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To: [David M. Magee](#); [Trials](#)
Cc: [Marc Vander Tuig](#); [Kyle G. Gottuso](#); [Bradley D Liddle](#); [Jeff Stephens](#); [Scott Breedlove](#); [Howard Lim](#); [Michael Pomeroy](#)
Subject: RE: Request for Authorization to File Preliminary Replies - IPR2023-01218, IPR2023-01219, and IPR2023-01220
Date: Wednesday, November 15, 2023 1:58:41 PM

Counsel,

From the Board –

Taking account of the information presented, the panel determines that additional briefing may be helpful to the Board in reaching an equitable decision on institution in each of the three proceedings at hand. On that basis, the panel authorizes additional briefing as follows: In each proceeding, Petitioner may file a three-page reply, and Patent Owner may file a three-page sur-reply, strictly limited to the arguments presented in the email below from counsel. The reply is due within five business days of the date of this email, and the sur-reply is due within five business days of the filing of any reply. No new evidence may accompany either brief. No conference call is necessary. Going forward, please refrain from presenting extensive legal arguments and case authority in any email communications to the Board. A copy of this email correspondence shall be entered in each proceeding as Exhibit 3001.

Regards,

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

From: David M. Magee <DMagee@atllp.com>
Sent: Monday, November 13, 2023 6:09 PM
To: Trials <Trials@USPTO.GOV>
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Subject: Request for Authorization to File Preliminary Replies - IPR2023-01218, IPR2023-01219, and IPR2023-01220

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Dear Honorable Board,

Pursuant to 37 C.F.R. § 42.108(c), Petitioner respectfully requests authorization to file Preliminary Replies to the Patent Owner's Preliminary Responses ("POPR") in IPR2023-01218, IPR2023-01219,

IPR2023-01218, -01219, -01220
Ex. 3001

and IPR2023-01220. Petitioner seeks leave to file Preliminary Replies of no more than ten pages each in order to address Patent Owner's discretionary denial arguments under 35 U.S.C. § 314(a). More specifically, Petitioner's Preliminary Replies would focus on the Patent Owner's application of new evidence to the *General Plastic* factors, the corresponding mischaracterizations within that analysis, and the misapplication of the "significant relationship" test, as applied by *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (P.T.A.B. Apr. 2, 2019).

Petitioner's Position:

Good cause exists for at least two reasons. First, Patent Owner's Preliminary Responses contained arguments that Petitioner could not have reasonably foreseen. For example, Patent Owner argues that several *General Plastic* factors weigh against institution because there is a "significant relationship" between Petitioner and Arnold & Richter Cine Technik GmbH & Co. Betriebs KG. *See, e.g.*, IPR2023-01218 POPR at 16-17; IPR2023-01219 at 17-18; IPR2023-01220 at 25-26. This "significant relationship" argument is erroneous, especially to the extent it is used in support of Patent Owner's "roadmap" arguments. *See, e.g.*, IPR2023-01218 POPR at 17-20; IPR2023-01219 at 18-21; IPR2023-01220 at 26-30. Second, permitting Petitioner to reply on this issue would clarify the record and aid the Board in deliberation on issues that are potentially dispositive to institution of the pending petitions. *See, e.g., Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2023-00446, Paper 9 (P.T.A.B. Aug. 7, 2023) (granting institution after "authoriz[ing] the filing of a Reply by Petitioner to Patent Owner's Preliminary Response...to further consider the arguments of the parties with respect to the application of [the Board's] discretion under 35 U.S.C. § 314(a)"); *Nanobebe US Inc. v. Mayborn (UK) Ltd.*, IPR2023-00467, Paper 7 (P.T.A.B. Apr. 27, 2023) (*sua sponte* authorizing Petitioner to file a Reply to address Patent Owner's *General Plastic* argument); *Nanobebe US Inc. v. Mayborn (UK) Ltd.*, IPR2023-00467, Paper 11 (P.T.A.B. June 16, 2023) (granting institution after the Board considered a Preliminary Reply and Sur-reply on Patent Owner's discretionary denial arguments relating to *General Plastic*).

Petitioner contacted Patent Owner on November 8, 2023 to meet and confer on this request. The parties have conferred on the requested relief, including the proposed page limitations and scope; however, Patent Owner opposes the request for the following reasons.

Patent Owner's Position:

This is Petitioner's second set of petitions for IPR against the patents at issue in IPR2023-01219 and -01220 and were filed one year and seven months after Videndum's first set of petitions; yet Petitioner did not address the *General Plastic* factors in their current petitions. The two stated reasons for alleged good cause do not explain why Petitioner couldn't have addressed these issues in their petitions. Petitioner's first argument that "Petitioner could not have reasonably foreseen" that Patent Owner would provide a *General Plastic* analysis does not establish good cause given the serial nature of their IPR filings. This second set of petitions are near-copycat petitions of instituted IPRs (IPR2021-01496, IPR2021-01497 and IPR 2022-00099) that Petitioner was aware of almost two years ago when filing their first set of petitions. The second set of petitions not only uses the same art and combinations, but barely changes any words used from the prior set of IPRs from Petitioner Arnold & Richter Cine Technik GmbH & Co ("ARRI"). When the Board denied institution of Videndum's first set

of petitions on June 8, 2022, Petitioner then failed to join the instituted ARRI proceedings and instead tried to stop their termination due to settlement in January of 2023. After this, Videndum made the decision to wait until almost the last day of its statutory bar period to the present copycat Petitions. Accordingly, Petitioner could have “reasonably foreseen” that Patent Owner would argue the General Plastic factors, including a “significant relationship” analysis for the first factor in their preliminary response. Petitioner’s second reason for requesting a preliminary reply is also not grounds for good cause. Just because the General Plastic factors are “dispositive to institution” does not necessarily create good cause. Instead, because of the importance of these issues, Petitioner should have addressed them in its Petition.

If the Board grants leave to file a Reply, Patent Owner requests that Petitioner is limited to 3 pages and that Patent Owner should be granted leave to file a sur-reply of equal length.

The parties are generally available for a call this week, with the exception of the following dates and times: November 15 (all day) and November 17 between 9am-1:30pm Central.

Respectfully submitted,

David M. Magee



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