From: Trials
To: Ahmed, Quadeer; Stephen Zinda; James Hall; Paralegal; PH-Samsung-AMRH-IPR
Cc: Trials
Subject: [EXT] RE: IPR Nos. 2024-01348, -01349, -01350
Date: Monday, December 9, 2024 11:05:15 AM

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Report Suspicious

Counsel,

Petitioner is authorized to file a motion seeking the relief sought in its email. Petitioner's motion should discuss why there is good cause for the Board to take each of the actions requested by Petitioner, including what, if any, statutory authority gives the Board the necessary authorization to take the actions Petitioner requests. Petitioner's motion may be no longer than 10 pages and must be filed no later than 5 business days from this authorization.

Patent Owner is authorized to file a response to Petitioner's motion. Patent Owner's response is limited to addressing the points raised in the above authorized motion. Patent Owner's response to the motion may be no longer than 10 pages and must be filed no later than 5 business days from the date that Petitioner's motion is filed.

Petitioner's request for a stay is denied at this time.

Regards,

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

From: Ahmed, Quadeer <quadeerahmed@paulhastings.com>
Sent: Wednesday, December 4, 2024 1:37 PM
To: Trials <Trials@USPTO.GOV>
Cc: Stephen Zinda <stephen@chzfirm.com>; James Hall <james@chzfirm.com>; Paralegal <paralegal@chzfirm.com>; PH-Samsung-AMRH-IPR <PH-Samsung-AMRH-IPR@paulhastings.com>

Subject: IPR Nos. 2024-01348, -01349, -01350

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Dear Honorable Patent Trial and Appeal Board,

Petitioner in the above-identified proceedings writes regarding an urgent issue involving recent filings by Patent Owner.

Patent Owner recently filed petitions to accept alleged unintentionally delayed benefit claims ("Petitions"), requests for certificates of correction ("Requests"), and petitions for expedited review of these Petitions and Requests. These papers were filed in the USPTO with respect to the patents being challenged in the above-identified IPRs, namely U.S. Patent Nos. 10,572,896 ("'896 patent"), 10,719,849 ("'849 patent"), and 10,719,848 ("'848 patent"). Patent Owner filed similar papers in other patents/patent applications in the same family that are not challenged in the above-identified IPRs.

The Petitions and Requests are directed to priority claims that are directly at issue in the above-identified IPRs, as acknowledged in Patent Owner's Petitions. Accordingly, Petitioner respectfully requests the following:

1. Petitioner requests the Board to exercise exclusive jurisdiction over the Petitions and Requests (along with the petitions for expedited review) under 37 C.F.R. § 42.3, and stay the Petitions and Requests pending the Board's decisions on institution in the above-identified IPRs.

2. Petitioner requests authorization to submit a short, 5-page paper in each of the above-identified IPRs regarding why Patent Owner's Petitions and Requests should be denied. Petitioner can submit its paper within five business days of the Board order granting this request.

3. Petitioner requests the Board order that Patent Owner shall not file any papers in the USPTO with respect to the '896 patent, '849 patent, and '848 patent while the above-identified IPRs are pending without the Board's prior authorization, except for papers filed directly with the Board in the above-identified IPRs that do not require prior Board authorization.

4. To the extent the Board grants Patent Owner's request set forth below (for the parties to brief the issue of whether the Board should exercise exclusive jurisdiction over the Petitions and Requests), Petitioner respectfully requests that the Board stay the Petitions and Requests pending the Board's decisions on any such briefing to avoid potential duplicative efforts by the Board and another department within the USPTO.

The Board has ordered similar relief in the pre-institution phase of other IPRs involving similar circumstances (e.g., requests for certificates of correction). *See, e.g.*, *Emerson Electric Co. v. Sipco,*

LLC, IPR2016-00984, Paper 10 at 2-4 (July 27, 2016); *Alarm.com Inc. v. Vivint, Inc.*, IPR2016-00116, Paper 9 at 3-5, 8-9 (Jan. 28, 2016); *see also ipDataTel, LLC v. ICN Acquisition, LLC*, IPR2018-01822, Paper 19 at 15-16 (Apr. 22, 2019) (discussing Rule 42.3 and noting petitioner did not request the Board to exercise exclusive jurisdiction or ask for additional guidance regarding patent owner's request for certificate of correction).

Petitioner conferred with Patent Owner. Patent Owner opposes Petitioner's requests and believes a preliminary issue for briefing is whether the Board should exercise authority over and decide the merits of Petitions and Requests, including Petitions and Requests related to patents and pending applications that are not involved in a trial or interference before the Board. See *Kaidi LLC, et al v. Limoss US, LLC*, IPR2019-01184, Paper 8 at 3 (July 19, 2019) ("…we are persuaded that Patent Owner may seek correction of the challenged patent's priority date with the Petitions Branch or Corrections Branch of the USPTO. We recognize that these Branches are responsible for making such corrections. At this time, we are not persuaded that briefing is appropriate concerning the merits of the petitions Patent Owner seeks to file with the Petitions Branch and Corrections Branch."); *Motif Foodworks, Inc. v. Impossible Foods, Inc.*, IPR2023-00206, Paper 15 at 4 (May 22, 2023) ("According to the Federal Circuit, the Director—not the Board—will evaluate the merits of the patentee's petition, including whether the mistake is of 'minor character' or 'occurred in good faith'…the Director has not delegated this authority to the Board.") (internal citations and quotations omitted). Patent Owner does not believe it is appropriate to enter a stay before Patent Owner has been afforded the opportunity to be heard on this issue, particularly given that patent expiration is looming and a stay of the Petitions and Requests as to the challenged patents will delay a determination on the Petitions and Requests for issued patents not at issue in these (or any other) proceeding.

The parties can make themselves available for a conference call, should the Board find it helpful.

Respectfully submitted,
Quadeer Ahmed
Counsel for Petitioner

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