

From: [Trials](#)
To: [Baker, W. Todd](#); [Trials](#)
Cc: [Philip J. Eklem](#); [Christine E. Lehman](#); [Jaime Cardenas-Navia](#); [Michael Matulewicz-Crowley](#); [RJ_VideoLabs-Facebook](#); [#Meta_VideoLabs](#)
Subject: RE: Meta v. VideoLabs, IPR2023-00923
Date: Wednesday, September 27, 2023 9:58:43 AM

CAUTION: EXTERNAL SENDER

Counsel,
A conference call is scheduled for **tomorrow (Thursday, September 28) at 10:30 am ET**.
The dial-in number is: 866-919-8442 and the passcode is: 9446155#.
Mr. Cardenas-Navia may present on behalf of the Patent Owner at the conference call.
Regards,
Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Baker, W. Todd
Sent: Tuesday, September 26, 2023 8:18 PM
To: Trials
Cc: peklem@reichmanjorgensen.com; clehman@reichmanjorgensen.com; jcardenas-navia@reichmanjorgensen.com; mmatulewicz-crowley@reichmanjorgensen.com; [RJ_VideoLabs-Facebook@reichmanjorgensen.com](#); [#Meta_VideoLabs](#)
Subject: RE: Meta v. VideoLabs, IPR2023-00923

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Dear Ms. Goldschlager,
Pursuant to the below, Petitioners and Patent Owner have conferred and jointly indicate availability for a conference call during any of the proposed times on Thursday, September 28 (*i.e.*, between 10 am and 12 pm ET or between 3 pm and 4 pm 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). Petitioners do not oppose Patent Owner's request.
Thank you,
Todd Baker
Counsel for Petitioner

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todd.baker@kirkland.com

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, September 26, 2023 3:46 PM
To: Baker, W. Todd <todd.baker@kirkland.com>; Trials <Trials@USPTO.GOV>

IPR2023-00923
Ex. 3004

Cc: peklem@reichmanjorgensen.com; clehman@reichmanjorgensen.com; jcardenas-navia@reichmanjorgensen.com; mmatulewicz-crowley@reichmanjorgensen.com; RJ_VideoLabs-Facebook@reichmanjorgensen.com; #Meta_VideoLabs <Meta_VideoLabs@kirkland.com>

Subject: RE: Meta v. VideoLabs, IPR2023-00923

Counsel,

Please confer and jointly indicate times that you are available for a conference call on Wednesday between 11am and 2pm ET, Thursday between 10am and 12pm ET, and Thursday between 3pm and 4pm ET.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Baker, W. Todd <todd.baker@kirkland.com>

Sent: Monday, September 25, 2023 6:06 PM

To: Trials <Trials@USPTO.GOV>

Cc: peklem@reichmanjorgensen.com; clehman@reichmanjorgensen.com; jcardenas-navia@reichmanjorgensen.com; mmatulewicz-crowley@reichmanjorgensen.com; RJ_VideoLabs-Facebook@reichmanjorgensen.com; #Meta_VideoLabs <Meta_VideoLabs@kirkland.com>

Subject: Meta v. VideoLabs, IPR2023-00923

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Honorable Board,

Petitioners respectfully request leave to file a Reply along with supplemental evidence in response to Patent Owner's Preliminary Response (POPR), under 37 C.F.R. §§ 42.2, 42.23, 42.24(c), and 42.108(c) and pursuant to the precedential decision in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 14-16 (PTAB Dec. 20, 2019) (Precedential).

Good cause for a Reply exists at least because the POPR challenges the printed publication and public accessibility status of both the Handley reference (Ex. 1005) and the PacketCable reference (Ex. 1007). Said arguments were not known or available to Petitioners at the time the petition was filed. *See also, Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 7, 14-16 (PTAB Dec. 20, 2019) (Precedential). Further, discretionary denial under 35 USC § 325(d) is dispositive. The dispositive nature of the issue satisfies the good cause standard and, as such, a reply is appropriate. *See General Plastics Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 10 at 2 (PTAB Sep. 14, 2016).

Contrary to Patent Owner's arguments (below), the Board has also found good cause for leave to file a reply regarding public accessibility in at least the following cases: (1) *Google LLC v. Vocalife LLC*, IPR2022-00005, Paper 7 at 2-4 (PTAB Feb. 22, 2022) (granting request to submit a reply limited to the issue of whether a prior art reference qualifies as a printed publication and to file a declaration from a co-author in support); (2) *Samsung Electronics Co., LTD. v. Greenthread LLC*, IPR2020-00292, Paper 9 at 7 (PTAB May 22, 2020) (authorizing Petitioner to respond in a reply to Patent Owner's argument in the POPR regarding a reference's status as a prior art printed publication); (3) *Axis Comm's AB et al. v. Avigilon Fortress Corp.*, IPR2019-00235, Paper 13 at 2 (PTAB March 28, 2019) (finding good cause exists to support Petitioner's request for a reply to Patent Owner's Preliminary Response to address Patent Owner's assertion that a prior art reference is not a printed publication);

and (4) *Emerson Elec. Co. v. SIPCO, LLC*, IPR2019-00545, Paper 11 at 2-3 (PTAB June 29, 2019) (finding good cause for Petitioners to file a reply to POPR relating to the public accessibility issues of the cited prior art).

