

From: [Trials](#)
To: [Blumenkopf, Bryan](#); [Aptiv-Microchip-PTAB](#); [Jensen, Travis](#); [Lang, Jason](#); [PTABDocketJJL2@orrick.com](#); [T61PTABDocket@orrick.com](#)
Cc: [Trials](#)
Subject: RE: IPR2024-00228, -229, -230, and PGR2024-00011: Request for Authorization to File Motion to Strike
Date: Wednesday, January 29, 2025 4:58:59 PM

Counsel,

The requested authorization to file a motion to strike directed to the issues and materials identified in the email below is granted. Patent Owner is authorized to file a motion to strike limited to 10 pages within 10 days. Petitioner is authorized to file an opposition to the motion to strike limited to 10 pages within 10 days of the filing of the motion. Patent Owner is authorized (but not required) to file a reply in support of the motion to strike limited to 5 pages within 5 days of the filing of the opposition.

No teleconference is deemed necessary at this time.

Regards,

Tina Lee
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Blumenkopf, Bryan <BBlumen@mofo.com>
Sent: Tuesday, January 28, 2025 8:06 PM
To: Trials <Trials@USPTO.GOV>
Cc: Aptiv-Microchip-PTAB <Aptiv-Microchip-PTAB@mofo.com>; Jensen, Travis <tjensen@orrick.com>; Lang, Jason <jlang@orrick.com>; PTABDocketJJL2@orrick.com; T61PTABDocket@orrick.com
Subject: RE: IPR2024-00228, -229, -230, and PGR2024-00011: Request for Authorization to File Motion to Strike

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Dear Honorable Board,

For each of the four above-captioned proceedings, Patent Owner requests authorization to file a motion to strike Section IV.A.3.b of Petitioner's Reply Brief, and portions of its accompanying new evidence: paragraphs 6-17 and 44-57 of the Reply Declaration of Eric Welch (Exhibit 1102); and Exhibit 1103. These materials are identical across all four proceedings.

Patent Owner's position is that these materials improperly include new issues and belatedly presented evidence that merit granting a motion to strike. Section IV.A.3.b of the Reply is intended to address a structural flaw in the prior art that was highlighted in the Patent Owner's response. This section argues, for the first time, that the flaw could be circumvented if the Petition's proposed prior art combination were modified in new ways never identified in the Petition. Section IV.A.3.b,

and its newly presented supporting evidence, fall outside the proper scope of a Reply for at least these reasons. Moreover, the new argument and new supporting evidence could have been presented in the Petition. Deferring new argument and evidence to the Reply deprives Patent Owner of a full and fair opportunity to respond.

Petitioner's position is that a motion to strike is simply not warranted here. Section IV.A.3.b of Petitioner's Reply (and corresponding Welch Reply paragraphs) fall squarely within the scope of a proper reply. PO's assertion that Petitioner's "prior art combination w[as] modified in new ways never identified in the Petition" is misleading at best. Petitioner's Reply raises no new grounds, prior art references, or combinations (EX1103 is a textbook excerpt cited for the mundane proposition that many electronic devices can be reset). The POR manufactures a purported "flaw" only by misstating the operation of Petitioner's proposed combination, as Reply §IV.A.3.a explains. The Reply §IV.A.3.b then merely elaborates on why the combination still works, even under PO's presentation of it. *See* 37 C.F.R. 42.23 (reply may "respond to arguments raised in the corresponding opposition"). Moreover, PO already has a 5,600 word sur-reply to further respond.

The parties met and conferred via teleconference. Petitioner indicated that it opposes the motion. Petitioner further indicated that, with respect to a concurrent proceeding (IPR2024-00495), it intends to submit substantially the same Reply Declaration and arguments in a forthcoming Reply. Should Petitioner do so, Patent Owner intends to seek the same relief for that proceeding.

If the Board wishes to have a conference call to discuss, Patent Owner and Petitioner are available on Jan. 30 after 4pm; and Feb. 3 before 1pm or after 3:30pm (all times Eastern). Counsel for both parties are copied on this email.

Thank you,

BRYAN BLUMENKOPF

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