

From: [John Holley](#)
To: [Beyer, Carrie](#); [Blair Jacobs](#); [Christina Ondrick](#); [Elizabeth Bernard](#)
Cc: [Stoll-DeBell, Kirstin L.](#); [Kachmer, Zach D.](#); [Softex MS](#)
Subject: RE: Microsoft Corp. v. Softex, LLC, IPR2023-01185
Date: Thursday, December 7, 2023 5:33:21 PM
Attachments: [image001.png](#)
[image002.png](#)

Carrie,

Apologies for the delay. I was in a lengthy claim construction deposition most of today.

We have not heard back from you regarding several of our questions; therefore, we are left to assume that HP, Dell and Lenovo are not willing to be subject to the estoppel provisions of §315 and intend to reference the second renewed motion to the customer suit exception that was already denied for HP and Dell. Below is an updated draft for you to send to the Board. If you make any edits, please send them to us first before contacting the Board.

Thanks,
John

--Draft to the Board --

Honorable Board,

Petitioner respectfully requests a pre-institution reply on two issues in IPR2023-01185:

1. PO's argument that Petitioner failed to identify all real parties-in-interest.
2. PO's argument that institution should be discretionarily denied under 35 U.S.C. § 314(a) based on application of the *Fintiv* factors.

Petitioner requests a 2-page reply to address the first issue and a 5-page reply to address the second issue.

The parties have conferred by email. PO **opposes** each request. Petitioner does not oppose PO's contingent request for sur-replies of equal length to the replies should the Board grant Petitioner the requested relief.

PO **opposes** briefing on issue (1) because good cause does not exist for briefing that issue. Petitioner already referenced HP, Dell and Lenovo in the RPI section of the petition but chose not to identify them as RPIs. Therefore, it had an adequate opportunity in the petition to reveal the RPIs.

PO **opposes** briefing on issue (2) because good cause does not exist for briefing that issue. Petitioner already provided its *Fintiv* analysis. Therefore, it had an adequate opportunity in the petition to address the *Fintiv* factors.

The parties can be available for a call to discuss this request on Friday from 10 am to 3 pm ET or at the Board's convenience on Monday or Tuesday next week.

McKool Smith | John Holley

Principal | Washington, D.C. | Tel: (202) 370-8320

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From: John Holley <jholley@McKoolSmith.com>

Sent: Wednesday, December 6, 2023 8:11 PM

To: Beyer, Carrie <carrie.beyer@faegredrinker.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldebell@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

Subject: Re: Microsoft Corp. v. Softex, LLC, IPR2023-01185

Thanks, Carrie.

We will discuss this with our client tomorrow and let you know.

In the meantime, page 11 of the documents you sent is a signature block. Also, to confirm, Defendants have not agreed to be estopped under section 315, correct? And are you referring to the first renewed motion or the second renewed motion? Any clarification you can provide would be greatly appreciated.

Have a nice evening,
John

McKool Smith | John Holley

Principal | Washington, D.C. | Tel: (202) 370-8320

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From: Beyer, Carrie <carrie.beyer@faegredrinker.com>

Sent: Wednesday, December 6, 2023 8:02 PM

To: John Holley <jholley@McKoolSmith.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldebell@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

Subject: RE: Microsoft Corp. v. Softex, LLC, IPR2023-01185

Hi John,

Regarding the stay, we're referring to the attached Motions to Stay Case Based on New Facts (ECF No. 73 in HP case, ECF No. 76 in Dell case) filed on October 31, 2023, after Softex filed its Preliminary Response stating that "[n]o party has moved to stay the ongoing Texas district court cases in view of the IPR filing[.]" Also, on page 11 of these motions, defendants stated that they "agree[] to be bound by any Final Written Decision in the Microsoft IPR."

We believe that Softex has all the information needed to let us know whether it opposes the proposed reply and sur-reply. Please let us know its position by 1 p.m. CT on Thursday, December 7. If Softex opposes, please provide your availability for a call with the Board on Friday 12/8, Monday 12/11, and Tuesday 12/12.

Best regards,
Carrie

From: John Holley <jholley@McKoolSmith.com>

Sent: Wednesday, December 6, 2023 4:31 PM

To: Beyer, Carrie <carrie.beyer@faegredrinker.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldebell@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

Subject: RE: Microsoft Corp. v. Softex, LLC, IPR2023-01185

This Message originated outside your organization.

Hi Carrie,

Regarding the RPI issue, you state, "[D]efendants have agreed to be bound by the outcome of the IPR FWD in the co-pending litigation." We are unsure of what agreement you are referring to, so please direct us to where the Defendants made that agreement. Also, HP, Dell and Lenovo have not agreed to be estopped under 35 U.S.C. §315. Please let us know if you disagree.

Regarding the §314(a) issue, when you say that Defendants "moved for a stay of the proceedings," are you referring to the first renewed motion for stay that Defendants lost (*see, e.g.*, 1:22-CV-01309-DAE at Dkt. No. 57) or Defendant's *second* renewed motion on the same issue?

