

Diana Bradley

From: Trials <Trials@USPTO.GOV>
Sent: Friday, June 2, 2023 8:29 AM
To: Nicholas Stephens
Cc: Matthew Berkowitz; Joy Wang; Patrick Colsher; RJ_CardwareSamsung; PGR39843-0147PS1; PGR39843-0147PS2; Trials
Subject: RE: PGR2023-00012, -00013 - Request for Replies to Patent Owner's Preliminary Responses

[This email originated outside of F&R.]

Counsel:

From the Board –

In PGR2023-00012, Petitioner is authorized to submit a preliminary reply (1) addressing in three pages alleged inconsistencies in Patent Owner's arguments that U.S. Patent 11,328,286 is ineligible for Post Grant Review due to support in U.S. Provisional Patent Application No. 61/794,891, and (2) addressing in three pages its additional stipulation and the application of the *Fintiv* factors. In PGR2023-00013, Petitioner is authorized to submit a preliminary reply, addressing in three pages alleged inconsistencies in Patent Owner's arguments that U.S. Patent 11,328,286 is ineligible for Post Grant Review due to support in U.S. Provisional Patent Application No. 61/794,891. Patent Owner is authorized to submit a preliminary sur-reply in each proceeding, responsive to the respective preliminary reply, of 6 pages in PGR2023-00012 (3 pages for each issue) and of 3 pages in PGR2023-00013. Petitioner's preliminary replies are due in 5 business days from this email, each of Patent Owner's preliminary sur-replies 5 business days from the filing of the preliminary reply to which it is responsive. If filing a preliminary reply, Petitioner should file this email as an exhibit and refer to it in its brief.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Nicholas Stephens <nstephens@fr.com>
Sent: Tuesday, May 30, 2023 12:19 PM
To: Trials <Trials@USPTO.GOV>
Cc: Matthew Berkowitz <mberkowitz@reichmanjorgensen.com>; Joy Wang <ywang@reichmanjorgensen.com>; Patrick Colsher <pcolsher@reichmanjorgensen.com>; RJ_CardwareSamsung <RJ_CardwareSamsung@reichmanjorgensen.com>; PGR39843-0147PS1 <PGR39843-0147PS1@fr.com>; PGR39843-0147PS2 <PGR39843-0147PS2@fr.com>
Subject: PGR2023-00012, -00013 - Request for Replies to Patent Owner's Preliminary Responses

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Dear Honorable Board,

Petitioner (Samsung Electronics Co., Ltd.) respectfully requests authorization to file replies to Patent Owner's Preliminary Responses in PGR2023-00012 and PGR2023-00013. Petitioner specifically seeks to address the following two issues in the replies.

Issue 1 (PGR2023-00012 and PGR2023-00013)

First, Petitioner requests three pages to reply to Patent Owner's arguments in both proceedings that the '286 patent is ineligible for PGR due to alleged support for challenged claim features in the pre-AIA provisional application. Petitioner submits that good cause exists for briefing on this issue to address (1) inconsistencies between Patent Owner's argument that dependent claim 15 is supported by the provisional application and earlier arguments advanced by Patent Owner to distinguish prior art in a related proceeding (IPR2023-00314) and (2) inconsistencies between Patent Owner's argument that dependent claim 3 is supported by the provisional application and portions of the provisional application not addressed in the POPR.

Issue 2 (PGR2023-00012 only)

Petitioner additionally requests three pages to reply to Patent Owner's arguments in PGR2023-00012 that institution should be denied based on *Fintiv* considerations. Petitioner served Patent Owner with an updated stipulation for this proceeding on April 18th in light of a change in the median time-to-trial statistics in the district of the co-pending litigation (E.D. Tex.), and although the POPR acknowledges the updated stipulation, Petitioner has not yet had an opportunity to address how the stipulation impacts the *Fintiv* factors in this proceeding. Petitioner submits that cause exists for briefing on this issue in view of the updated stipulation, the change in median time-to-trial statistics in E.D. Texas, and to ensure the parties have the same opportunity to be heard on these developments in PGR2023-00012 as they were previously in related proceedings IPR2023-00196, IPR2023-00210, IPR2023-00211, IPR2023-00219, and IPR2023-00314.

If replies are authorized, Petitioner does not oppose Patent Owner's filing of sur-replies of corresponding length.

The parties have conferred by email and Patent Owner offers the following position:

Patent Owner opposes the proposed reply except to the same extent previously authorized by the Board in IPR2023-00196, -00210, -00211, -00219, and -00314. Specifically, the Board previously allowed Petitioner to file a reply regarding "a change in the median time-to-trial statistics in the forum of the parallel proceeding and an additional Fintiv stipulation, along with a three-page preliminary reply regarding the Fintiv factors." The Board also gave Patent Owner five business days thereafter to file a responsive three-page preliminary sur-reply.

Patent Owner does not oppose this same relief in PGR2023-00012, but opposes the other requested relief.

Should the Board desire a call, the parties are available on May 31 from 11:30 am-5 pm ET. The parties can provide additional availability at the Board's request.

Best Regards,
Nick Stephens

Counsel for Petitioner (Samsung)

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