

Murphy, Brian

From: Trials
Sent: Friday, January 10, 2025 9:43 AM
To: Greg Gulliver; Aguilar, Safiya; Google-DHInternational-IPRs; Bell, Cory; robert@addyhart.com; Meredith Addy
Cc: Trials
Subject: RE: Request for pre-institution reply (IPR Nos. 2024-01321,01322)

Counsel,

The panel authorizes Petitioner to file a 5-page Reply in each IPR proceeding that addresses only the following issues:

- A. IPR2024-01321
 - 1. Patent Owner's alleged "Procedural Errors," POPR III E.1., E.2. at pages 5-7;
 - 2. Patent Owner's claim construction of "activation cue," POPR VII A. at pages 12-13;
- B. IPR2024-01322
 - 1. Patent Owner's claim construction of "activation cue," POPR VII A. at pages 9-10;
 - 2. Patent Owner's claim construction of "data conveyance switching element," POPR VII B. at pages 10-11;
 - 3. Patent Owner's claim construction of "close proximity," POPR VII D. at page 12.

Petitioner's Reply in each proceeding is due January 17th.

Patent Owner may file a 5-page Sur-reply in each proceeding that addresses only the issues stated above, due January 24th.

Petitioner and Patent Owner shall not introduce any new evidence into the record, but either party may cite to evidence already of record. Any attempt to introduce new evidence into the record or raise new arguments that go beyond the issues authorized above, will not be considered by the Board.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Greg Gulliver <gbgulliver@addyhart.com>
Sent: Tuesday, January 7, 2025 10:05 AM

To: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Google-DHInternational-IPRs <Google-DHInternational-IPRs@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>; robert@addyhart.com; Meredith Addy <meredith@addyhart.com>

Subject: RE: Request for pre-institution reply (IPR Nos. 2024-01321,01322)

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board,

In Petitioner's email to the Board, Petitioner provides argument and position that it did not discuss with Patent Owner prior to sending the email. Petitioner did ask Patent Owner if it would agree to Petitioner's request for permission to file an "institution reply" on claim construction. However, Petitioner neglected to inform Patent Owner that it planned to argue that Patent Owner's POPR claim construction was not supported and hence was unanticipated by Petitioner.

The Board requires that the requesting email should "describe the nub of the dispute" with appropriate "facts and authority." See *Metrics, Inc. v. Senju Pharmaceutical Co., Ltd.*, Case Nos. IPR2014-01041 and -01043 (PTAB, Sept. 9, 2014) (Obermann, APJ). Petitioner's email to Patent Owner (included below) failed to disclose the "nub of the dispute" that it presented to the Board. Instead, Petitioner improperly reserved that information solely for its email to the Board.

Had Patent Owner known the specifics of Petitioner's position, Patent Owner would have amended its response to inform the Board that, contrary to Petitioner's assertion, Patent owner's construction comports with both the claims and the specification, and hence should have been anticipated, making Petitioner's request for "institution reply" improper for that additional reason.

Patent Owner maintains that these issues are best dealt with *if* institution is granted. Further, any change in Petitioner's claim construction prior to the institution of the IPR is "new matter" and is not allowed. In an IPR proceeding, the petition, not the reply, must set forth the petitioner's prima facie case of anticipation or obviousness. See U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide 73 (Nov. 2019).

For completeness of the record, Patent Owner includes Petitioner's initial email to Patent Owner and Patent Owner's response.

In view of the above, and for the reasons indicated by Patent Owner in Petitioner's email to the Board, Patent Owner request the Board deny Petitioner's request for a leave to file a Reply Brief.

Prior Emails:

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From: Robert Hart <robert@addyhart.com>
Sent: Monday, January 6, 2025 9:19 AM
To: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>; Meredith Addy <meredith@addyhart.com>; Greg Gulliver <gbgulliver@addyhart.com>
Cc: Google-DHInternational-IPRs <Google-DHInternational-IPRs@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>
Subject: Request for pre-institution reply (IPR Nos . 2024-01321,01322)

Counsel,

DH International opposes Google's request. The Patent Owner requests that Google include the following statements should it decide email a request to the Board:

"Patent Owner does not believe the Board requires any additional briefing to make a determination that procedural errors exist in the Google's Petition. Any alleged errors either exist or they do not. There is no procedure in place to correct a flawed Petition. With regard to claim construction the Petitioner has already provided a construction that is the "plain meaning." Petitioner will have their opportunity to respond if institution is granted."

