

From: [Trials](#)
To: [Garr, David](#); [Zhong, Annita](#); [Trials](#); [Weidenfeller, Scott](#); [#PictivaIPR](#); [Gao, Jie](#); [Carson, Rebecca](#); [Warrick, Philip](#); [Silver, Blair](#); [Sheasby, Jason](#); [SDC-Pictiva-IPR](#)
Cc: [Trials](#)
Subject: RE: IPR2024-01095/IPR2024-01094: request for preliminary reply
Date: Thursday, November 14, 2024 2:09:10 PM
Attachments: [image002.png](#)

Counsel,

The panel has conferred and determined that allowing Petitioner to submit a declaration in support of any reply filed pursuant to our authorization (*see* Ex. 3001) is appropriate under the particular facts and circumstances presented. Patent Owner's concerns about pre-institution discovery are unpersuasive. Any discovery of the declarant normally would occur only in the event the Board institutes a trial. No conference call is necessary. The Board will enter a copy of this email correspondence as Exhibit 3002 in both proceedings.

Regards,

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

From: Garr, David <dgarr@cov.com>
Sent: Wednesday, November 13, 2024 5:00 PM
To: Zhong, Annita <HZhong@irell.com>; Trials <Trials@USPTO.GOV>; Weidenfeller, Scott <SWeidenfeller@cov.com>; #PictivaIPR <PictivaIPR@irell.com>; Gao, Jie <JGao@irell.com>; Carson, Rebecca <RCarson@irell.com>; Warrick, Philip <pwarrick@irell.com>; Silver, Blair <bsilver@irell.com>; Sheasby, Jason <JSheasby@irell.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
Subject: RE: IPR2024-01095/IPR2024-01094: request for preliminary reply

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

Dear Honorable Board,

We write concerning Patent Owner's improper and argumentative email, which we believe is inconsistent with the Board's rules on the submission of unauthorized, off-the-record briefing. To the extent that the Board is inclined to consider Patent Owner's arguments, Petitioner requests an

Pictiva EX2051-p.1
Samsung v Pictiva
IPR2026-00129

Ex. 3002
IPR2024-01094
IPR2024-01095

opportunity to be heard in response.

Petitioner understands the Board's order this morning as authorizing Petitioner to file the 5-page reply and declaration that it requested, and authorizing Patent Owner to file the sur-reply that it requested. Petitioner notes that its declaration will be less than two pages in length, limited to fact testimony concerning the Ma reference's publication.

Respectfully submitted,
David Garr
Counsel for Petitioner

David A. Garr

Pronouns: He/Him/His

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From: Zhong, Annita <HZhong@irell.com>

Sent: Wednesday, November 13, 2024 2:59 PM

To: Trials <Trials@USPTO.GOV>; Weidenfeller, Scott <SWeidenfeller@cov.com>; #PictivalIPR <PictivalPR@irell.com>; Gao, Jie <JGao@irell.com>; Carson, Rebecca <RCarson@irell.com>; Warrick, Philip <pwarrick@irell.com>; Silver, Blair <bsilver@irell.com>; Sheasby, Jason <JSheasby@irell.com>; Garr, David <dgarr@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>

Subject: RE: IPR2024-01095/IPR2024-01094: request for preliminary reply

[EXTERNAL]

Dear Honorable Board,

In an excess of caution, Patent Owner Pictiva seeks clarification of whether the Board's authorization of pre-institution briefing on the publication status of the Ma reference includes filing of new and undisclosed declaration testimony that should have been included in the Petition. We understand from the Board's past practice that no such evidence is permitted, as it could have been submitted but was not submitted at the time of Petition. *See, e.g.*, IPR2023-00923, Paper 13 (authorizing pre-institution briefing on publication, but denying additional declaration testimony from librarians and authors).

In IPR2024-01095, Petitioner provided no evidence or any argument that Ma was publicly available and thus qualifies as a printed publication in this matter. Patent Owner's Preliminary Response in IPR2024-01095 simply pointed out the failure of Petitioner to meet its burden in the petition. While the Board authorized Petitioner's requested briefing, it did not authorize or specifically address Petitioner's request to file new expert declaration testimony. As there is currently no evidence of Ma's public availability on the record in this proceeding, Petitioner's introduction of the first and only evidence in *reply* of Ma's publication is not responsive to any issue in the Preliminary Response, is untimely, and is improper.

