

From: [Won Yoon](#)
To: [Trials](#)
Cc: [Honda-Neo Wireless FR-Internal](#); [PTAB Inbound](#); [IPR15625-0037IP4](#); [Kenneth Weatherwax](#); [Parham Hendifar](#); [Neo](#)
Subject: RE: IPR2023-00797 - Petitioner's Request for Authorization to File Reply to POPR
Date: Tuesday, September 19, 2023 6:25:03 PM

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

Dear Patent Trial and Appeal Board,

Petitioner's email request identifies three topics for which it seeks authorization to submit briefing and evidence. For each, Petitioner limited its email to a single sentence, providing a high-level encapsulation of the issues central to its request, with a level of detail believed necessary to provide the Board with an understanding of the topics that it seeks to address.

Notably, therefore, most of Petitioner's email addresses the form of submissions (brief, evidence) sought, and other formalities, with just three enumerated sentences used to describe the object of its intended submission. And, by limiting the description of topics to just one sentence each, the email purposefully excluded argumentation that it proposes to address through briefing and through evidence from Dr. Buehrer. Indeed, out of an abundance of caution, concerns over Patent Owner's treatment of identified topics were also largely omitted, as Petitioner left the same for a subsequent call with the Board, if the Board thought the same would be helpful.

Seeking still to abide Board guidance, Petitioner omits further detail regarding the topics (and arguments) in this email, and instead now reiterates its requested authorization while also reiterating its willingness to participate in a call to provide details regarding concerns over Patent Owner's submission, including the unforeseeability of positions taken by Patent Owner with respect to each of the three topics central to Petitioner's request.

Respectfully submitted,
Won S. Yoon
Counsel for Petitioner

Won S. Yoon, J.D.

Principal :: **Fish & Richardson, P.C.**

1000 Maine Ave, SW, Suite 1000, Washington, DC 20024

202 626 6431 (direct) :: 617 620 2330 (mobile) :: 202 783 2331 (fax)

woon@fr.com :: fr.com :: [Bio](#) :: [LinkedIn](#)

Note: This e-mail is for the sole use of the intended recipient(s) and may contain material that is confidential, privileged, and/or attorney work product. Any review or distribution by others is strictly prohibited. If you are not the intended recipient, please contact the sender and delete all copies.

From: Parham Hendifar <hendifar@lowensteinweatherwax.com>

Sent: Monday, September 18, 2023 10:26 PM

To: Trials <Trials@USPTO.GOV>

Cc: Honda-Neo Wireless FR-Internal <Honda-Neo_Wireless_FR-Internal@fr.com>; PTAB Inbound <PTABInbound@fr.com>; IPR15625-0037IP4 <IPR15625-0037IP4@fr.com>; Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>; Neo <neowireless_iprs@lowensteinweatherwax.com>; Won Yoon <yoon@fr.com>

Subject: Re: IPR2023-00797 - Petitioner's Request for Authorization to File Reply to POPR

Dear Honorable Board,

As Patent Owner advised Petitioner during meet and confer, Petitioner's email improperly includes arguments. *Polygroup Ltd v. Willis Elec. Co.*, IPR2016-01610, Paper 39, 3 (PTAB Feb. 27, 2017). To the extent the Board considers these substantive arguments, Patent Owner responds as follows.

Petitioner's alleged good cause for the high bar of submitting both additional briefing and additional evidence and expert testimony is based on POPR arguments that allegedly "could not have reasonably been foreseen, at least insofar as the POPR characterizes petition arguments and record evidence" However, Petitioner fails to show good cause. First, as the Board has previously held, alleged mischaracterizations of the record do not support good cause for additional briefing. *Dell Inc. v. Neo Wireless LLC*, IPR2021-01468, Paper 10, 3 (Jan. 27, 2022) ("The Board routinely determines whether a party mischaracterizes the asserted references or the other party's arguments without the need for additional briefing."). Second, the notion that Petitioner "could not have reasonably" foreseen POPR's arguments is readily refuted:

1. Patent Owner's raising of *Valve* (POPR, § II) was foreseen and addressed in the Petition, which devoted an entire section to it. Pet., 67 (§ IV.B); *see also* POPR, 19.
2. Patent Owner's sole citation to § 325(d) and any related analysis (POPR, 18) was foreseen and addressed in the Petition, which devoted an entire section to § 325(d). Pet., 67-68 (§ IV.C).
3. Patent Owner's argument that Koo is not prior art (POPR, § III.B) was foreseen and addressed in the Petition, which devoted more than three pages and a claim chart to it. Pet., 2-6. In fact, Petitioner's second ground relies on Kitroser instead of Koo with the effect of addressing the possibility that Koo is not prior art. Pet., 58.

