

From: [Trials](#)
To: [Frederic Meeker](#); [Trials](#)
Cc: [Paul T. Qualey](#); [John Fleming](#); [John R. Hutchins](#); [Joshua Davenport](#); [KFRIESEN@SHB.COM](#); [JMUDD@SHB.COM](#); [RDYKAL@SHB.COM](#); [RRECKERS@SHB.COM](#); [SHBTSCOMCASTIPR@SHB.COM](#)
Subject: RE: IPR2024-00321, IPR2024-00322, IPR2024-00323, IPR2024-00324, IPR2024-00325, IPR2024-00326 – Request for Authorization for Reply
Date: Friday, May 17, 2024 2:17:16 PM

Counsel,

From the Board –

Petitioner is authorized to file a five page reply on the issues identified in the email below. The reply is due five business days from the date of this email. Patent Owner may respond with a five page sur-reply due five business days from the filing of Petitioner's reply.

Regards,

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

From: Frederic Meeker <fmeeker@bannerwitcoff.com>
Sent: Tuesday, May 14, 2024 9:44 AM
To: Trials <Trials@USPTO.GOV>
Cc: Paul T. Qualey <PQualey@bannerwitcoff.com>; John Fleming <JFleming@bannerwitcoff.com>; John R. Hutchins <JHutchins@bannerwitcoff.com>; Joshua Davenport <JDavenport@bannerwitcoff.com>; [KFRIESEN@SHB.COM](#); [JMUDD@SHB.COM](#); [RDYKAL@SHB.COM](#); [RRECKERS@SHB.COM](#); [SHBTSCOMCASTIPR@SHB.COM](#)
Subject: IPR2024-00321, IPR2024-00322, IPR2024-00323, IPR2024-00324, IPR2024-00325, IPR2024-00326 – Request for Authorization for Reply

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To the Board,

Petitioner in the above-identified IPRs, Comcast Cable Communications, LLC, seeks authorization to file a short, 5-page reply under 37 C.F.R. § 42.108(c) to each of the Patent Owner's Preliminary Responses in IPR2024-00321, IPR2024-00322, IPR2024-00323, IPR2024-00324, IPR2024-00325, and IPR2024-00326.

Specifically, Petitioner seeks to address Patent Owner's arguments in all six

proceedings concerning the *Fintiv* factors. Further, Petitioner seeks to address Patent Owner's arguments in IPR2024-00322, IPR-00324, and IPR2024-00326, concerning the *Becton, Dickinson* factors.

Petitioner believes good cause exists for the request, consistent with 37 C.F.R. § 42.108(c). Examples of this good cause include:

1. With regard to the *Fintiv* factors, Petitioner intends to address Judge Gilstrap's practice regarding granting stays after institution; similarly, Petitioner intends to address factual and legal misrepresentations as to related proceedings, including clarity on what claims are asserted and challenged, and the likelihood of invalidity being resolved in pretrial.
2. With regard to the *Becton, Dickinson* factors, Petitioner believes there is good cause to address Patent Owner's arguments in IPR2024-00322, IPR2024-00324, and IPR2024-00326, concerning Danciu and Mahajan and representations about these references. Danciu was never cited in prosecution and does not qualify as "the same or substantially the same prior art or arguments [that] previously were presented to the Office" as required under 35 U.S.C. §325(d). Further, Danciu was not of record during prosecution in any of the patents in dispute, and Petitioner could not have reasonably anticipated Respondent would assert §325(d) in view of that reference. Petitioner further requests to address misrepresentations regarding Mahajan and its role in prosecution, including, for example, that Respondent's argument and cited excerpt in IPR2024-00322 fail to show that the examiner's view of Mahajan was *maintained* following Applicant's May 9, 2019, Response in a Final Rejection dated June 12, 2019. *See* IPR2024-00322 POPR at 46-47; *see also* IPR2024-00322 Exs. 2001 and 2017.

Additionally, Petitioner requests permission to file docket entries from *Touchstream Techs., Inc. v. Google, LLC*, 6-21-cv-00569 (W.D. Tex. Jun. 4, 2021) cited by the Patent Owner as exhibits for the convenience of the Board. Petitioner also requests permission to file the full '751 Patent prosecution history as an exhibit in IPR2024-00322, also for the convenience of the Board.

Petitioner has conferred with Patent Owner on these requests and understands Patent Owner's position to be as follows:

Patent Owner does not oppose a Reply limited to the issue of § 325(d) arguments pertaining to Danciu (which Patent Owner asserts is only relevant to IPR2024-00322, -324, and -326), provided Patent Owner is permitted to file a Sur-reply of equal length. Further, with regard to filing (i) docket entries from the district court cited by Patent Owner and (ii) the complete '751 prosecution history in IPR2024-00322, Patent Owner does not oppose the requests. Patent Owner disagrees, however, that anything in its POPRs misrepresents the facts or law pertaining to either the *Fintiv* factors or the *Becton, Dickinson* factors. Also, Patent Owner asserts that the issues presented under *Fintiv* and § 325(d) regarding Mahajan were reasonably anticipated by Petitioner when it prepared and filed its Petitions. Patent Owner therefore opposes any request for leave to file a Reply that encompasses those issues. To the extent the Board grants Petitioner leave to file a Reply, Patent Owner requests leave to file a Sur-reply of equal length.

The parties are available for a conference call with the Board at the following times:

1. Tuesday May 14, 12:00-1:30 pm EDT
2. Wednesday May 15, 12-1:00 pm EDT
3. Wednesday May 15, 2:30-3:30 pm EDT
4. Friday May 17 11:00 am to 12:00 pm EDT.

Respectfully,

Fred Meeker

FREDERIC MEEKER | ATTORNEY

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