

From: [Trials](#)
To: [Kaiser, Jessica \(DEN\)](#); [Christopher Fahy](#); [Trials](#)
Cc: [*SES-imagotag-IPRs](#); [Shen Wang](#); [Hao Tan](#); [Yu Di](#); [Alyssa Yang](#)
Subject: RE: Hanshow v. SES-IMAGOTAG, IPR2024-00189 - Request for authorization of the late filing of Exhibits 1013 through 1021
Date: Thursday, December 19, 2024 12:12:32 PM

Counsel:

Petitioner's e-mail requests we authorize late filing of Ex. 1013-1021 (and updated 1021). There is no need for a conference, as there is no issue before us at this time. The Exhibits have been filed and are part of the current record, Patent Owner has objected to the evidence. If Patent Owner subsequently files a Motion to Exclude, we will rule on such a Motion at an appropriate time.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Kaiser, Jessica (Perkins Coie) <jkaiser@perkinscoie.com>
Sent: Thursday, December 19, 2024 11:37 AM
To: Christopher Fahy <christopher@archlakelaw.com>; Trials <Trials@USPTO.GOV>
Cc: SES-imagotag-IPRs@perkinscoie.com; Shen Wang <shenwang@archlakelaw.com>; Hao Tan <haotan@archlakelaw.com>; Yu Di <yudi@archlakelaw.com>; Alyssa Yang <AlyssaYang@archlakelaw.com>
Subject: RE: Hanshow v. SES-IMAGOTAG, IPR2024-00189 - Request for authorization of the late filing of Exhibits 1013 through 1021

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Dear Honorable Board,

Unfortunately, Petitioner did not properly meet and confer with Patent Owner prior to sending its December 18 email to the Board. In the prior exchange referenced in Petitioner's email to the Board, at 10:30pm MT on Thanksgiving day, Petitioner asked Patent Owner to agree to the filing of nine new exhibits in this proceeding. Patent Owner responded the next day (November 29), stating that it was unsure what Petitioner was asking it to agree to but that Patent Owner could not agree to Petitioner submitting evidence into the record over a year after Petitioner admittedly knew about such evidence, and particularly without having seen Petitioner's reply in this proceeding. On December 2, Petitioner filed its Reply (Paper 26), and on December 9, Patent Owner filed objections to evidence (Paper 27), objecting to a number of Petitioner's exhibits filed with its Reply.

Inexplicably, Petitioner sent its email to the Board yesterday without ever conferring with Patent Owner so that the parties could understand their respective positions, and so that Petitioner could

include Patent Owner's position in its email to the Board. The Board should deny Petitioner's request on that basis alone.

It is also unclear what relief Petitioner is seeking from the Board. (Again, this could have been clarified in a proper meet and confer between the parties.) From Petitioner's email, it seems Petitioner is asking the Board to excuse its over-one-year delay in filing these exhibits. But Petitioner cannot reasonably explain this delay. Petitioner incorrectly states in its email that "although Patent Owner has objected to these exhibits, it did not challenge the substantive use by Petitioner's expert of them, either in its Preliminary Response or in its Response..." That is not correct because Patent Owner's Response filed in September expressly noted this issue. *See* Paper 21, 10 n.1 ("Petitioners and/or their expert identify several background references that were not submitted as exhibits. Any reliance on unsubmitted references is improper. 37 C.F.R. §42.63(a)."). Petitioner does not explain its three-month delay in addressing this issue after Patent Owner raised it in the Response. The Board should deny Petitioner's request based on Petitioner's lengthy and unexplained delay.

Finally, Patent Owner notes that Petitioner does not give the Board complete information about the exhibits at issue in its email. Petitioner states that Exhibits 1019 and 1021 "were filed on the same date of the Petition in a separate proceeding by Petitioner, IPR2024-00190..." However, Exhibit 1019 includes an updated certification dated 11/27/2024, and Exhibit 1021 (updated) includes an updated certification dated 12/3/2024. Thus, these exhibits were not filed in their current form with the petition in IPR2024-00190 (filed 11/14/2023).

Patent Owner regrets the amount of argument already included in this email that was necessitated by Petitioner's failure to confer prior to contacting the Board. Patent Owner has additional argument regarding why Petitioner's request is improper and why there is not good cause to support it. Unless the Board denies the request based on the above, Patent Owner requests a conference call with the Board to provide additional information. If a conference call is needed, Patent Owner is available tomorrow from 11-1 ET, but did not want to delay this email to the Board to verify Petitioner's availability. Patent Owner can also confer with Petitioner and propose times of mutual availability.

Best Regards,

Jessica Kaiser
PARTNER

Perkins Coie

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From: Christopher Fahy <christopher@archlakelaw.com>
Sent: Wednesday, December 18, 2024 4:57 PM

To: Trials@uspto.gov

Cc: *SES-imagotag-IPRs <ses-imagotag-iprs@perkinscoie.com>; Kaiser, Jessica (DEN) <jkaiser@perkinscoie.com>; Shen Wang <shenwang@archlakelaw.com>; Hao Tan <haotan@archlakelaw.com>; Yu Di <yudi@archlakelaw.com>; Alyssa Yang <AlyssaYang@archlakelaw.com>

Subject: Hanshow v. SES-IMAGOTAG, IPR2024-00189 - Request for authorization of the late filing of Exhibits 1013 through 1021

HANSHOW v. SES-IMAGOTAG

Case No.: IPR2024-00189

Patent No. 10,674,340

Dear Board,

Petitioner respectfully asks the Board to authorize the late filing of Exhibits 1013 through 1021 (filed on December 2, 2024, with Exhibit 1021 further updated on December 3, 2024). Petitioner's expert referred to these documents in his first declaration (Exhibit 1009). Regretfully, due to inadvertence (including multiple same-day filings, e.g., Exhibits 1018, 1019, 1020, 1021 were filed on the same date of the Petition in a separate proceeding by Petitioner, IPR2024-00190), Petitioner failed to file them in accordance with the requirements of 37 CFR 42.6(c).

"A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." 37 CFR 42.5(c)(3). Petitioner respectfully asks the Board to find that consideration on the merits would be in the interests of justice. While the Petitioner filed these documents later than it should have, the consideration is outweighed by "the benefit of having a clearer record on which to consider the merits of the issues." See *Walmart Inc. v. Caravan Canopy Int'l., Inc.*, IPR2020-01026, Paper 48 (Sep. 17, 2021), at 2. Further, although Patent Owner has objected to these exhibits, it did not challenge the substantive use by Petitioner's expert of them, either in its Preliminary Response or in its Response, and has yet to file its Sur-Reply. Thus, Patent Owner is not prejudiced by the late filing. Accordingly, Petitioner respectfully asks the Board to excuse the late filing of the afore-mentioned Exhibits pursuant to 37 CFR 42.5(c)(3).

Petitioner raised this issue with Patent Owner, however, Patent Owner indicated its opposition on November 29, 2024 and has subsequently formally objected to the submission of these exhibits in Paper 27.

If the Board wishes to have a conference call, the parties can confer and propose times of

mutual availability.

Best Regards,

Christopher J. Fahy

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