Patent Owner is available for a call Thursday afternoon, anytime Friday, or Monday afternoon. If Google seeks a meet and confer, Patent Owner is available anytime tomorrow.

Best regards,
Robert
Counsel for Patent Owner

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From: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>
Sent: Friday, January 3, 2025 12:39 PM
To: Robert Hart <robert@addyhart.com>; Meredith Addy <meredith@addyhart.com>; Greg Gulliver <gbgulliver@addyhart.com>
Cc: Google-DHInternational-IPRs <Google-DHInternational-IPRs@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>
Subject: Request for pre-institution reply (IPR Nos . 2024-01321,01322)

Counsel,
Petitioner, Google, intends to request authorization from the Board to file a ten-page pre-institution reply in IPR2024-01321 addressing Patent Owner's construction of the term "activation cue" and various alleged "procedural errors."
Petitioner also intends to request authorization from the Board to file a ten-page pre-institution reply in IPR2024-01322 addressing Patent Owner's construction of the terms "activation cue," "data conveyance switching element," and "close proximity."
Petitioner would not oppose a sur-reply to each reply of equal length.
Please advise as to whether Patent Owner opposes this request **no later than 11am ET, Monday January, 6.**

Regards,
Safiya
Counsel for Petitioner

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Kind Regards,
Gregory B. Gulliver
Reg. 44,138
Attorney for Patent Owner

From: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>
Sent: Monday, January 6, 2025 5:56 PM

To: 'Trials' <Trials@USPTO.GOV>

Cc: Google-DHInternational-IPRs <Google-DHInternational-IPRs@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>; Robert Hart <robert@addyhart.com>; Meredith Addy <meredith@addyhart.com>; Greg Gulliver <gbgulliver@addyhart.com>

Subject: Request for pre-institution reply (IPR Nos. 2024-01321,01322)

Honorable Board,

Petitioner requests authorization to file a ten-page pre-institution reply in IPR2024-01322 addressing Patent Owner's unforeseeable proposal of claim constructions that contradict the patent's disclosure in Patent Owner's preliminary Response (Paper 7).

Good cause exists for filing this pre-institution reply. Petitioner could not have foreseen Patent Owner's construction of "activation cue" because it is inconsistent with the '294 patent's disclosure that the activation cue "is in the form of a *data communication* of a specific type *which will be recognized by electronic device 10 as an activation cue.*" Patent Owner's construction of "data conveyance switching element" was also unforeseeable because it is inconsistent with the '294 patent's disclosure that the "data conveyance switching element" can be *any type of device* allowing data to be conveyed according to alternate data conveyance operations." Patent Owner's construction of "close proximity" was likewise unforeseeable because it is inconsistent with the '294 patent's disclosure that "close proximity" depends on the nature of the control and data exchange devices themselves.

Petitioner also requests authorization to file a ten-page pre-institution reply in IPR2024-01321 to address Patent Owner's construction of the term "activation cue" which is unsupported by the specification and various alleged "procedural errors" in Patent Owner's preliminary Response (Paper 8).

Good cause exists for filing this pre-institution reply because Petitioner could not have foreseen Patent Owner's construction, which is unsupported by the disclosure of the '333 patent. Petitioner also could not have foreseen Patent Owner would allege a "procedural error" when it is well settled that no motivation to combine is required when a secondary reference is used to explain another reference.

If granted, Petitioner does not oppose permitting Patent Owner a sur-reply of equal length in each case.

Petitioner and Patent Owner have conferred, and Patent Owner opposes this request and requested that Petitioner include the following on Patent Owner's behalf: *Patent Owner does not believe the Board requires any additional briefing to make a determination that procedural errors exist in the Google's Petition. Any alleged errors either exist or they do not. There is no procedure in place to correct a flawed Petition. With regard to claim construction the Petitioner has already provided a construction that is the "plain meaning." Petitioner will have their opportunity to respond if institution is granted.*

Regards,
Safiya Aguilar
Counsel for Petitioner

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This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.