As shown above, the notion that any of the proposed subjects of additional briefing and evidence "could not have reasonably been foreseen" is unsubstantiated. Furthermore, any allegation of "mischaracterization" does not warrant additional briefing, let alone an additional expert declaration. *Dell*, IPR2021-01468, Paper 10, 3.

Finally, the extent to which Petitioner has self-servingly already prepared an additional round of filings it hopes to be allowed to submit does nothing to allay the additional burden to both Patent Owner and the Board, especially absent any showing of good cause. *See also Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (petitioners must "make their case in their petition to institute.").

Respectfully submitted,

--

Parham Hendifar | Lowenstein & Weatherwax LLP

1016 Pico Boulevard, Santa Monica, CA 90405
Office: 310.307.4514

From: Won Yoon <yoona@fr.com>

Date: Monday, September 18, 2023 at 9:08 AM

To: Trials <Trials@USPTO.GOV>

Cc: Honda-Neo Wireless FR-Internal <Honda-Neo_Wireless_FR-Internal@fr.com>, PTAB Inbound <PTABInbound@fr.com>, IPR15625-0037IP4 <IPR15625-0037IP4@fr.com>, Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>, Parham Hendifar <hendifar@lowensteinweatherwax.com>, Neo <neowireless_iprs@lowensteinweatherwax.com>

Subject: IPR2023-00797 - Petitioner's Request for Authorization to File Reply to POPR

Dear Patent Trial and Appeal Board,

Petitioner respectfully requests authorization to file briefing in the form of a 10-page Reply to Patent Owner's Preliminary Response ("POPR") in IPR2023-00797. In addition, Petitioner respectfully requests authorization to submit evidence in the form of a supplemental declaration from Petitioner's technical expert, Dr. Buehrer, in order to address technical inaccuracies contained in the POPR. If Petitioner's requests are granted, Petitioner does not oppose Patent Owner's submission of an equivalent-length Sur-Reply and submission of additional evidence.

If authorized, Petitioner's Reply would address POPR arguments that could not have reasonably been foreseen, at least insofar as the POPR characterizes petition arguments and record evidence in a manner inconsistent with the petition and evidence. Petitioner respectfully submits that good cause for further briefing on these issues exists, at least because briefing would clarify the record and aid the Board in deliberations on issues that are potentially dispositive to institution of the pending petition. For example, Petitioner's reply would address the following issues in the POPR:

1. Patent Owner's arguments under § 314(a) attempt to extend the holding of *Valve* to a circumstance in which prior art is different from that applied in an earlier IPR petition (POPR, § II);
2. Patent Owner's arguments under § 325(d) are based on a 300-page technical standard document that was never discussed during original examination (POPR, § II);
3. Patent Owner's arguments that the reference Koo is not prior art mischaracterize the '586 provisional to which the '302 patent claims priority and also mischaracterize a 2006 book authored by Petitioner's technical expert Dr. Buehrer (POPR, § III.B).

Furthermore, if Petitioner's request for authorization to submit evidence is granted, the supplemental declaration from Petitioner's expert, Dr. Buehrer, would clarify the record as to various allegations by Patent Owner's expert, Mr. Alberth. If authorized, Petitioner's Reply and Dr. Buehrer's accompanying declaration are ready to be filed immediately, thus alleviating any timing concerns.

Petitioner and Patent Owner have conferred. Patent Owner opposes this request.

Should the Board desire a call to discuss this request, the parties are available on September 21 (1:00 PM – 4:00 PM EST), September 25 (1:00 PM – 4:00 PM EST), and September 27 (3:00 PM – 5:00 PM EST).

PM EST).

Respectfully submitted,
Won S. Yoon
Counsel for Petitioner

Won S. Yoon, J.D.

Principal :: **Fish & Richardson, P.C.**

1000 Maine Ave, SW, Suite 1000, Washington, DC 20024

202 626 6431 (direct) :: 617 620 2330 (mobile) :: 202 783 2331 (fax)

woon@fr.com :: fr.com :: [Bio](#) :: [LinkedIn](#)

Note: This e-mail is for the sole use of the intended recipient(s) and may contain material that is confidential, privileged, and/or attorney work product. Any review or distribution by others is strictly prohibited. If you are not the intended recipient, please contact the sender and delete all copies.

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

