From: Trials <Trials@USPTO.GOV>
Sent: Thursday, June 6, 2024 12:27 PM
To: andrew.mason@klarquist.com; Trials
Cc: Melissa Kalka; IDG_Microsoft_IPRs; Richard Kamprath; George T. Fishback, Jr.; Sarah E. Jelsema; Samuel Thacker; Frank Morton-Park; Stephanie R. Fulk; Toni R. Kammers; Todd M. Siegel
Subject: RE: IPR2024-00537 and -00538, Microsoft Corp. v. InterDigital Corp.

Counsel,

From the Board -

Petitioner's request to file a reply to Patent Owner's preliminary response in each of IPR2024-00537 and -00538 is granted. Petitioner may also file, with its reply in each matter, a copy of Lenovo's Sand II stipulation and the relevant median time-to-trial statistics for the Eastern District of North Carolina.

Petitioner's replies shall be due no later than June 14, 2024, and each shall be limited to 4 pages discussing the relevance of Lenovo's Sand II stipulation, the trial date or absence thereof, the trial court's median time-to-trial statistics, and any alleged inaccuracies in the *Fintiv* analysis provided in Patent Owner's preliminary responses.

Patent Owner is also granted the opportunity to file 4-page sur-replies, due no later than June 21, 2024, and limited to addressing issues raised in Petitioner's replies.

Regards,

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

From: Andrew M. Mason <andrew.mason@klarquist.com>
Sent: Tuesday, June 4, 2024 7:50 PM
To: Trials <Trials@USPTO.GOV>
Cc: Melissa Kalka <mkalka@McKoolSmith.com>; IDG_Microsoft_IPRs <IDG_Microsoft_IPRs@mckoolsmith.com>; Richard Kamprath <rkamprath@McKoolSmith.com>; George T. Fishback, Jr. <gfishback@McKoolSmith.com>; Sarah E. Jelsema <Sarah.Jelsema@klarquist.com>; Samuel Thacker <Samuel.Thacker@klarquist.com>; Frank Morton-Park <Frank.Morton-Park@klarquist.com>; Stephanie R. Fulk <Stephanie.Fulk@klarquist.com>; Toni R. Kammers <toni.kammers@klarquist.com>; Todd M. Siegel <todd.siegel@klarquist.com>
Subject: IPR2024-00537 and -00538, Microsoft Corp. v. InterDigital Corp.

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Dear Honorable Board,

In each of Case Nos. IPR2024-00537 and -00538, Petitioner Microsoft respectfully requests leave to file:

1. A 4-page reply to Patent Owner's arguments for discretionary denial under *Fintiv* in the Patent Owner Preliminary Response (Paper 7 in each IPR); and
2. Two exhibits:
    a. A *Sand Revolution*-type stipulation filed by RPI Lenovo in United States District Court for the Eastern District of North Carolina; and
    b. Excerpts from recent U.S. District Court statistics from the U.S. Courts' website, including the median-time-to-trial for civil cases in the Eastern District of North Carolina.

At least three reasons establish good cause for these filings.

First, given that the Petitions were promptly filed less than five months after service of the district court complaint and that there is no district court trial date, Petitioner could not have reasonably foreseen that Patent Owner would argue for discretionarily denial under *Fintiv*. Petitioner should be allowed a reply to those arguments, as it was in related IPR2024-00305 and -00306. Additional briefing will facilitate the Board's resolution of this issue.

Second, Petitioner should be allowed to clarify the median-time-to-trial statistics for the Eastern District of North Carolina. Among other things, this will ensure that the issue is decided on a fuller and more accurate record.

Third, the POPRs characterize the investment by the parties in the district court case and Petitioner should be allowed to respond to these characterizations.

Microsoft would not oppose a Patent Owner sur-reply of equal length.

Undersigned counsel for Petitioner Microsoft conferred with lead counsel for Patent Owner InterDigital, which opposes this request.

Patent Owner's Position:
Petitioner should not be allowed to present additional *Fintiv*-related argument in response to the aforementioned patent Owner Preliminary Responses. Petitioner had ample opportunity and word space to make such arguments in its Petitions and consciously elected not to do so. The Board should not permit Petitioner additional briefing (and words) to further end-run the Board's rules.

Despite its arguments to the contrary, Microsoft did indeed foresee the potential for discretionary denial under *Fintiv* in its Petitions. See IPR2024-00537, Paper 1 at 3; IPR2024-00538, Paper 1 at 3. Accordingly, Microsoft clearly contemplated that Patent Owner would seek discretionary denial under Fintiv, and Microsoft should not now be permitted additional briefing to address arguments that should have been addressed in the Petitions.

