

From: [Ashe Puri](#)
To: [Trials](#); [Ryan Santurri](#); [Williams, Daveina](#); [Sasha Rao](#); [Chris F. Regan](#); [David Carus](#)
Subject: RE: Filing Date Accorded IPR2023-01162, challenging patent 8,032,278 B2
Date: Monday, December 18, 2023 11:22:06 AM
Attachments: [image002.png](#)
[image003.png](#)

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Dear Ms. Goldschlager,

A dispute has arisen between Petitioner Verizon Connect Inc. (“Verizon”) and Patent Owner Omega Patents, LLC (“Omega Patents”) concerning the deadline by which Omega Patents’ Preliminary Response was due and its impact on the deadline of the Board’s Institution Decision. Verizon asserts that Omega Patents missed the Preliminary Response deadline by two weeks and therefore should be stricken. Omega Patents has indicated that it disagrees with Verizon’s position. The parties have provided the following brief summary of their arguments and request a conference with the Board:

Verizon’s position:

Under 37 C.F.R. § 42.107(b): “The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date.”

The Board had issued clear guidance regarding when the Preliminary Response was due. Per the Board’s instructions in Paper No. 6 (“Errata”), the Notice of Filing Date Accorded was provided a mailing date of August 24, 2023 with additional instructions from the Board that “[a]ll due dates continue to run from the date of Notice of Filing Date Accorded was entered, August 24, 2023.” Based on these instructions, Omega Patents’ Preliminary Response was due by November 24, 2023 -- three months after the August 24, 2023 entry of the Notice of Filing Date Accorded. Instead, Omega Patents filed its response on December 8, 2023 – two weeks late – and is therefore untimely and should be stricken.

Verizon further seeks guidance from the Board on whether the late filing of the Preliminary Response will impact the deadline of the Board’s institution decision, which is statutorily due within 3 months from the November 24th filing deadline of the Preliminary Response.

Pursuant to 35 USC § 314: “The Director shall determine whether to institute an *inter partes* review ... within 3 months after – (1) receiving a preliminary response to the petition under section 313; or (2) if not such preliminary response is filed, the last date on which such response may be filed.”

Verizon also briefly responds to Omega Patents’ arguments. Omega Patents states that there is no record of the Board’s Errata (Paper No. 6). The parties’ counsel were emailed a notification of the filing of the Board’s Errata (Paper No. 6) via the Board’s P-TACTS electronic notification system. The Board’s Errata can also be found on the P-TACTS website.

Omega Patents' position

The Board issued Paper No. 4, a notice of defective petition, which accorded the filing date of June 30, 2023 for the petition but required the defects be corrected within 5 business days. On September 8, 2023, the Board issued a notice of acceptance corrected petition, which noted the filing date and ordered the PO to file a preliminary response within 3 months of notice. PO contacted the Board to confirm the date and Ms. Goldschlager confirmed "Patent Owner may file a Preliminary Response to the Petition no later than three months from the date of the Notice of Filing Date Accorded to Petition. Please see 37 C.F.R. 42.107 (b) regarding same." PO docketed this date as December 8, 2023. According to P-TACTS, the Board issued an "Errata" several hours later that corrected the notice of filing date accorded as August 24, 2023, though counsel for PO had no record of this Errata in its electronic filing system. The Errata also says "[a]ll due dates continue to run from the date of Notice of Filing Date Accorded was entered, August 24, 2023." However, PO understood this to mean any dates associated with the [new] accorded filing date, not that the date of the September 8 Notice should be retroactively dated to August 24, 2023. Thus, based on the email guidance from Ms. Goldschlager on September 8, PO docketed a deadline of December 8, 2023. To the extent this was incorrect, there is no prejudice to Petitioner by acceptance of the POPR as of December 8, 2023, and PO's Preliminary Response should be accepted as filed.

Kind regards,
Ashe

Ashe Puri

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From: Trials <Trials@USPTO.GOV>
Sent: Friday, September 8, 2023 11:03 AM
To: Ryan Santurri <rsanturri@allendyer.com>; Williams, Daveina <Daveina.Williams@USPTO.GOV>; Trials <Trials@USPTO.GOV>; Ashe Puri <apuri@MaynardNexsen.com>; Sasha Rao <sr Rao@MaynardNexsen.com>; Chris F. Regan <cregan@allendyer.com>; David Carus <dcarus@allendyer.com>
Subject: RE: Filing Date Accorded IPR2023-01162, challenging patent 8,032,278 B2

Counsel,

Patent Owner may file a Preliminary Response to the Petition no later than three months from the date of the Notice of Filing Date Accorded to Petition. Please see 37 C.F.R. 42.107 (b) regarding same.

Regards,

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

From: Ryan Santurri <rsanturri@allendyer.com>
Sent: Friday, September 8, 2023 1:48 PM
To: Williams, Daveina <Daveina.Williams@USPTO.GOV>; Trials <Trials@USPTO.GOV>;
apuri@MaynardNexsen.com; srao@MaynardNexsen.com; Chris F. Regan <cregan@allendyer.com>;
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Subject: RE: Filing Date Accorded IPR2023-01162, challenging patent 8,032,278 B2

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M. Williams,

For clarification, this notice indicates "The petition for inter partes review filed in the above proceeding has been accorded the filing date of June 30, 2023." However, it also says "Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice." So are we calculating the preliminary response deadline as 3 months from the accorded filing date or from the date of this notice (September 8, 2023)?

Regards,
Ryan



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From: Williams, Daveina <Daveina.Williams@USPTO.GOV>
Sent: Friday, September 8, 2023 1:39 PM
To: Trials <Trials@USPTO.GOV>; apuri@MaynardNexsen.com; srao@MaynardNexsen.com; Ryan

Santurri <rsanturri@allendyer.com>; Chris F. Regan <cregan@allendyer.com>; David Carus <dcarus@allendyer.com>

Subject: Filing Date Accorded IPR2023-01162, challenging patent 8,032,278 B2

Hello,

The attached Petition has been filed in IPR2023-01162, challenging patent 8,032,278 B2.

Thank you,
Daveina Williams
US Patent Trial and Appeal Board

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