Trials
Cc: johnw@wsltrial.com; Todd Landis; Michael Fagan; Mark McCarthy; Dynapass-IPR
Subject: RE: IPR2023-00367

Follow Up Flag: Follow up
Flag Status: Flagged



EXTERNAL Email:

Counsel: The panel authorizes a one-page preliminary reply on the issues of jurisdiction and Patent Owner's application of *Xerox* as requested by Petitioner. We also authorize Patent Owner to file a one-page preliminary sur-reply limited to responding to these issues. Petitioner's preliminary reply is due within five business days of receipt of this email authorization and Patent Owner's sur-reply is due within five business days of filing of Petitioner's preliminary reply. Petitioner should file a copy of this email as an Exhibit in this proceeding.

Thank you,

Maria King
Deputy Chief Clerk for Trials
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
703-756-1288

From: Specht, Kara <Kara.Specht@finnegan.com>
Sent: Wednesday, May 17, 2023 11:39 AM
To: Trials <Trials@USPTO.GOV>
Cc: johnw@wsltrial.com; Todd Landis <tlandis@wsltrial.com>; Michael Fagan <mfagan@wsltrial.com>; Mark McCarthy <mmccarthy@wsltrial.com>; Dynapass-IPR <Dynapass-IPR@finnegan.com>
Subject: IPR2023-00367

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Dear Board -

Petitioners in IPR2023-00367 request a one-page pre-institution reply on the issues of jurisdiction and Patent Owner's application of *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624. Patent Owner does not oppose a one-page reply on the issue of jurisdiction but does oppose additional briefing on *Xerox*.

Although unopposed, good cause exists to address jurisdiction because of Patent Owner's direct contradiction of *Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 10 (Nov. 29, 2021) (finding jurisdiction over an IPR filed on an expired patent) was unforeseeable. Petitioners request a reply to address the Board's reasoning in *Apple v. Gesture Tech*.

Patent Owner argues that under *Xerox* a declaration is entitled to little weight if it restates the same supporting evidence and reasoning as the petition. Paper 10 at 17-18 ("declaration is entitled to little weight when it contains an exact restatement of the petition's arguments without additional supporting evidence or reasoning"). This is an unforeseeable expansion of the actual holding from *Xerox*, which held that a declaration is entitled to little weight if it is conclusory and unsupported with evidence and explanation. *Xerox Corp., et al. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9 at 15 (August 24, 2022) (precedential) ("cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight"). Petitioners request a reply to address the proper holding from *Xerox*.

If granted, Petitioners will not oppose a sur-reply by Patent Owner of equal length, limited to responding to the arguments made in reply.

Petitioners are available for a call with the Board at the Board's convenience this week. Patent Owner indicated it is available for a call with the Board Thursday of this week.

Best regards,

Kara Specht
Counsel for Petitioners

Kara Specht
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
271 17th Street, NW, Suite 1400, Atlanta, GA 30363-6209
404.653.6481 | fax 404.653.6444 | kara.specht@finnegan.com | [bio](#) | www.finnegan.com

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.