

From: [Trials](#)
To: [Carmichael, Jim \(External\)](#); [Valente, David](#); [Trials](#)
Cc: [PH-Google-Multifold-IPR](#); [Motorola-Multifold_OHS](#); [TVPTABDocket@orrick.com](#); [OCHPTABDocket@orrick.com](#); [gmooss@orrick.com](#); [Ke, Elaine](#); [Multifold IPRs](#); [Steve Schreiner](#); [Mitch Yang](#); [Steve McBride](#); [Christopher R. Abidin](#)
Subject: RE: IPR2025-00058
Date: Thursday, March 27, 2025 10:17:14 AM
Attachments: [image002.png](#)
[image003.png](#)

Counsel,

We are in receipt of Petitioner's email of March 26 requesting authorization to file a preliminary reply on the issue of the priority date of the challenged patent. We are also in receipt of Patent Owner's supplemental email setting forth its reasons for opposing Petitioner's request.

Pursuant to 37 CFR § 42.20 (d), the Board finds that additional briefing on this issue would be helpful. Consequently, Petitioner may submit a preliminary reply, limited to 10 pages, no later than April 7, 2025. Patent Owner may submit a preliminary sur-reply, also limited to 10 pages, no later than April 17, 2025. No further briefing is authorized.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: James Carmichael <jim@carmichaelip.com>
Sent: Wednesday, March 26, 2025 4:18 PM
To: Valente, David <davidvalente@paulhastings.com>; Trials <Trials@USPTO.GOV>
Cc: PH-Google-Multifold-IPR <PH-Google-Multifold-IPR@paulhastings.com>; Motorola-Multifold_OHS <Motorola-Multifold_OHS@orrick.com>; TVPTABDocket@orrick.com; OCHPTABDocket@orrick.com; gmooss@orrick.com; Ke, Elaine <eke@orrick.com>; Multifold IPRs <MultifoldIPRs@carmichaelip.com>; Steve Schreiner <schreiner@carmichaelip.com>; Mitch Yang <Mitch@carmichaelip.com>; Steve McBride <stevemcbride@carmichaelip.com>; Christopher R. Abidin <Chris@carmichaelip.com>
Subject: RE: IPR2025-00058

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

Your Honors,

Regrettably, Patent Owner must send this supplemental email because Petitioners refused to include Patent Owner's position in their 2:19pm email to the Board. Here is Patent Owner's position, precisely as previously presented to Petitioners for inclusion in their email:

Patent Owner opposes Petitioners' request because Petitioner Google knew about the named inventors having invented the claimed invention prior to the asserted Seo reference and should have addressed it in the Petition. One of the two named inventors, Mo Selim, has been employed by Google for the last four years. Mr. Selim's title at Google is Senior Staff UX Design Manager. <https://www.linkedin.com/in/moselim/>. Mr. Selim maintains a webpage about the claimed invention and prototype, calling it "a revolutionary product" and dating his work on it "2010-2011." <https://moselimdesign.com/project/imerj>. That webpage also states the prototype "completed full Google certification," confirming Google knew in detail about the named inventors' work in 2010-2011.

Petitioners do not deny they knew about the named inventors' prior invention activities before filing the Petition. Nor do they assert it was unforeseeable Patent Owner would raise it. Further preliminary briefing is inappropriate in these circumstances.

Respectfully submitted,

Jim Carmichael
Counsel for Patent Owner



James T. Carmichael

Carmichael IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
(703)646-9255
jim@carmichaelip.com

This message may contain privileged and confidential information. If you are not the intended recipient, kindly contact the sender and destroy all copies.

From: Valente, David <davidvalente@paulhastings.com>

Sent: Wednesday, March 26, 2025 2:19 PM

To: Trials <Trials@USPTO.GOV>

Cc: PH-Google-Multifold-IPR <PH-Google-Multifold-IPR@paulhastings.com>; Motorola-Multifold_OHS <Motorola-Multifold_OHS@orrick.com>; TVPTABDocket@orrick.com; QCHPTABDocket@orrick.com; gmooss@orrick.com; Ke, Elaine <eke@orrick.com>; Multifold IPRs <MultifoldIPRs@carmichaelip.com>; James Carmichael <jim@carmichaelip.com>; Steve Schreiner <schreiner@carmichaelip.com>; Mitch Yang <Mitch@carmichaelip.com>; Steve McBride <stevemcbride@carmichaelip.com>; Christopher R. Abidin <Chris@carmichaelip.com>

Subject: IPR2025-00058

Your Honors,

Petitioners seek leave to file a reply to Patent Owner's Preliminary Response ("POPR") in IPR2025-00058 to respond to Patent Owner's arguments that it conceived of the challenged patent before the earliest priority date of one of the asserted prior art references. Good cause exists for such a reply. In particular, Patent Owner submitted over eighty exhibits and extensive argument contending that the named inventors conceived of and then diligently reduced to practice the challenged patent before the earliest priority date for the prior art reference Seo (one of the references used in every ground in the Petition). At the time Petitioners filed the Petition, they were unaware of Patent Owner's contention that the challenged patent was entitled to an earlier priority date than that claimed on its face or any of the evidence or argument that Patent Owner submitted with the POPR. Accordingly, good cause exists to afford Petitioners an opportunity to respond to these previously unknown contentions.

Petitioners agree to limit the preliminary reply to ten pages and would request authorization to file the reply within ten days after the Board grants such leave. The reply would not include any new exhibits. Petitioners also do not oppose Patent Owners having the opportunity to submit a preliminary sur-reply of equal length.

Petitioners conferred with Patent Owner regarding this request. Patent Owner indicated that it opposes this request because, according to Patent Owner, the arguments raised in the Preliminary Responses were foreseeable.

Petitioners do not believe a call with the Board is necessary, but to the extent the Board would like to discuss Petitioners' request, the parties can be available March 27 or 28.

Respectfully,
David Valente
Counsel for Petitioner Google

**PAUL
HASTINGS**

David Valente | Associate, Litigation Department

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct: +1.202.551.1871 |
Main: +1.202.551.1700 | Fax: +1.202.551.0371 | davidvalente@paulhastings.com |
www.paulhastings.com

This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments. If you reply to this message, Paul Hastings may collect personal information including your name, business name and other contact details, and IP address. For more information about Paul Hastings' information collection, privacy and security principles please click [HERE](#). If you have any questions, please contact Privacy@paulhastings.com.