Petitioners request that the Reply be limited to the scope allowed for in the Rules. Namely, the Reply will only respond to arguments raised in the POPR pursuant to 37 C.F.R. § 42.23(b). Petitioners also agree to limit the Reply itself to three pages. Specifically, in addition to the Reply itself, Petitioners will include supplemental evidence to further confirm, in response to PO's arguments, that the Handley and PacketCable references were each publicly available as of the dates set forth in the Petition and are, in fact, prior art (pursuant to the journal citation and internet link evidence included in the Petition at, *inter alia*, §V. A. 1. and List of Exhibits (page iv)). Petitioners submit that its supplemental evidence would include:

1. A Supplemental Declaration from Dr. Henry Houh, Petitioners' previously disclosed technical expert witness, regarding the publication status and public accessibility of the Handley reference;
2. A Supplemental Declaration from Dr. Sylvia Hall-Ellis regarding the publication status and public accessibility of the Handley reference. Said declaration will include:
 - a. A version of the Handley reference as published in *COMPUTER NETWORKS*, Vol. 31, No. 3 on February 11, 1999;
 - b. A version of the Handley reference as published online by Elsevier on its sciencedirect.com website, matching the version as published in *COMPUTER NETWORKS*, Vol. 31, No. 3, each of which confirm publication and public accessibility on February 11, 1999; and
 - c. Related screenshots of Elsevier's sciencedirect.com website showing publication and availability dates for its publication entitled *COMPUTER NETWORKS*, Vol. 31, No. 3;
3. A declaration from a named author of the Handley reference regarding the status of the Handley reference as a printed publication and its public accessibility; and
4. A Supplemental Declaration from Dr. Hall-Ellis regarding the publication status and public accessibility of the PacketCable reference.

Petitioners request that the Reply be due at least four weeks after the filing of the POPR (*i.e.*, due on or after October 6, 2023). Should the Board believe a conference call is necessary, please advise. Petitioners have conferred with Patent Owner in an attempt to resolve any disputes. Patent Owner responded as follows:

Patent Owner opposes Petitioners' request for leave to file a Reply and supplemental evidence. Petitioners were required by statute to include in the Petition the arguments and evidence related to prior art status that they now seek to provide in a Reply. 35 U.S.C. § 312(a); *Hulu, LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 12–13 (PTAB Dec. 20, 2019) (Precedential) (Petition must “identify *with particularity* the grounds for institution and evidence supporting such grounds,” including “the prior art relied upon *and evidence that it qualifies as such.*”) (emphases added). Yet the Petition did not include *any* evidence supporting Petitioners' assertions that the Handley (EX1005) and PacketCable (EX1007) references are prior art. POPR, at 33-36, 40-41. Given the clear statutory requirement, it was entirely foreseeable that Patent Owner would point out the Petition's failure to present evidence that Handley and PacketCable are prior art. Petitioners thus cannot establish good cause for their requested Reply, as multiple other panels have found in denying similar requests. *See, e.g., Victoria's Secret Stores LLC v. Andra Group, LP*,

IPR2020-00853, Paper 11 at 4 (PTAB Aug. 13, 2020) (citing Consolidated Trial Practice Guide 52 (Nov. 2019)) (denying request to submit a pre-institution reply regarding the prior art status of a reference because it was “reasonably foreseeable” that patent owner would challenge the status); *BMW of N. Am. LLC v. Intellectual Ventures*, IPR2017-01558, Paper 8 at 2–3 (PTAB Oct. 25, 2017) (same).

Moreover, the Petition is already thousands of words over the limit, and Petitioners now seek to further violate the Board’s regulations with 3 more pages of argument (constituting more than 600 additional words) and myriad supplemental evidence. 37 C.F.R. § 42.24; POPR, at 25-32. Petitioners’ request should thus also be denied as lacking good cause because it seeks to further violate one rule (word limit) to attempt to cure its failure to meet another (establishing prior art status). POPR, at 41-43; see *Instrumentation Laboratory Co. v. Hemosonics LLC*, IPR2018-00264, Paper 7 at 4 (PTAB Mar. 9, 2018) (denying request for pre-institution reply in part because it “would effectively allow Petitioner to extend the length of its petition”).

Petitioners are also incorrect that “[t]he dispositive nature of the issue satisfies the good cause standard.” The panel decision cited by Petitioners did not hold or suggest that the dispositive nature of an issue alone could satisfy the good cause requirement for a pre-institution reply. See *General Plastics Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 10 at 2 (PTAB Sep. 14, 2016). Indeed, panels have expressly rejected the argument that good cause for a pre-institution reply exists just because “the issues discussed [in the POPR] are case dispositive,” *Instrumentation Laboratory*, IPR2018-00264, Paper 7 at 4, and others have denied requests to submit pre-institution replies and supplemental evidence related to the prior art status of references, see, e.g., *RayVio Corp. v. Nitride Semiconductors Co., Ltd.*, IPR2018-01139, Paper 14 at 8-9 (PTAB Oct. 31, 2018); *Franklin Electric Co., Inc. et al. v. Liberty Pumps, Inc.*, IPR2017-00112, Paper 11 at 2-3 (PTAB Feb. 16, 2017). Petitioners’ request should therefore be denied.

Thank you,

Todd Baker

Counsel for Petitioner

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