Once we hear back from you, we will evaluate your responses with our client and let you know whether Softex opposes the requested Reply.

Thanks,

John

McKool Smith | John Holley

Principal | Washington, D.C. | Tel: [\(202\) 370-8320](tel:(202)370-8320)

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From: Beyer, Carrie <carrie.beyer@faegredrinker.com>

Sent: Wednesday, December 6, 2023 10:01 AM

To: John Holley <jholley@McKoolSmith.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldeb主@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

Subject: RE: Microsoft Corp. v. Softex, LLC, IPR2023-01185

Hi John,

We're happy to provide the requested further information and appreciate the reminder that we should include it in our email to the Board.

First, on the RPI issue, good cause exists for the proposed reply due to unanticipated arguments made by PO in its Preliminary Response. Although Petitioner preemptively addressed the RPI issue by disclosing the defendants in the district court litigations and noting its belief that an RPI determination is unnecessary under *Unified Patents* and *Shark Ninja*, Petitioner did not foresee—and could not have foreseen—that PO would spend a full 10 pages of its Preliminary Response arguing that this precedent does not apply here because, in PO's view, Petitioner acted in bad faith with respect to its Mandatory Disclosures. Petitioner strongly disagrees with PO's assertion of bad faith and, in fairness, should be granted the opportunity to respond to PO's allegations and unanticipated arguments.

Second, on the §314(a) issue, good cause exists for the proposed reply due to changes to the relevant circumstances. Since the filing of the Petition, the WDTX has entered a scheduling order in the co-pending litigations, the defendants in those cases have moved for a stay of proceedings, the defendants have agreed to be bound by the outcome of the IPR FWD in the co-pending litigation, and the parties have filed claim construction briefs. Each of these developments bears on the applicable *Fintiv* factors, and Petitioner should be granted the opportunity to address these changed circumstances.

Also, please note that we intend to cite several exhibits that are either already in your possession or are publicly available in connection with these arguments.

We currently anticipate that the requested 7-page reply will include 5 pages on the RPI issue and 2 pages on the §314(a) issue. While PO's arguments are lengthy, we are endeavoring to provide succinct replies using the minimum number of pages to adequately address the issues.

We look forward to hearing from you shortly regarding whether PO will agree to the proposed reply and sur-reply.

Best regards,
Carrie

From: John Holley <jholley@McKoolSmith.com>

Sent: Tuesday, December 5, 2023 3:44 PM

To: Beyer, Carrie <carrie.beyer@faegredrinker.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldebell@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

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This Message originated outside your organization.

Counsel,

We need more information from you before we can consider whether or not we agree with Petitioner's request for a reply. Once you answer the questions below, we will need to speak with our client, and then we will let you know one way or the other.

Petitioner's message does not articulate any good cause for seeking leave to reply to the Patent Owner's Preliminary Response (POPR). But Petitioner is required to make that showing. 37 CFR §42.108(c) (".... A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.") Before we can determine whether we oppose Petitioner's requests, please explain:

- What is Petitioner's good cause for seeking a reply to the RPI issue, given that Petitioner already addressed this issue in its Petition?
- How many pages does Petitioner need for the RPI issue (and why)?
- What is Petitioner's good cause for seeking a reply to the §314(a) issue, given that Petitioner already addressed this issue in its Petition?
- How many pages does Petitioner need for the §314(a) issue (and why)?

Thanks,

John



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From: Beyer, Carrie <carrie.beyer@faegredrinker.com>

Sent: Monday, December 4, 2023 5:34 PM

To: John Holley <jholley@McKoolSmith.com>; Blair Jacobs <bjacobs@McKoolSmith.com>; Christina Ondrick <condrick@McKoolSmith.com>; Elizabeth Bernard <ebarnard@McKoolSmith.com>

Cc: Stoll-DeBell, Kirstin L. <kirstin.stolldebell@faegredrinker.com>; Kachmer, Zach D. <zach.kachmer@faegredrinker.com>; Softex_MS <Softex_MS@mckoolsmith.com>

Subject: Microsoft Corp. v. Softex, LLC, IPR2023-01185

Counsel:

Petitioner intends to contact the Board to request authorization for a 7-page pre-institution reply to address Patent Owner's real party-in-interest and *Fintiv* arguments. Petitioner agrees to allow Patent Owner a sur-reply of equal length.

Please let us know if Patent Owner opposes this request. A draft email to the Board is proposed below.

If Patent Owner opposes this request, please provide your availability for a call with the Board on each day from December 5 through December 8.

Best regards,
Carrie

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Dear Honorable Board:

Petitioner respectfully requests a 7-page pre-institution reply in IPR2023-01185 to address Patent Owner's real party-in-interest and *Fintiv* arguments. Petitioner agrees to allow Patent Owner a sur-reply of equal length.

The parties have met and conferred, and Patent Owner has indicated it **does not oppose** authorizing

the 7-page reply and sur-reply.

Should the Board wish to schedule a call, the parties are available for a call with the Board on [to be inserted].

Respectfully submitted,
Counsel for Petitioner

Carrie A. Beyer

Partner

Pronouns: she/her/hers

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