

From: [Trials](#)
To: [Philip J. Ekle](#); [Trials](#)
Cc: [todd.baker@kirkland.com](#); [ellisen.turner@kirkland.com](#); [jonathan.brit@kirkland.com](#); [#Meta_VideoLabs](#); [RJ_VideoLabs-Facebook](#); [Christine E. Lehman](#); [Michael Matulewicz-Crowley](#)
Subject: RE: Meta v. VideoLabs, IPR2023-00923
Date: Wednesday, October 18, 2023 3:39:38 PM

CAUTION: EXTERNAL SENDER

Counsel,

The judge panel responds as follows:

Patent Owner's request to file a motion to strike is denied. Patent Owner may address whether Petitioner's Reply exceeded its authorized scope in the Sur-Reply. Patent Owner is reminded of our outstanding order to cease presenting arguments or briefing via email. We will not consider the substantive arguments contained in Patent Owner's unauthorized email to the Board.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Philip J. Ekle

Sent: Wednesday, October 18, 2023 11:00 AM

To: Trials

Cc: [todd.baker@kirkland.com](#); [ellisen.turner@kirkland.com](#); [jonathan.brit@kirkland.com](#); [#Meta_VideoLabs](#) ; [RJ_VideoLabs-Facebook](#)

Subject: Meta v. VideoLabs, IPR2023-00923

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

Case IPR2023-00923

U.S. Patent 7,266,682

Honorable Board,

Patent Owner respectfully requests leave to file a motion to strike portions of Petitioners' Reply (Paper 14) and expunge those portions from the record under 37 C.F.R. §§ 42.20, 42.23. The Board limited the scope of Petitioners' Reply to "addressing arguments in the Preliminary Response regarding whether *the Petition* sufficiently shows that Exhibits 1005 and 1007 are printed publications" and denied Petitioners' request to submit supplemental information or evidence for lack of good cause. Paper 13 at 2-4 (emphasis added). Yet Petitioners' Reply improperly includes supplemental information and evidence that is not in the Petition, including URLs to multiple new documents that Petitioners invite the Board to access and review, metadata for documents and links, and new expert "testimony." Paper 14 at 1-3 (e.g., all

IPR2023-00923
Ex. 3006

URLs in the Reply, metadata screenshot, and numerous statements about what POSITA would have known or done that are not in the Petition or any exhibits thereto, including assertions of what Dr. Houh allegedly knew or did). The Reply then argues that Handley and PacketCable are printed publications based on this improper new evidence. *Id.* The only part of the Reply that is proper is the final paragraph of the Reply (excluding footnote 6). Patent Owner thus requests permission to file a motion to strike and expunge from the record all other portions of the Reply. Patent Owner requests a 5-page brief for its motion. Patent Owner also requests that the Board extend the deadline for Patent Owner's Sur-Reply (which is currently due this Friday 10/20) until after the motion to strike is resolved. The deadline and page limits for the Sur-Reply were set under the assumption that there would not be new evidence in the Reply, and it would be prejudicial to Patent Owner to have to respond to the myriad new and improper evidence and arguments under the current timeframe and page limits.

Patent Owner conferred with Petitioners to attempt to resolve the dispute.

Petitioners oppose Patent Owner's requests. Petitioners responded as follows:

Patent Owner's requests should be denied. The Board's October 5, 2023 Order (Paper 13) authorized "Petitioner to file a three-page Reply limited to addressing arguments in the Preliminary Response regarding whether the Petition sufficiently shows that Exhibits 1005 and 1007 qualify as printed publications." Order at 2; *see also id.* at 3. The Board stated that it "would benefit from additional briefing on this issue." *Id.* at 3. Further, the Board found no good cause for the submission of supplemental evidence (*id.*), "including a supplemental declaration from Dr. Henry Houh, two supplemental declarations from Dr. Sylvia Hall-Ellis, and a declaration from a named author of the *Handley* reference" (*id.* at 2). The Reply included no such supplemental evidence.

Any request to extend the deadline for PO's Sur-Reply should likewise be denied. PO was provided five business days to respond to a mere three-page brief. PO's attempt to raise a non-existent issue is no excuse for an extension to a pre-set deadline, especially considering that Petitioners are in full compliance with the Board's Order and PO has experienced no prejudice.

In light of the Board's admonition on September 28, 2023 "to cease any

further presentation of argument or briefing via email,” Petitioner has not fully responded here to Patent Owner’s argument provided above. Of course, if the Board would benefit from additional briefing or a conference call, Petitioners will be available to do so.

Patent Owner and Petitioners are available for a conference call this Wednesday (10/18) between 10:00 am ET and 5:00 pm ET, Thursday (10/19) between 2:00 pm ET and 5:00 pm ET, and Friday (10/20) between 1pm ET and 5pm ET.

Additionally, Patent Owner requests permission for Patent Owner’s counsel, Jaime F. Cardenas-Navia, to present on behalf of the Patent Owner at the requested hearing. Mr. Cardenas-Navia’s motion to appear *pro hac vice* is currently pending (Paper 12).

With best regards,

Philip J. Eklem

Reichman Jorgensen Lehman & Feldberg llp

1909 K Street, NW

Suite 800

Washington, DC 20006

(202) 894-7451

The information contained in this communication is confidential, may be attorney-client privileged, may constitute inside information, and is intended only for the use of the intended recipient(s). This communication is the property of Reichman Jorgensen LLP. Unauthorized use, disclosure or copying of this communication or any part thereof is strictly prohibited and may be unlawful. If you have received this communication in error, please promptly notify the sender by reply email and immediately destroy this communication and all copies thereof, including all attachments.

NOTICE: This transmission is intended only for the use of the addressee and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If you are not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify the sender immediately via reply e-mail, and then destroy all instances of this communication. Thank you.