

From: [Trials](#)
To: [Christopher, Angelo](#); [Trials](#)
Cc: [Hayes, Jennifer](#); [Stringfield, Daniel](#); [Zheng, Helena](#); [Mizzo, F. Christopher](#); [Rabinowitz, Alan](#); [Arovas, Greg](#); [#Samsung_NST_IPR](#)
Subject: RE: IPR2024-00338 and IPR2024-00339
Date: Tuesday, April 23, 2024 3:11:38 PM

Good afternoon counsel,

In response to the April 22, 2024, email from Petitioner's counsel and the April 23, 2024, email from Patent Owner's counsel concerning IPR2024-00338 and IPR2024-00339, in each proceeding the Board authorizes (1) Petitioner to file within five business days of this email a Preliminary Reply no longer than seven pages that addresses the issues identified in the April 22 email and (2) Patent Owner to file within ten business days of this email a Preliminary Sur-reply no longer than seven pages that responds to the Preliminary Reply.

The Board also authorizes Petitioner to file with the Preliminary Reply the exhibits identified in the April 22 mail, namely, the "exhibits that relate to Patent Owner's admission that Rădulescu, Goossens2002, and Goossens2003 are prior art" and the "exhibit in which Patent Owner disputed the district court's indefiniteness decision and argued it did not render claim 12 of the '800 patent invalid." The Board also authorizes Patent Owner to file with the Preliminary Sur-reply exhibits that relate to Patent Owner's alleged admission that Rădulescu, Goossens2002, and Goossens2003 are prior art and exhibits relating to Patent Owner's alleged dispute of the district court's indefiniteness decision. The Board does not authorize either party to file any other exhibit with the Preliminary Reply or the Preliminary Sur-reply.

Regards,

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

From: Christopher, Angelo <achristopher@nixonpeabody.com>
Sent: Tuesday, April 23, 2024 2:37 PM
To: Trials <Trials@USPTO.GOV>
Cc: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Mizzo, F. Christopher <chris.mizzo@kirkland.com>; Rabinowitz, Alan <alan.rabinowitz@kirkland.com>; Arovas, Greg <garovas@kirkland.com>; #Samsung_NST_IPR <Samsung_NST_IPR@kirkland.com>
Subject: RE: IPR2024-00338 and IPR2024-00339

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Your Honors,

We write in response to Petitioner's requests below in IPR2024-00338 and IPR2024-00339. On April 22, Patent Owner provided Petitioner with the position statement below setting forth Patent Owner's opposition, but Petitioner did not include it in its email. Because we understand the Board may rule on Petitioner's request without a conference call, we write separately to complete the record with Patent Owner's full position and its related request for preliminary sur-replies.

Patent Owner's Position

IPR2024-00338 ('449 IPR)

Patent Owner opposes and responds to each of Petitioner's rationales below:

- With respect to the alleged prior art status of Goossens2002 and Goossens2003, the PPOR argued that the Petition did not comply with the Board's rules and circumvented the word limit by improperly incorporating arguments and evidence by reference. PPOR at 39-41. Allowing a preliminary reply to advance arguments that should have been included in the Petition would vitiate the Board's rules prohibiting incorporation by reference.
- Petitioner identifies no "mischaracterizations" of law or fact in the PPOR – it simply disagrees with Patent Owner's argument that Petitioner did not comply with the Board's claim construction rules. Patent Owner submits that this does not constitute good cause.
- Petitioner identifies no "mischaracterizations" of law or fact – it merely disagrees with Patent Owner's argument that Drake does not disclose a "communication manager." Patent Owner submits that this does not constitute good cause.

