

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC.
Petitioner

v.

INTELLECTUAL VENTURES I LLC
Patent Owner

Inter Partes Review No.
IPR2024-01244

Patent No. 7,623,439
Filing: May 4, 2005
Issue Date: November 4, 2009

**MOTION FOR LEAVE FOR AUTHORIZATION TO FILE A
PRELIMINARY REPLY**

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I. INTRODUCTION

Petitioner respectfully moves for authorization to file a Preliminary Reply to Paper 6, i.e., Patent Owner's Preliminary Response (POPR). This Motion is responsive to the Board's email on December 3, 2024. The Preliminary Reply will be no longer than five (5) pages and is limited to the issue of the status of Ex. 1005 (the Dammann article) as a prior art reference based on its public availability.

Petitioner's reply will provide information, including a supporting declaration from a research librarian that confirms that Ex. 1005 was publicly available before the critical date of the '439 patent. The research librarian will rely only on additional archived pages of the same website that was previously submitted to show public accessibility of the Ex.1005, many of which can be accessed on the hyperlinks of the exhibits already of record. The requested Preliminary Reply is not rendered moot by a time bar under 35 U.S.C. § 315(b). Paper 6 of IPR2024-00883 (i.e., '883 POPR) was filed at a time when Petitioner had represented to the Board it would assume a "passive understudy" role. Petitioner files this motion only after denial of institution in the '883 IPR now that Petitioner is effectively barred from filing a motion for joinder. Accordingly, Petitioner respectfully requests that the instant motion be granted.

II. BACKGROUND

The Board's precedent in *Hulu LLC v. Sound View Innovations* authorizes a

Petitioner to submit additional information including a reply to support that a reference qualifies as a printed publication, if challenged by the Patent Owner. IPR2018-01039, Paper 29 at 14 (PTAB Dec. 20, 2019) (citing 37 C.F.R. §42.23); *see also Google LLC v. Vocalife LLC*, IPR2022-00004 Paper 7 at 3-4 (Feb. 22, 2022) (authorizing Petitioner to submit a Reply to address the issue of whether the challenged art qualifies as a printed publication pre-institution); *Eyenovia, Inc. v. Syndexis, Inc.*, IPR2022-00414, Paper 9 at 23 (finding Petitioner’s pre-institution request for addressing the status of a printed publication persuasive).

III. ARGUMENT

A. The Petition Is Not Subject to a Time Bar Under 35 U.S.C. § 315(b)

A time bar under 35 U.S.C. § 315(b) does not apply to the present Petition (i.e., Paper 2) because the Petition was filed less than a year after service of a complaint by the Patent Owner, as acknowledged by Patent Owner in Paper 6. Specifically, “Petitioner was served with a Complaint filed by Patent Owner on August 3, 2023.” Paper 6 at 67 (citing to Ex. 2007, the Complaint). The Petition was filed on August 2, 2024, i.e., less than a year later. Paper 6 at 67. Thus, the Petition is not subject to a time bar under 35 U.S.C. §315(b).

B. Petitioner’s Motion Is Timely in View of Patent Owner’s Preliminary Response in IPR2024-00883 on the ’439 Patent

Patent Owner filed Paper 6 in the IPR2024-00883 proceeding (’883 POPR)

on August 22, 2024. The '883 POPR alleged that Ex. 1005 did not qualify as a printed publication. IPR2024-00883, Paper 6 at 42-46. Petitioner is not a party to the '883 IPR and was not able to file a motion in the '883 IPR. As the filer of a “copycat”, Petitioner signaled its intention to file a motion for joinder and assume a “passive understudy role,” were the '883 IPR to be instituted. Paper 1 at 16. *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10. Such a role would not create a “significant additional burden” for the Board and “effectively neutraliz[ed] the *General Plastics* factors” for this Petition. IPR2018-00580, Paper 13 at 10. Filing a motion in this IPR to introduce declaration evidence, while the '883 IPR awaited an institution decision, however, would not have been consistent with Petitioner’s representation that it would assume a passive understudy role. Indeed, the grant of such a motion would have undermined Petitioner’s ability to file a motion for joinder of the '883 IPR, by introducing issues in this IPR that were not considered by the Board in the '883 IPR.

Paper 6 in the present IPR (i.e., POPR) was filed on November 18, 2024, and institution of the '883 IPR was denied on November 20, 2024. IPR2024-00883, Paper 10. Only after denial of institution in the '883 IPR (when Petitioner’s “passive understudy” role was nullified), did Petitioner promptly contact the Board to request authorization to file a Preliminary Reply. Had the '883 IPR been instituted, no relief would be necessary because Petitioner would have filed a

motion for joinder in the '883 IPR. Therefore, this request for a response is timely.

C. Granting of Petitioner's Motion Is in the Interests of Justice

Petitioner will provide evidence in the Preliminary Reply that is both productive for a full understanding of the case and limited in substance. “The Federal Circuit has stated ‘[t]he purpose of the trial in an *inter partes* review proceeding is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware.’” IPR2017-00830, citing *Genzyme Therapeutic Prods. L.P. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1367 (Fed. Cir. 2016) (finding consideration of newly introduced evidence acceptable where Patent Owner had notice and opportunity to respond to it). Should the Board grant Petitioner's request for a Preliminary Reply, Patent Owner should be entitled to a sur-reply to respond to the librarian's testimony. The public accessibility of Ex. 1005 is a key area of contention in this IPR and consideration of Petitioner's supplemental information on this topic is in the interests of justice. *See Telefonaktiebolaget LM Ericsson v. TCL Corp.*, No. 17-2381 (Fed. Cir. 2019) at 7 (considering supplemental information of public accessibility found to be in the “interests of justice”).

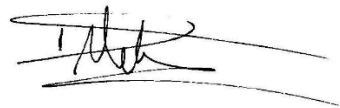
Moreover, the evidence that Petitioner intends to introduce is limited to the issue of the public accessibility of Ex. 1005 and does not affect the grounds of the IPR. A similar Petitioner request to introduce pre-institution evidence to confirm

that a reference “was published and publicly accessible” was granted in IPR2022-00414. Paper 9 at 23; *see also* IPR2022-00004, Paper 9 at 24. There, the Board found that the introduction of this evidence corroborated Petitioner’s prior art claims while Petitioner’s grounds “remain[ed] unchanged from what [was] set forth in the Petition.” Paper 9 at 23; *see also* IPR2024-00094, Paper 14 at 6 (Board finding a request to “supplement the record on [a] public accessibility issue” of a prior art reference promoting “the just, speedy, and inexpensive resolution” of the proceeding while not changing the Petitioner’s “merits case or evidence.”).

Petitioner’s requested Preliminary Reply in this case will include the declaration of a research librarian confirming that Ex. 1005 was publicly accessible before the critical date of the ’439 patent based on the 2002 European Wireless conference website where it was published. *See* Exs.1005, 1014-1016. The research librarian’s declaration will rely on exhibits from the same archived website relied on to support public accessibility of Ex. 1005 in the Petition.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests leave to file a Preliminary Reply and ultimately that *inter partes* review be instituted.



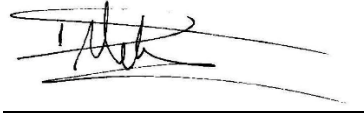
Dated: December 9, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned hereby certifies that this “MOTION FOR LEAVE FOR AUTHORIZATION TO FILE A PRELIMINARY REPLY” was served by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via e-mail to the following attorneys of record for the Patent Owner listed below:

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