

Diana Bradley

From: Trials <Trials@USPTO.GOV>
Sent: Monday, August 14, 2023 10:06 AM
To: cbiyer@daignaultiyer.com; Hyun Jin In; Trials
Cc: 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: Seeking Board Authorization re IPR2023-00621, IPR2023-00756, and IPR2023-00701

[This email originated outside of F&R.]

Counsel:

From the Board –

With respect to the parties' emails of August 10, 2023, we do not authorize the submission of a revised declaration from Dr. Schmidt in IPR2023-00621, IPR2023-00756, or IPR2023-00701.

We authorize Petitioner in IPR2023-00621 and IPR2023-00756 to file a seven-page preliminary reply (i) responding to Patent Owner's arguments regarding the claim construction standard noted in Dr. Schmidt's declaration in each proceeding, (ii) addressing the alleged inconsistent means-plus-function treatment of claims in the co-pending litigation, and (iii) discussing the applicability of *Fintiv*. This preliminary reply in each case is limited to these matters and should be filed within seven business days of this email. If Petitioner chooses to file a preliminary reply in either proceeding, it should file this email as an exhibit in the proceeding and refer to it in its preliminary reply.

We authorize Patent Owner in IPR2023-00621 and IPR2023-00756 to file a responsive preliminary sur-reply, which should be filed within seven business days of the filing of a preliminary reply in either proceeding.

Any request regarding a similar preliminary reply in IPR2023-00701 should be made promptly, as we will be disinclined to authorize a preliminary reply to be filed in IPR2023-00701 after a Patent Owner preliminary sur-reply has been filed in IPR2023-00621 and IPR2023-00756.

Regards,

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

From: Chandran Iyer <cbiyer@daignaultiyer.com>
Sent: Thursday, August 10, 2023 11:18 PM
To: Hyun Jin In <in@fr.com>; Trials <Trials@USPTO.GOV>
Cc: Konah Duche <kduche@daignaultiyer.com>; jason.s.charkow@gmail.com; richard.juang@gmail.com; DoDotsLit <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: Re: Seeking Board Authorization re IPR2023-00621, IPR2023-00756, and IPR2023-00701

Your Honors,

Though Patent Owner's counsel approved the below email, upon further reading, the final sentence regarding the parties' availability for and necessity of a call leaves some ambiguity. To be clear, Patent Owner does not believe that Petitioner should be allowed to serve a revised expert declaration because, as set forth in the POPR, the error in the expert's declaration is neither typographical nor clerical as Petitioner suggests in its email. For this reason, should the Board be inclined to permit Petitioner to file a motion seeking leave to serve a new expert declaration and address issues (i)-(iii) under 37 C.F.R. §42.104 and §42.20(a) and (b), Patent Owner requests the opportunity to be heard and oppose on such a motion.

Respectfully submitted,
Chandran Iyer



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From: Hyun Jin In <in@fr.com>
Date: Thursday, August 10, 2023 at 6:16 PM
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Subject: Seeking Board Authorization re IPR2023-00621, IPR2023-00756, and IPR2023-00701

Your Honors,

In IPR2023-00621 and IPR2023-00756, Petitioner requests leave to file a five-page reply to the Patent Owner Preliminary Response (POPR) pursuant to 37 CFR 42.108(c). Petitioner seeks to respond to Patent Owner's arguments regarding the claim construction standard noted in the expert declaration (Exhibit 1003), the alleged inconsistent means-plus-function treatment of claims in the co-pending litigation, and *Fintiv* considerations. Good cause exists for the replies. For example, (i) Petitioner did not appreciate the typographical error in the expert declaration concerning 37 CFR §42.100(b), (ii) the parties submitted updated claim construction pleadings in the co-pending litigation subsequent to the filing of these petitions, and (iii) good cause exists to allow Petitioner to address *Fintiv* in light of Patent Owner's arguments in the POPR and the current state of the litigation, which is different than the state of the litigation at the time of petition filing.

Additionally, in IPR2023-00621, IPR2023-00756, and IPR2023-00701, with regard to the claim construction standard noted in the expert declaration, Petitioner requests authorization to submit a revised declaration with an updated construction standard to allow Petitioner to correct the clerical error in the declaration as per 37 CFR §42.104(c). The Petition advocated for the correct claim construction standard, and the claim constructions discussed in the expert declaration were consistent with the correct claim construction standard. Thus, for at least these reasons, good cause exists to allow Petitioner to correct the typographical error included in the expert declarations.

The parties have conferred, and Patent Owner opposes Petitioner's request. If the Board grants Petitioner's request, Patent Owner requests authorization to file a sur-reply of equal length. Petitioner does not oppose Patent Owner's request for a sur-reply.

Conference Call Availability

While the parties do not believe a conference call will be necessary, the parties are generally available next Thursday (8/17) and Friday (8/18) if needed.

Regards,
Hyun Jin In
Counsel for Petitioner

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