Diana Bradley

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 15, 2023 8:19 AM
To: Hyun Jin In; Trials
Cc: cbiyer@daignaultiyer.com; kduche@daignaultiyer.com; jason.s.charkow@gmail.com; richard.juang@gmail.com; DoDotsLit@daignaultiyer.com; IPR39843-0148IP1; IPR39843-0150IP1; IPR39843-0149IP1; PTAB Inbound; AXF-PTAB
Subject: RE: Request for Authorization to Submit Supplemental Information in IPR2023-00621, IPR2023-00756, and IPR2023-00701

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Counsel:

The judge panels respond as follows:

We authorize Petitioner to submit a motion to file supplemental information in each proceeding. We direct the parties' attention specifically to 37 C.F.R. 42.123 and to the relevant portions of the Consolidated Trial Practice Guide ("CTPG") (available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf) including pages 47–48 and 75. The CTPG notes that "[n]ormally, the Board will permit such information to be filed." CTPG 48. We note that in these proceedings we declined to authorize the submission of a revised declaration before institution (see, e.g., IPR2023-00621, Ex. 1020) and that we stated in the Decisions on Institution that this issue might be further explored during the proceeding including through cross-examination of the Petitioner's declarant (see, e.g., IPR2023-00621, Paper 9, 23).

Petitioner should submit such a motion on or before November 21, 2023, filing this email as an exhibit and referencing it in the motion. Patent Owner should submit any opposition within five business days of the filing of Petitioner's motion.

Regards,

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

From: Hyun Jin In <in@fr.com>
Sent: Monday, November 13, 2023 5:27 PM
To: Trials <Trials@USPTO.GOV>
Cc: cbiyer@daignaultiyer.com; kduche@daignaultiyer.com; jason.s.charkow@gmail.com; richard.juang@gmail.com; DoDotsLit@daignaultiyer.com; IPR39843-0148IP1 <IPR39843-0148IP1@fr.com>; IPR39843-0150IP1 <IPR39843-0150IP1@fr.com>; IPR39843-0149IP1 <IPR39843-0149IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; AXF-PTAB <AXF-PTAB@fr.com>
Subject: Request for Authorization to Submit Supplemental Information in IPR2023-00621, IPR2023-00756, and IPR2023-00701

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Exhibit 1023
Samsung v. DoDots
IPR2023-00621

Your Honors,

Pursuant to 37 CFR § 42.123, Petitioner hereby requests authorization from the Board to file a motion to submit supplemental information in each of IPR2023-00621, IPR2023-00756, and IPR2023-00701.

More specifically, Petitioner requests authorization to file a motion to submit a supplemental declaration of Dr. Douglas C. Schmidt as supplemental information in each of the above-noted cases. This declaration provides clarification regarding the typographical error in his original declaration where he quoted an earlier version of 37 C.F.R. § 42.100(b) when discussing the claim construction standard. For at least that reason, the supplemental declaration is relevant to a claim for which trial has been instituted.

Petitioner and Patent Owner have met and conferred regarding this request, and Patent Owner opposes the motions to submit supplemental information in each of IPR2023-00621, IPR2023-00756, and IPR2023-00701. In opposing, Patent Owner has asked that the following remarks be included in this request:

> Patent Owner DoDots opposes Samsung's request for at least the following two reasons. First, in its August 14, 2023 Order, the Board expressly denied the exact same request that Petitioner seeks now – the submission of a revised declaration of Dr. Schmidt. The Board's reasons for denying Samsung's request in August 2023 continue to apply and warrant denial yet again. Second, the supplemental information that Petitioner seeks to submit should have and could have been submitted along with Samsung's preliminary reply. This would have allowed (i) the Patent Owner to properly address it in its preliminary sur-reply; and (ii) the Board to consider it when making its institution decision. Samsung's belated attempt to add now new information to this proceeding is prejudicial to DoDots because DoDots has lost the opportunity to respond to this information in opposing institution. Likewise, the Board has lost the opportunity to consider this information in making its institution decision.

Should the Board desire a call with the parties in connection with this request, the parties will confer and offer times of joint availability.

Sincerely,
Hyun Jin In
Counsel for Petitioner

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