

From: [Trials](#)
To: [Jaime Cardenas-Navia](#); [Turner, Ellisen Shelton](#); [Trials](#)
Cc: [Philip J. Eklem](#); [Christine E. Lehman](#); [Michael Matulewicz-Crowley](#); [RJ_VideoLabs-Facebook](#); [#Meta_VideoLabs](#)
Subject: RE: [Meta v. VL Collective IP] IPR2023-00923
Date: Thursday, September 28, 2023 3:13:09 PM

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Counsel,

From the Board –

The Practice Guide allows parties to contact the Board by email for certain purposes, such as arranging a conference call. The parties are not permitted to contact the Board by email to submit unauthorized arguments. The submission of such unauthorized email circumvents our rules prohibiting filing a motion without prior authorization. See 37 C.F.R. § 42.1(b); § 42.25 (“(a) motion may only be filed according to a schedule set by the Board”); Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) at 37 (“Generally, a motion will not be entered without prior Board authorization.”). We will not consider the substantive arguments contained in the unauthorized emails from the parties to the Board. The parties are ordered to cease any further presentation of argument or briefing via email.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Jaime Cardenas-Navia

Sent: Thursday, September 28, 2023 1:44 PM

To: Turner, Ellisen Shelton ; Trials

Cc: Philip J. Eklem ; Christine E. Lehman ; Michael Matulewicz-Crowley ; RJ_VideoLabs-Facebook ; #Meta_VideoLabs

Subject: RE: [Meta v. VL Collective IP] IPR2023-00923

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Dear Board,

Patent Owner opposes Petitioners’ new and procedurally improper request. As with its original request, Petitioners’ new request cannot meet the good cause standard because it seeks to address a deficiency in the Petition that was entirely foreseeable, and the requested supplemental evidence would amount to an additional, substantial violation of the permitted word limit. As explained in the hearing, the weight of the PTAB’s decisions are overwhelmingly in support of Patent Owner’s position, with three of the four decisions **that Petitioner cited** in the email to the Board finding a lack of good cause to permit supplemental evidence to be filed along with a Reply.

Moreover, Petitioners’ new request to submit additional evidence not addressed anywhere in the Petition to “let the evidence speak for itself” amounts to further impermissible incorporation by reference and should be rejected. Incorporation by reference is prohibited by the Board’s rules. 42 C.F.R. § 42.6. The Trial Practice Guide makes clear that petitioners that incorporate argument or evidence by reference “risk having the testimony not considered by the Board.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 35-36 (citing *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative)). And the Board’s

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informative *Cisco* decision makes clear that citing declarations to support conclusory assertions not otherwise supported in a petition “amounts to incorporation by reference” in violation of § 42.6 and may be disregarded as such. *Cisco*, IPR2014-00454, Paper 12 at 9-10. What Petitioners are asking for is even worse—they are asking the Board to consider evidence not even cited in the Petition (or in a Reply). Panels of the Board have rightfully declined to do so. *See, e.g., Apple Inc v. Masimo Corporation*, IPR2020-01539, Paper 41 at 82 (PTAB Feb. 23, 2021) (“As discussed above, the Petition lacks any supporting evidence to support the contention of obviousness. Petitioner cannot provide such evidence on Reply when it should have been offered in the Petition.”). The Board’s informative *Cisco* decision also points out that the prohibition against incorporation by reference is to eliminate “abuses that arise from incorporation,” including “circumvent[ing] the page limits imposed on petitions for *inter partes* review.” *Cisco*, IPR2014-00454, Paper 12 at 10. As discussed during today’s call, and as explained in the POPR, Petitioners have already violated the prohibition of incorporation by reference, and are now asking for permission to violate it even further. POPR, at 25-33, 41-43. Petitioners’ request should be denied.

Best regards,

Jaime Cardenas-Navia

Counsel for Patent Owner

Jaime F. Cardenas-Navia

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From: Turner, Ellisen Shelton <ellisen.turner@kirkland.com>

Sent: Thursday, September 28, 2023 12:35 PM

To: trials@uspto.gov

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Subject: [Meta v. VL Collective IP] IPR2023-00923

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Honorable Board,

Thank you for your time today on our conference call regarding Petitioners’ Request for Leave to File a Reply in IPR2023-00923. Petitioners respectfully submit the following in order to clarify one point made on our call during which Petitioner stated that “no further argument is required.” While Petitioners dispute Patent Owner’s arguments concerning the length of the original Petition, Petitioners are willing to submit their supplemental evidence without any additional attorney argument and, thus, let the evidence speak for itself. Petitioners do not object to Patent Owner having sufficient time and space to submit any responsive argument or evidence that they desire if they continue to dispute public availability of the prior art disclosed in these references.

Respectfully submitted,

Ellisen Shelton Turner P.C.

Partner

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