

## **EXHIBIT 3001**

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**Subject:** IPR2018-00631: Request for Teleconference to seek authorization to file a reply

To the Board

Pursuant to 37 C.F.R. § 42.108(c), Petitioner requests authorization to file a Reply to Patent Owner's ("P.O.") Preliminary Response in the above-referenced IPR. This same request is being made in each of IPR2018-00631, IPR2018-00632, IPR2018-00633, and IPR2018-00634.

Petitioner seeks leave to file a reply for the following limited purposes of addressing PO's argument concerning issue preclusion and 35 USC 314(a). Petitioner contends that good cause exists to address both issues.

First, Petitioner could not have anticipated PO's issue preclusion argument because it is legally improper. PO has not cited a single case where issue preclusion is applied based on an institution decision. Based on an analysis of statutory and regulation language, district courts have explained that issue preclusion does not arise from an institution decision. *Top-Co Inc. v. Blackhawk Specialty Tools, LLC*, No. 4:14-CV-1937, slip op. at 7 (S.D. Tex. May 2, 2016) ("Taken on the whole, a denial at the preliminary phase of the IPR proceedings does not statutorily, or at common law, collaterally estop a party from raising the same arguments at the district court.") (opinion attached). The Board has also made clear that institution decisions are preliminary and may change upon development of the record. *Sandisk Corp. v. Netlist, Inc.*, IPR2014-00971, Paper 36 at 6-7 (April 27, 2016) ("In a decision issued subsequent to the filing of Petitioner's Request, our reviewing court rejected a similar argument, and explicitly stated that the Board is not bound by any findings made in its Institution Decision."); *Mylan Pharms. Inc. v. UCB Pharm. GMBH*, IPR2016-00512, Paper 12 at 29 (PTAB July 20, 2016) ("This is not a final decision as to the construction of any claim term or the patentability of claims 1-16. Our final decision will be based on the full record

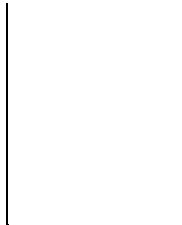
developed during trial." ). By comparison, the decisions relied on in PO's preliminary response were based on the Board's Final Decisions after completion of a trial and a full record; and they were subject to further review (that was sought and dismissed). *See* Exs. 2057-58.

Second, Petitioner seeks to address PO's argument that the Board should exercise its discretion un 35 U.S.C. § 314(a) and deny this petition under *General Plastics*. The arguments made could not have been anticipated because this petition is the first and only petition relating to the 9,339,062 patent that Petitioner has ever filed or been involved with. Petitioner is not attempting to get a second bite at invalidity through a follow-on petition. Instead, Petitioner filed its petition in response to being sued by PO in March 2017. Notably, PO had filed **three** prior lawsuits against Petitioner in April, May and June 2016, but did not assert the patent-at-issue here. And, when PO finally did file its March 2017 lawsuit against Petitioner, that was the 23<sup>rd</sup> lawsuit that PO had filed relating to its patents. PO's arguments relating to 314(a) are inappropriate where they are the result of its litigation strategy. Decision dated Feb. 6, 2018 at 26 (Paper 8), *Samsung Elec. Am. v. Uniloc*, IPR2017-01801, Paper 8 at 26 (Feb. 6, 2018 P.T.A.B.) (Patent Owner's complaint about the multiple IPR petitions "is not persuasive when the volume appears to be a direct result of its own litigation activity." ).

PO advised that it opposes this request. The parties are available for a call next week on Monday or Tuesday after 12.00 pm EDT.

Regards  
Robert

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