IPR2024-00339 ('800 IPR)

Patent Owner opposes and responds to each of Petitioner's rationales below:

- With respect to the alleged prior art status of Radulescu, the PPOR argued that the Petition did not comply with the Board's rules and attempted to circumvent the word limit through improper incorporation by reference. PPOR at 29-34. Allowing a preliminary reply to advance arguments that should have been included in the Petition would vitiate the Board's rules prohibiting incorporation by reference.
- Petitioner is mischaracterizing the PPOR: Patent Owner argued that the Board should exercise its discretion to deny institution in view of the district court indefiniteness findings – not that they "bar[]" institution. PPOR at 10-13. Petitioner identifies no "mischaracterization" – it merely disagrees with Patent Owner's argument. Patent Owner submits that this does not constitute good cause.
- Petitioner identifies no "mischaracterizations" of law or fact – it merely disagrees with Patent Owner's argument that it did not comply with the Board's claim construction rules. Patent Owner submits that this does not constitute good cause.

Additional Exhibits

Patent Owner opposes Petitioner's request to file additional exhibits. Patent Owner asked Petitioner to specifically identify what documents it is seeking to introduce but Petitioner has not responded. Moreover, Petitioner has not alleged that these exhibits could not have been submitted with the Petitions or offered any justification for its failure to include them with the Petitions. Petitioner has therefore failed to show the requisite good cause to file unidentified additional exhibits.

Contingent Request for Authorization to File Sur-Replies

To the extent the Board grants Petitioner's requests, Patent Owner requests authorization to file sur-replies of equal length limited to the same issues as the preliminary replies. Petitioner does not oppose this request.

Respectfully Submitted,

Angelo Christopher (Reg. No. 81, 594)

Angelo J. Christopher

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From: Rabinowitz, Alan <alan.rabinowitz@kirkland.com>

Sent: Monday, April 22, 2024 4:51 PM

To: trials@uspto.gov

Cc: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; Mizzo, F. Christopher <chris.mizzo@kirkland.com>; Arovas, Greg <garovas@kirkland.com>; #Samsung_NST_IPR <Samsung_NST_IPR@kirkland.com>

Subject: IPR2024-00338 and IPR2024-00339

[EXTERNAL E-MAIL]

Be Aware of Links and Attachments

To the Board,

Petitioner respectfully requests leave to file seven-page replies to Patent Owner's Preliminary Responses in the above-referenced proceedings to address Patent Owner's arguments regarding the Board's discretion under §314(a), the status of certain references as prior art, claim construction, and certain mischaracterizations of the Petitions' claim-mapping. In particular, Petitioner seeks to address Patent Owner's argument that Petitioner purportedly has not shown the Rădulescu, Goossens2002, and Goossens2003 references are prior art printed publications (IPR2024-00338 and IPR2024-00339), that the Board should deny institution because Petitioner argued in district court

litigation that certain claim terms are indefinite (IPR2024-00339), that Petitioner allegedly did not comply with Patent Office rules by urging a means-plus-function construction for certain claim terms (IPR2024-00338 and IPR2024-00339), and that Petitioner has purportedly not identified a communication manager that is distinct from the resource manager (IPR2024-00338). Petitioner seeks leave to file replies to address certain misrepresentations in Patent Owner's Preliminary Responses. Good cause exists to file these replies at least because these issues pertain to the status of the prior art as printed publications and claim construction issues. *See, e.g., Hulu LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential board decision re the use of replies to support a reference's status as a printed publication).

Additionally, Petitioner requests authorization to file additional exhibits in support of Petitioner's arguments on these issues, including exhibits that relate to Patent Owner's admission that Rădulescu, Goossens2002, and Goossens2003 are prior art and an exhibit in which Patent Owner disputed the district court's indefiniteness decision and argued it did not render claim 12 of the '800 patent invalid.

Petitioner emailed counsel for Patent Owner regarding these requests on April 12, 2024 and April 22, 2024, and Patent Owner responded on April 15, 2024 and April 22, 2024. Patent Owner has stated it opposes Petitioner's requests. If Petitioner is authorized to file replies, Petitioner does not oppose a Patent Owner sur-reply of seven pages. Should the Board believe a call is necessary to discuss Petitioner's requests, the parties are generally available on April 25, 2024, for a conference call.

Respectfully submitted,
Alan Rabinowitz

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