In IPR2024-01094, the evidentiary record in the Petition is the same. Petitioner merely added a footnote but no additional record evidence or declaration testimony related to Ma's publication in the Petition. It is thus also improper and untimely for Petitioner to submit additional evidence at this point.

Allowing Petitioner to spring a declaration that it apparently has already prepared but refuses to share with Patent Owner works great prejudice against Patent Owner. Petitioner is likely to broadly reference the declaration and thus effectively incorporate by reference the declaration's multiple-page content to get around the 5-page limit set by the Board to address both *Fintiv* and Ma's publication. Patent Owner then in sur-reply must respond to both issues in addition to the declaration's substantive discussion within those same 5 pages. Unlike post-institution, there is also little time pre-institution for a deposition or for the preparation of any counter evidence and declaration testimony in the intervening five business days. New evidence and testimony at this time is not only improper, but simply unworkable.

Patent Owner is available at the Board's convenience for a conference call if one is required.

Respectfully,

H. Annita Zhong
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067-4276
Telephone: (310) 203-7183
Fax: (310) 556-5385

From: Trials <Trials@USPTO.GOV>

Sent: Wednesday, November 13, 2024 6:48 AM

To: Zhong, Annita <HZhong@irell.com>; Weidenfeller, Scott <SWeidenfeller@cov.com>; #PictivalIPR <PictivalIPR@irell.com>; Gao, Jie <JGao@irell.com>; Carson, Rebecca <RCarson@irell.com>; Warrick, Philip <pwarrick@irell.com>; Silver, Blair <bsilver@irell.com>; Sheasby, Jason <JSheasby@irell.com>; Garr, David <dgarr@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-01095: request for preliminary reply

Counsel,

The panel has determined that additional briefing may be helpful to the Board in reaching a just decision on institution. Petitioner is authorized to file a Reply, strictly limited to the issues raised below in Petitioner's email. Any reply filed pursuant to this authorization is limited to five (5) pages in length and is due within five (5) business days. Patent Owner is authorized to file a Sur-reply limited to five (5) pages in length, within five (5) business days of the filing of any reply. No conference call is required. The Board will enter a copy of this email correspondence as Exhibit 3001.

Regards,

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

From: Zhong, Annita <HZhong@irell.com>
Sent: Friday, November 8, 2024 4:25 PM
To: Weidenfeller, Scott <SWeidenfeller@cov.com>; Trials <Trials@USPTO.GOV>
Cc: #PictivalPR <PictivalPR@irell.com>; Gao, Jie <JGao@irell.com>; Carson, Rebecca <RCarson@irell.com>; Warrick, Philip <pwarrick@irell.com>; Silver, Blair <bsilver@irell.com>; Sheasby, Jason <JSheasby@irell.com>; Garr, David <dgarr@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
Subject: RE: IPR2024-01095: request for preliminary reply

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Dear Honorable Board,

Pictiva is available at the Board's convenience if a call is required. It also requests a sur-reply should the Board grants Petitioner's request for a reply.

Respectfully,

H. Annita Zhong

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From: Weidenfeller, Scott <SWeidenfeller@cov.com>
Sent: Friday, November 8, 2024 1:21 PM
To: trials@uspto.gov
Cc: #PictivalPR <PictivalPR@irell.com>; Zhong, Annita <HZhong@irell.com>; Gao, Jie <JGao@irell.com>; Carson, Rebecca <RCarson@irell.com>; Warrick, Philip <pwarrick@irell.com>; Silver, Blair <bsilver@irell.com>; Sheasby, Jason <JSheasby@irell.com>; Garr, David

<dgarr@cov.com>; Weidenfeller, Scott <SWeidenfeller@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>

Subject: IPR2024-01095: request for preliminary reply

Dear Honorable Board,

Petitioner in the above-referenced IPR respectfully requests authorization to file a five-page preliminary reply, and a declaration on public availability of the Ma reference, in order to address Patent Owner's arguments on discretionary denial under *Fintiv* and on the availability of the Ma reference as prior art.

Patent Owner has advised: "We do not oppose a reply on the 314(a) issue, but based on your response to date, we do oppose your attempt to supplement the petitions and to circumvent the word limit to address Ma's alleged online availability and an attempt to submit additional evidence."

Petitioner is available at the Board's convenience if it desires a conference call. Patent Owner did not provide its availability for such a call.

Respectfully submitted,
Scott Weidenfeller
Counsel for Petitioner

Scott Weidenfeller

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