

Diana Bradley

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 22, 2023 12:34 PM
To: Usman Khan; Trials
Cc: rmirzaie@raklaw.com; mfenster@raklaw.com; Dale Chang; Amy E. Hayden; nrubin@raklaw.com; pwang@raklaw.com; IPR39843-0163IP1; AXF-PTAB
Subject: RE: IPR2023-01157 Samsung v. Headwater 224 IPR - Request for pre-institution briefing

[This email originated outside of F&R.]

Counsel:

From the Board –

No call is necessary. Petitioner may file a 5-page reply addressing only the 325(d) issue, due two weeks from receipt of this email. Patent Owner may file a 5-page sur-reply addressing the 325(d) issue, due two weeks after Petitioner files its reply. As for Petitioner's request for additional briefing concerning reasons to combine references, we deny authorization at this time, because "identifying and evaluating statements or misstatements of the facts and law are well within the purview of the [panels of judges] assigned to these proceedings." *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00593, Paper 11 at 3 (PTAB July 1, 2016).

Regards,

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

From: Usman Khan <khan@fr.com>
Sent: Wednesday, November 22, 2023 12:56 PM
To: Trials <Trials@USPTO.GOV>
Cc: rmirzaie@raklaw.com; mfenster@raklaw.com; Dale Chang <dchang@raklaw.com>; Amy E. Hayden <ahayden@raklaw.com>; nrubin@raklaw.com; pwang@raklaw.com; IPR39843-0163IP1 <IPR39843-0163IP1@fr.com>; AXF-PTAB <AXF-PTAB@fr.com>
Subject: IPR2023-01157 Samsung v. Headwater 224 IPR - Request for pre-institution briefing

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Your Honors:

Petitioner requests authorization to submit a Petitioner pre-institution reply in the above-referenced IPR.

Petitioner would like to address the following two issues in the requested reply.

1. 325d – In the Patent Owner Preliminary Response (POPR), Patent Owner argues that the Petition should be discretionarily denied because family member applications related to Cole and Rao were considered by the Examiner during prosecution. Petitioner requests briefing to address the 325d arguments advanced in the POPR. Good cause exists for briefing because Petitioner could not have predicted the specific arguments raised by Patent Owner for discretionary denial.
2. Reasons to combine Cole, D’Amore, and Rao – In the POPR, Patent Owner argues against the Cole, D’Amore, and Rao combination, but, in doing so, mischaracterizes the prior art references and combinations asserted in the Petition, and makes arguments that are inconsistent with the disclosure in the prior art references. Petitioner requests briefing to address Patent Owner’s combination arguments. Good cause exists for this request because Petitioner could not have foreseen the mischaracterizations and specific arguments advanced in the POPR.

Petitioner requests 8 pages of briefing to address the two issues noted above.

Mindful of the Board’s direction to reserve substantive arguments for a Board call and subsequent briefing, Petitioner remains willing to offer further detail during a Board call, including the unforeseeable nature of POPR arguments addressed by the proposed request.

Petitioner reached out to Patent Owner’s counsel, who provided the following position:

Patent Owner opposes Petitioner’s request for additional briefing, because the Petition could have addressed (and in some cases, did address) the issues raised in the POPR, and during a meet and confer Petitioner did not identify any mischaracterizations of the Petition or references. However, if the Board does grant Petitioner’s requested briefing, Patent Owner requests a responsive brief of the same length.

Should the Board desire to have a call with the parties to discuss this request, both parties are available at the following times:

- Tues, Nov. 28: 10-11 am, 2-3 pm, 330-430 pm EST
- Wed, Nov. 29: 10-1 pm, 2-330 pm EST
- Thurs, Nov. 30: 10-11 am EST

If the Board has any questions or would like further information, please let us know.

Regards,

Usman A. Khan, Ph.D., Esq.

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