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Sent: Thursday, March 14, 2024 12:36 PM

To: Trials <Trials@USPTO.GOV>

Cc: *SFI_PTAB <SFI_PTAB@sullcrom.com>; EHunt-PTAB@WolfGreenfield.com; GNieberg-PTAB@WolfGreenfield.com; Nathan R. Speed <Nathan.Speed@WolfGreenfield.com>; Elisabeth H. Hunt <Elisabeth.Hunt@WolfGreenfield.com>

Subject: RE: IPR2024-00214, -00215 (Google v. SFI): Request for Reply to POPR

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Dear Honorable Board:

Patent Owner objects to Petitioner's request, which contains improper argument and which was sent without concluding the meet and confer process. I attach the email thread between the parties which sets out the record. Petitioner has, without authorization, submitted their additional arguments in the form of a purported request for leave to submit those additional arguments. This is improper and a violation of the rules. *See, e.g., Polygroup Ltd. v. Willis Elec. Co., Ltd.*, IPR2016-01610, Paper 39, 3 (PTAB Feb. 27, 2017) ("Email correspondence between the parties and the Board is for administrative purposes only" and "must not include arguments"). Patent Owner objects to this submission and to Petitioner's purported request for leave to submit these additional arguments, which merely rehash issues already argued to the Board in the Petition and Patent Owner's Preliminary Response and argues only that Patent Owner's arguments allegedly "mischaracterize" facts and law. No good cause is shown for any further briefing on any of these foreseeable arguments. *See, e.g., Dell Inc. v. Neo Wireless LLC*, IPR2021-01468, Paper 10, 3 (PTAB Jan. 27, 2022) (denying petitioner's request for post-POPR briefing) ("The Board routinely determines whether a party mischaracterizes the asserted references or the other party's arguments without the need for additional briefing."). Petitioner made or could have made in its original petition all of the supplemental arguments that it now proposes, and Petitioner should not be permitted to use the Patent Owner's Preliminary Response as a roadmap to re-craft the Petition. The motion for leave should be denied.

Respectfully submitted,

Stephen J. Elliott
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Counsel for Patent Owner

From: Elisabeth H. Hunt <Elisabeth.Hunt@WolfGreenfield.com>

Sent: Thursday, March 14, 2024 8:57 AM

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IPR2024-00214, -00215
Ex. 3001

PTAB@WolfGreenfield.com; Nathan R. Speed <Nathan.Speed@WolfGreenfield.com>

Subject: [EXTERNAL] IPR2024-00214, -00215 (Google v. SFI): Request for Reply to POPR

Honorable Board,

Petitioner in IPR2024-00214 and -00215 requests a conference call to seek authorization to file a 6-page reply to the POPR filed February 28, 2024. The requested reply would correct mischaracterizations of fact and law on four points in the POPRs. Petitioner would not oppose Patent Owner being authorized a sur-reply of equal length.

Petitioner attempted to meet and confer with Patent Owner and explained that good cause exists for Petitioner to reply to correct mischaracterizations of fact and law in the POPRs as follows:

- Patent Owner's allegation that "Foster's definition of 'content,' which Petitioner cites, makes no mention of 'storage'" (-00214 POPR at 39; -00215 POPR at 41; discussing Foster, [0008]) mischaracterizes Foster which says the content is used "for...storage by a receiver" ([0008]).
- Patent Owner's allegation that Petitioner cannot rely on corroborating references as evidence of POSAs' background/general knowledge motivating modifying Orsini to meet a claim limitation (-00214 POPR at 32-33; -00215 POPR at 34-35) mischaracterizes the law, as the Federal Circuit explained in both *Ariosa* (mischaracterized by POPR) and *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337-38 (Fed. Cir. 2020) (Section II of opinion).
- Patent Owner's allegation that the "Board cannot apply" Patent Owner's claim constructions that the Petition presented as alternatives unless Petitioner has "acquiesced to" those constructions (-00214 POPR at 53, 62; -00215 POPR at 55, 60) mischaracterizes the law/rules, which "do not preclude providing alternative claim constructions in a petition" (77 Fed. Reg. 48,460, 48,700 (Aug. 14, 2012); see *Hologic* (mischaracterized by POPR) at 7). "The Board...will consider statements regarding claim construction made by patent owners...filed in other proceedings" and "will provide an initial claim construction determination in the institution decision" (Trial Practice Guide at 48-49) and should assess the Petition's alternative unpatentability showing under the construction the Board determines is correct.
- Patent Owner's allegation that Orsini's "obfuscate" step is "non-cryptographic" (e.g., POPR at 8-9) is a red herring as the Petition did not rely on the "obfuscate" step to meet the disputed limitation; and Patent Owner's allegation that the Petition relies on inherency (POPR at 13-15) mischaracterizes the Petition, which relies on Orsini's [0301] statement as evidence of express disclosure and/or obviousness of a cryptographic step (-00214 Pet. at 30-37; -00215 Pet. at 33-40).

Patent Owner responded that it "disagree[s] with [Petitioner's] characterization of SFI's POPR arguments" and "do[es] not believe good cause exists for any reply, much less on four different issues." Patent Owner declined to provide any further position other than alleging that it is "not acceptable" for Petitioner to provide the Board the same explanation of its request that it provided Patent Owner in meet-and-confer.

Counsel for both parties are available for a conference call on March 20, 21, or 22 during 1-5 PM ET.

Respectfully submitted,



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