

RE: IPR2023-00953; Requested Call re Motion to Strike

Trials <Trials@USPTO.GOV>

Mon 3/18/2024 7:01 AM

To: David Berten <dberten@giplg.com>; Trials <Trials@USPTO.GOV>

Cc: Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>; Bock, Joel N. <joel.bock@dentons.com>; Tuck, James D. <james.tuck@dentons.com>; femi.masha@dentons.com <femi.masha@dentons.com>; Alison Richards <arichards@giplg.com>; Kristina Martin <kmartin@giplg.com>; Ragnar Olson <rolson@giplg.com>

Counsel,

From the Board –

Patent Owner's request to file a motion to strike is denied. Patent Owner should use its sur-reply to respond to Petitioner's reply, including stating and explaining any objections to the evidence Petitioner relies on in its reply.

Regards,

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

From: David Berten <dberten@giplg.com>

Sent: Thursday, March 14, 2024 3:32 PM

To: Trials <Trials@USPTO.GOV>

Cc: Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>; Bock, Joel N. <joel.bock@dentons.com>; Tuck, James D. <james.tuck@dentons.com>; femi.masha@dentons.com; Alison Richards <arichards@giplg.com>; Kristina Martin <kmartin@giplg.com>; Ragnar Olson <rolson@giplg.com>

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Dear Board:

Petitioner filed its Reply in support of the Petition on March 19. Among 9 new references and two new declarations submitted with the Reply, the Reply relies on what the Petition calls Exhibit 1017. Exhibit 1017 is the application version of Krassner, which was expressly expunged from the IPR and which the Board stated "may not be re-filed." See Paper 21. The other references were available prior to the Petition being filed and are being used to backfill an element missing from the Petition. Patent Owner seeks leave to file a Motion to Strike so that Patent Owner can know which, if any, of the 8 new and 1 expunged references need to be addressed in the Sur-Reply.

Petitioner's response to these accusations is that Board rules and precedent, including the *Hulu* decision, allows petitioners' replies to include rebuttal evidence. IPR2018-01039, Paper 29, 7 (PTAB December 20, 2019) (precedential). Petitioner understands the context of FN 1 of Paper 21 to be prohibiting refiling of the Krassner pre-grant publication as supplemental information with a corrected exhibit number, and FN1 did not address submitting it as rebuttal evidence, as discussed in the *Hulu* decision. Each of the exhibits rebuts new, unanticipated arguments from the POR, including enablement and secondary considerations. None of the new references were "used to backfill an element missing from the Petition."

The parties are available for a call with Board at the following times:

- Monday March 18 @ 9–12 or 1–5 EDT; or
- Tuesday March 19 [all day]

David Berten, Founder and Partner
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Duration v. Rich Media Club
IPR2023-00953, 11,443,329
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