

Diana Bradley

From: Trials <Trials@USPTO.GOV>
Sent: Monday, January 22, 2024 4:58 AM
To: Jennifer Huang; Trials
Cc: rmirzaie@raklaw.com; mfenster@raklaw.com; Dale Chang; Amy E. Hayden; nrubin@raklaw.com; pwang@raklaw.com; Jim Milkey; rak_headwater@raklaw.com; AXF-PTAB; IPR39843-0155IP1; IPR39843-0157IP1
Subject: RE: IPR2023-01336, IPR2023-01337 – Samsung v. Headwater (701 IPR, 578 IPR) - Petitioner's Request for Pre-Institution Briefing

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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. No other briefing is authorized at this time.

Regards,

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

From: Jennifer Huang <jhuang@fr.com>
Sent: Friday, January 19, 2024 3:49 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; Jim Milkey <jmilkey@raklaw.com>; rak_headwater@raklaw.com; AXF-PTAB <AXF-PTAB@fr.com>; IPR39843-0155IP1 <IPR39843-0155IP1@fr.com>; IPR39843-0157IP1 <IPR39843-0157IP1@fr.com>
Subject: IPR2023-01336, IPR2023-01337 – Samsung v. Headwater (701 IPR, 578 IPR) - Petitioner's 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 proceedings – IPR2023-01336 and IPR2023-01337, relating to U.S. Pat. Nos. 9,137,701 and 9,521,578, respectively, or the “701 IPR” and “578 IPR.”

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

1. 325(d) – In its Patent Owner Preliminary Responses (POPRs), Patent Owner argues that the Petitions for the two proceeding should be discretionarily denied under 325(d) because (1) family member applications related to prior art references (Rao in 701 IPR; Rao and Montemurro in 578 IPR) that were considered by the Examiner during prosecution of each corresponding challenged patent, and (2) a prior art reference (Oestvall) was substantially the same as the cited portion of the Rao reference and other references discussed during prosecution of each patent. Petitioner requests briefing to address the 325(d) arguments advanced in the POPR. Good cause exists for briefing since 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”), IPR2023-01226 (“773 IPR”), IPR2023-01250 (“433 IPR”), and IPR2023-01253 (“976 IPR”).
2. Mischaracterization of Rao (701 IPR and 578 IPR) – Patent Owner includes mischaracterizations of Rao that are inconsistent with the disclosure cited in the Petition. Good cause exists for briefing because Petitioner could not have predicted the characterizations by the Patent Owner. Petitioner would like the opportunity to identify the relevant disclosures of Rao pertinent to Patent Owner’s mischaracterizations.
3. Construction of “block” (701 IPR) - Patent Owner advances an incorrect construction of this claim term 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. Patent Owner notes the following:

Patent Owner does not object to a five-page reply in each proceeding to address 325(d), so long as Patent Owner is provided an equal-length sur-reply. However, Patent Owner does object to Petitioner's request to address merits arguments because Petitioner has not shown good cause.

Both parties will make counsel available for a call to discuss this request, if requested by the Board. Please let us know if the Board has any questions or would like further information to consider this request.

Sincerely,
Jenny

Jenny Huang :: Managing Principal :: Fish & Richardson P.C.

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