

Davis Jr., Walter D.

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, January 23, 2025 2:58 PM
To: Davis Jr., Walter D.; Trials
Cc: SecureWiFi_Samsung; CM-200771-00003 - Samsung-SWF-IPRs; Jerry Tice
Subject: RE: IPR2024-01368, -01369

Counsel,

Petitioner requests authorization from the Board to file a pre-institution reply in each of IPR2024-01368 and IPR2024-01369 matters to address Patent Owner's arguments regarding three issues: 1) the construction of the term "'authenticated' access point"; 2) the propriety of Petitioner filing two petitions challenging the same patent; and 3) the related district court record. Patent Owner opposes this request. Nevertheless, we find good cause exists for allowing both parties an additional 6 pages that are strictly limited to addressing the three issues identified above. Therefore, Petitioner is authorized to file a 6 page pre-institution reply by no later than January 30, 2025 and Patent Owner is authorized to file a 6 page pre-institution sur-reply by no later than February 6, 2025. Petitioner is likewise to include this email as an exhibit to its reply.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Davis Jr., Walter D. <Walter.Davis@BlankRome.com>
Sent: Thursday, January 16, 2025 5:13 PM
To: Trials <Trials@USPTO.GOV>
Cc: SecureWiFi_Samsung <SecureWiFi_Samsung@bdiplaw.com>; CM-200771-00003 - Samsung-SWF-IPRs <Samsung-SWF-IPRs@BlankRome.com>; Jerry Tice <jtice@bdiplaw.com>
Subject: IPR2024-01368, -01369

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Dear Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), and 42.108(c), Petitioner requests authorization from the Board to file a 15-page pre-institution reply in each of IPR2024-01368 and IPR2024-01369 to respond to the following three unforeseen arguments raised by Patent Owner in the recently filed Preliminary Responses:

- (1) Patent Owner's unforeseeable and incorrect implicit construction of the term "'authenticated' access point" (e.g., IPR2024-01368, Paper No. 7 at 3, 20-25, 26, 27, IPR2024-01369, Paper No. 7 at 3-4, 21-24, 26, 27, 28);
- (2) Patent Owner's unforeseeable and incorrect statements concerning Petitioner's filing of two Petitions (e.g., IPR2024-01368, Paper No. 7 at 42, IPR2024-01369, Paper No. 7 at 42); and
- (3) Patent Owner's unforeseeable and incorrect statements concerning the district court record (e.g., IPR2024-01368, Paper No. 7 at 44, 48-52, IPR2024-01369, Paper No. 7 at 45, 49-53).

Good cause exists for pre-institution briefing on the first issue, because Patent Owner’s newly interprets the term “authenticated access point” adverse to and inconsistently with its previous construction presented in Patent Owner’s infringement contentions from the parallel EDTX action.

For the second issue, good cause exists for pre-institution briefing, because Patent Owner mischaracterizes the two Petitions and asserts Petitioner did not provide metrics to rank the Petitions – one challenging asserted claims and one challenging unasserted claims – in a manner which was unforeseeable.

Good cause exists for pre-institution briefing on the third issue, because Patent Owner incorrectly represents the record in the district court litigation regarding Petitioner’s motion to stay and the Order Denying the Motion to Stay, the investment between the parties in parallel proceedings, and the overlap of the issues. Petitioner’s motion to stay was filed after the filing of the Petition; and therefore, Petitioner could not fully address the issue in the Petition. Additionally, Patent Owner’s misrepresentations concerning the investment in parallel proceedings and overlap of the issues could not have been anticipated by Petitioner or included in the Petition. As such, these issues in the Patent Owner Preliminary Responses were unforeseeable.

Petitioner will not oppose a sur-reply by Patent Owner of equal length.

Patent Owner’s Position

Patent Owner opposes Petitioners’ request. The issues in Petitioners’ email are general disagreements with Patent Owner’s arguments that do not establish good cause for replies.

First Issue: Patent Owner disagrees that it was unforeseeable that Patent Owner would describe the well-known, plain meaning of the term “authenticated” as recited in the claims. Nevertheless, Petitioners’ expert already addressed the meaning of the term. See EX1002, para. 55 of each case. Moreover, Petitioners already addressed Patent Owner’s infringement contentions on this issue. IPR2024-01366, at 42 n.4 and IPR2024-01369, at 42 n.4 (“For purposes of this proceeding, Petitioner adopts PO’s infringement theory of ‘authenticated access point’ being an access point that the mobile device previously connected with”); IPR2024-01367, at 31 (“PO’s infringement contentions agree, because PO asserts an AP is an AAP [authenticated access point] by being a previously-connected AP”); IPR2024-01368, at 22 (“PO’s infringement contentions [allege] that it’s the SSID or MAC address of a **previously connected** AP” for “authenticated access point list”). This issue was not only foreseeable, but Petitioners also already addressed it. Both the infringement contentions and the petitions address this same theory for “authenticated access point”; that the Parties disagree on whether Petitioners’ proposed combination renders obvious that theory does not establish good cause for reply.

Second Issue: There is no “incorrect statement” in the POPRs. Petitioners placed “substantial and unnecessary burden on the Board and the patent owner” by filing two separate petitions on the same patent without providing any ranking, any discussion of material differences, or any reason why the Board should allow two petitions, as required by the PTAB Consolidated Trial Practice Guide (pp. 59-60). It is not unforeseeable that Petitioners were required to follow the rules.

Third Issue: Petitioners have not identified any “incorrect statements,” as there are none. Petitioners chose to file an unsuccessful motion to stay after filing their IPRs, and the court order, filed as Exhibit 2001 to each POPR, speaks for itself.

The Request for 15 Pages is Excessive: Patent Owner opposes Petitioners’ request for fifteen pages. This request suggests that Petitioners will attempt to present new theories that are absent from the petitions. Moreover, should Patent Owner be allowed sur-replies, it is unduly burdensome for Patent Owner to respond to a total of 60 additional pages pre-institution across Petitioners’ four Petitions, as well as the Board in considering an additional 120 pages of briefing. While Patent Owner maintains there is no good cause for reply, it requests that any reply and corresponding sur-reply be limited to 5-pages, which is typical in our experience.

The parties are available for a call with the Board as follows:

1/21 – 3:00 pm to 4:00 pm

1/22 – 11:00 am to 4:30 pm

1/23 – 10:30 am to 4:30 pm

Best,

Walter Davis

Counsel for Petitioner

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