To the extent that the Board is inclined to grant Microsoft's request, Patent Owner respectfully requests that the reply be limited to four pages (as in IPR2024-00305 and -00306) and that Patent Owner be permitted a sur-reply of equal length.

Should a conference call be necessary, counsel for the parties can be available at the Board's convenience.

Respectfully submitted,

Andy Mason
Lead Counsel for Petitioner

Andy Mason | Partner
D. 503.473.0804

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From: Andrew M. Mason <andrew.mason@klarquist.com>
Sent: Friday, April 12, 2024 12:37 PM
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Subject: IPR2024-00305 and -00306, Microsoft Corp. v. InterDigital Corp.

Dear Honorable Board,

In each of Case Nos. IPR2024-00305 and -00306, Petitioner Microsoft respectfully requests leave to file:

1. A 5-page reply to Patent Owner's arguments for discretionary denial under *Fintiv* in the Patent Owner Preliminary Response (Paper 9 in each IPR); and
2. Five exhibits:
   (a) A *Sand Revolution*-type stipulation filed by RPI Lenovo in United States District Court for the Eastern District of North Carolina;
   (b) The proposed schedule filed by the parties in the district court case;
   (c) The court's Case Management Order in the district court case;
   (d) The joint claim construction statement, with Appendix A, filed by the parties in the district court case; and
   (e) Excerpts from recent U.S. District Court statistics from the U.S. Courts' website, including the median-time-to-trial for civil cases in the Eastern District of North Carolina.

At least three reasons establish good cause for these filings.

First, given that the Petitions were promptly filed barely three months after service of the district court complaint and that there is no district court trial date, Petitioner could not have reasonably foreseen that Patent Owner would argue for discretionarily denial under *Fintiv*, much less that it would devote 11 pages of each POPR to that issue. Petitioner should be allowed a reply to those arguments, and additional briefing will facilitate the Board's resolution of this issue.

Second, now that RPI Lenovo has filed a stipulation in district court, Petitioner should be allowed to file that stipulation with the Board and explain its impact on the *Fintiv* analysis. This evidence and explanation will better facilitate the Board's decision on this issue.

Third, the POPRs make statements that Petitioner should be allowed to clarify and correct in briefing and through exhibits. As just one example, Petitioner should be allowed to clarify the actual schedule and investment by the parties in the district court case, which are reflected, for example, in exhibits (b-d) above. Among other things, this will ensure that the issue is decided on an accurate and fuller record.

Microsoft would not oppose a Patent Owner sur-reply of equal length.

Undersigned counsel for Petitioner Microsoft conferred with lead counsel for Patent Owner InterDigital, which opposes this request and provided the following two-paragraph statement:

Patent Owner opposes Microsoft's request for the reasons identified in the Patent Owner Preliminary Responses. *See* IPR2024-00305, Paper 9 at 12-13 n.4; IPR2024-00306, Paper 9 at 12-13 n.4 (Petitioner presents a single paragraph arguing why the Board should not deny institution under Fintiv in its Petition (Petition, 3) and makes an almost identical argument in its second Petition challenging the claims of the '933 patent (IPR2024- 00537, Paper 1, 3). That single

paragraph fails to include any substantive evidence as to why the Board should ignore Fintiv in either case—despite the fact that Petitioner had two opportunities (four if the Board also considers the identical arguments made in IPR2024-00306 and IPR2024-00538) to do so. Accordingly, Petitioner should not be allowed to present additional *Fintiv*-related argument in response to this or any other POPR. Petitioner had ample opportunity and word space to make such arguments and consciously elected not to do so. The Board should not permit Petitioner additional briefing (and words) to further end-run the Board's rules.).

Despite its arguments to the contrary, Microsoft did indeed foresee the potential for discretionary denial under *Fintiv* in its Petitions. *See* IPR2024-00305, Paper 1 at 3; IPR2024-00306, Paper 1 at 3. Accordingly, Microsoft clearly contemplated that Patent Owner would seek discretionary denial under *Fintiv*, and Microsoft should not now be permitted additional briefing to address arguments that should have been addressed in the Petitions.

Should a conference call be necessary, counsel for the parties can be available during the following times and will provide additional availability at the Board's request:

- Monday, April 15, 11:30 AM - 4 PM ET
- Tuesday, April 16, 11:30 AM - 4 PM ET
- Wednesday, April 17, 11:30 AM - 4 PM ET

Respectfully submitted,

Andy Mason
Lead Counsel for Petitioner

Klarquist

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