

## Michael Stanwyck

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Thursday, December 7, 2023 1:34 PM  
**To:** Usman Khan; Trials  
**Cc:** rmirzaie@raklaw.com; mfenster@raklaw.com; Dale Chang; Amy E. Hayden; nrubin@raklaw.com; pwang@raklaw.com; AXF-PTAB; IPR39843-0161IP1  
**Subject:** RE: IPR2023-01226 – Samsung v. Headwater 773 IPR - Request for pre-institution briefing

[This email originated outside of F&R.]

Counsel,

From the Board –

Petitioner may file a 5-page reply addressing only the 325(d) issue, due one week from receipt of this email. Patent Owner may file a 5-page sur-reply addressing the 325(d) issue, due one week after Petitioner files its reply. As for Petitioner's request for additional briefing concerning claim construction of "service usage control policy," we deny authorization at this time.

Regards,

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

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**From:** Usman Khan <khan@fr.com>  
**Sent:** Wednesday, December 6, 2023 1:39 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; AXF-PTAB <AXF-PTAB@fr.com>; IPR39843-0161IP1 <IPR39843-0161IP1@fr.com>  
**Subject:** IPR2023-01226 – Samsung v. Headwater 773 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. The Board has previously granted briefing on a similar issue in IPR2023-01157 (224 IPR).

2. Construction of “service usage control policy” - Patent Owner advances an incorrect construction of the term “service usage control policy” in an attempt to distinguish the claims from the prior art references. Good cause exists for briefing because Petitioner could not have predicted the incorrect and unsupported construction advanced by the Patent Owner. Petitioner would like the opportunity to address the construction.

Petitioner has conferred with Patent Owner. Although Patent Owner does not agree with the arguments Petitioner presents here, Patent Owner **does not object** to Petitioner’s request provided that Patent Owner gets an opportunity to respond to any brief submitted by Petitioner. The parties agreed to a length of five (5) pages for each of the briefs. If agreeable and authorized by the Board, the parties also agreed that Petitioner will submit its brief one week after receiving Board authorization and Patent Owner will submit its brief one week after Petitioner submits its brief.

Should the Board desire to have a call with the parties to discuss this request, both parties can make themselves available. Please let us know if the Board has any questions or would like further information to consider this request.

Sincerely,

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

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